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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

	X	
	:	
EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	
Petitioner,	:	Cancellation No. 92025859
	:	
v.	:	
	:	
GENERAL CIGAR CO., INC.,	:	
	:	
Respondent.	:	
	X	

RESPONDENT GENERAL CIGAR CO., INC.'S TRIAL BRIEF

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Respondent General Cigar Co., Inc. (“GC”) respectfully submits its Trial Brief in opposition to the Amended Petition of Petitioner Empresa Cubana del Tabaco, d.b.a. Cubatabaco (“CT”) to cancel GC’s Reg. No. 1147309 (Feb. 17, 1981) (“First Registration”) and Reg. No. 1898273 (June 6, 1995) (“Second Registration”) (collectively, the “Registrations”) of COHIBA for cigars.

DESCRIPTION OF THE RECORD

The portions of the record on which GC relies include: (1) trial declarations (including exhibits) and cross-examinations of Abbot (GC), Richter (GC), McKee (GC), Hacker (GC), Willner (CT), Fernandez (CT), and Babot (CT); (2) discovery depositions of the same witnesses, and also of Martinez (GC), Maturen (GC), and Smith (former GC); (3) testimonial and documentary discovery and trial evidence from *Empresa Cubana del Tabaco v. General Cigar Co., Inc.*, 97 Civ. 8399 (S.D.N.Y.) (“Federal Action”); (4) relevant U.S. Patent and Trademark Office (“PTO”) file histories;¹ (5) submissions from the instant Proceeding and other Board proceedings involving the parties, including pleadings and filings by either party and rulings; and (6) other documents submitted by Notice of Reliance, including cigar catalogs and third-party publications.

Appendix A to this Brief describes GC’s evidence. Appendix B sets forth GC’s objections to the admissibility of certain evidence submitted by CT in its trial period. In Appendix C, GC responds to the evidentiary objections raised by CT to certain GC trial evidence. Appendix D is a copy of CT’s memorandum of law in support of its motion for partial summary judgment, dated February 5, 2002, filed in the Federal Action (without any attachments) (“CT SJ Br.”).²

¹ The PTO files for the Registrations are part of the record. 37 CFR § 2.122(b)(1); TBMP § 704.03(a).

² At any stage of a proceeding, the Board may take judicial notice of a fact that is “not subject to reasonable dispute” in that it is “capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” TBMP § 704.12, citing Fed R. Evid. 201(b); *see also* 37 CFR § 2.122(a); *Biomedical v. California*, 505 F.3d 1328, 1331 n.1, 85 USPQ2d 1074, 1076 (Fed. Cir. 2007) (affirming court’s decision to take judicial notice of several court filings from prior litigation between the parties).

COUNTERSTATEMENT OF THE ISSUES

1. Are CT's claims for cancellation of the First Registration and Second Registration under Article 8 of the Inter-American Convention ("IAC") barred by issue preclusion arising from a final judgment in the Federal Action?

2. With respect to CT's claim of fraud in GC's § 15 Declaration of five years of continuous use of the COHIBA mark, filed in connection with the First Registration, has CT proven by clear and convincing evidence that the Declaration contained a materially false statement and was made with intent to defraud the PTO?

3. With respect to CT's claim for abandonment of the First Registration, (a) has GC met its burden of going forward with evidence that during the period of GC's non-use of the mark, GC intended to resume use of the mark once economic conditions in the cigar market improved, and in fact did resume that use promptly upon improved conditions, and (b) if GC has met its burden, has CT met its burden of persuasion of showing that GC discontinued use of the COHIBA mark without intent to resume use?

4. Assuming *arguendo* that CT prevails on one or more of its claims for cancellation of the First Registration, has CT carried its heavy burden of proving, under § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), that (a) it acquired priority in the U.S. by making actual commercial use of the COHIBA mark on cigars in the U.S. prior to GC's first use date of the mark under the Second Registration, *and* (b) that GC's use of its COHIBA mark under its Second Registration is today likely to cause confusion as to source or origin among an appreciable number of premium cigar consumers in the U.S.?

5. Does GC's use of the COHIBA mark in the U.S. with knowledge that CT had previously used that mark for cigars sold outside of the U.S., but without evidence of GC having blatantly passed off the GC COHIBA cigars as the CT Cohiba cigars sold outside of the U.S., entitle CT to cancellation of the Second Registration under § 14(3) of the Lanham Act, 15 U.S.C. § 1064(3)?

STATEMENT OF FACTS

1. Facts Unique to the U.S. Cigar Market

The Embargo: In 1962, the U.S. government imposed an embargo on trade with Cuba, prohibiting person(s) subject to U.S. jurisdiction from transporting, importing, or otherwise dealing in or engaging in any transaction with respect to merchandise of “Cuban origin,” including cigars. 31 C.F.R. §§ 515.101, *et seq.* (“Embargo”). Since the Embargo went into effect, it has been illegal for Cuban cigars to be sold or imported for commercial purposes in the U.S. 273 TTABVue 11; 341 TTABVue 5-7. The Embargo regulations as of 1996 were codified into law by the Cuban Liberty and Democratic Solidarity (LIBERTAD) Act of 1996, now codified as 22 U.S.C. § 6021, *et seq.* *See id.* § 6032(h) (“Codification of economic embargo”). Thus, the Embargo regulations may not be modified except by an Act of Congress signed by the President. No such legislation has ever passed either house of Congress.

“Parallel” Cigar Brands: When Fidel Castro came to power in Cuba, his government expropriated existing cigar businesses and the marks they had used. *See Havana Club Holding, S.A. v. Galleon S.A.*, 203 F.3d 116, 129, 53 USPQ2d 1609, 1618 (2d Cir. 200), *cert. denied*, 531 U.S. 918 (2000). The exiled mark owners reestablished themselves in other countries and began to manufacture non-Cuban cigars and sell them in the U.S., using the same marks and trade dress that the manufacturers had used in Cuba; their right to do so over Cuban government objections was affirmed by the U.S. courts. *F. Palicio y Compania v. Brush*, 256 F. Supp. 481, 487-88, 150 USPQ 607, 611-12 (S.D.N.Y. 1966), *aff’d*, 375 F.2d 1011 (2d Cir. 1967); *Menendez v. Faber, Coe & Gregg, Inc.*, 345 F. Supp. 527, 552, 174 USPQ 80, 85 (S.D.N.Y. 1972). Many of these businesses and their marks were subsequently sold to existing U.S. cigar manufacturers, including GC, which have continued to sell non-Cuban cigars in the U.S. using the marks and sometimes trade dress of the original Cuban brands. 341 TTABVue 6-7. In the meantime, CT (the Cuban state tobacco monopoly) and its licensees began exporting cigars under the same marks and trade dress to countries other than the U.S.

As a result, for a number of decades there has been a “parallel brands” situation unique to cigars. There are dozens of cigar brands for which the same marks are used both on non-Cuban cigars sold in the

U.S. and Cuban cigars sold in other countries, despite the fact that there is no connection between the two sets of manufacturers. These include MONTECRISTO, PUNCH, PARTAGAS, ROMEO Y JULIETA, and the mark which is the subject of this proceeding, COHIBA. 339 TTABVUE 265, 337-39 (Appendix I); 283 TTABVUE 20-27; 284 TTABVUE 139-224 (Annexes T and U); 273 TTABVUE 5.³ As discussed below, U.S. cigar smokers are well-aware of the “parallel brands” practice and that the non-Cuban cigars for sale in the U.S. are not connected with the Cuban cigars sold in other countries under the same brands. *See infra* at 43-46.

The Enduring Connection between Cigars and Cuba: Cuba has been known among U.S. cigar consumers as a center of cigar manufacturing since well before the Castro government came to power. As a result of this historical connection, premium cigar consumers generally draw a connection between cigars and Cuba no matter where cigars originate (much as a similar connection is drawn between wine and France), and even though a cigar brand is not advertised or marketed as having a connection with Cuba. 361 TTABVUE 79-81 at 77:25-79:15; 362 TTABVUE 826-28 at 134:5-136:12. Documents and testimony in the record concerning internal discussions at GC about whether the GC COHIBA cigar has a “Cuban aura” or “Cuban equities” refer to this background consumer connection that exists for all cigar manufacturers. However, there has never been any GC consumer-facing advertising of the COHIBA cigar that mentions Cuba.

Premium Cigars: The cigar industry is generally divided into mass-market cigars, which are machine made, and premium cigars which are hand-rolled with all-natural long filler tobacco, which may be aged or fermented and are sold at a higher price point than machine-made cigars. 273 TTABVUE 7; 341 TTABVUE 5. GC’s COHIBA cigar is a premium cigar; the least expensive COHIBA cigar has a suggested retail price of over \$9 and the most expensive can retail for \$90.⁴ 283 TTABVUE 9, 37-113 (Annex A);

³ While COHIBA was not one of the brands confiscated by the Cuban government, since it was originated after the Castro government came to power, writers on cigars and consumers have nonetheless regarded COHIBA as being one of the many parallel cigar brands sold in the U.S. *See infra* at 43-46.

⁴ CT deceptively suggests GC’s COHIBA cigar is not premium because the “majority” of GC’s COHIBA sales are for “small” cigars. 365 & 366 TTABVUE 41. This is false math based on counting the

273 TTABVUE 29; 285 TTABVUE 2-912 (Annex W); 139 TTABVUE 3. Since the late 1990s, GC has always promoted the COHIBA cigar as a luxury, “lifestyle” purchase. 341 TTABVUE 50-53; 283 TTABVUE 19, 367-84 (Annex Q).

Evolution of U.S. Cigar Market: The background facts of this case take place against dramatic changes in the U.S. cigar market. From the mid-1960s until the early 1990s, consumption of cigars declined by 66% (*Cigar Aficionado*, “A Brief History of the Cigar Industry,” Sept.-Oct. 2012 (283 TTABVUE 114)), and GC reacted to adverse conditions by limiting the cigar brands that it sold while waiting for a recovery in the market. *See infra* at 33-35. There was a sudden and dramatic improvement in sales within the U.S. cigar market toward the end of 1992, which became known as the “cigar boom;” in fact, by 1996, imports of premium cigars in the U.S. had nearly tripled. 283 TTABVUE 115, 288-306 (Annex M). As shown below, GC discontinued sales of its COHIBA cigar in 1987, while waiting for conditions in the market to improve before re-entry, and as soon as the “boom” began, in November 1992, GC again began selling cigars under the COHIBA mark. 341 TTABVUE 12-14, 16-17, 26-28, 32.

2. GC’s Adoption and Use of the COHIBA Mark

First Registration: GC first heard of the name “Cohiba” in late 1977, at a time when the CT Cohiba was essentially unknown in the U.S.⁵ In 1978, Oscar Boruchin discussed Castro’s use of the “Cohiba” cigar in Cuba with company CEO Edgar Cullman Jr., and noted that “Cohiba” was used in Cuba to identify cigars given to visitors and diplomats by “the highest echelons of government,” but that “Cohiba” was “not on the market” or sold commercially and “didn’t mean anything to anybody.” “Nobody knew the brand.”⁶ 342

small cigars individually. In fact, small COHIBA cigars are sold only in packages of six to ten for a suggested retail price of \$19.99 to \$23.99, equivalent to the price of one of the higher-priced COHIBA full cigars. 283 TTABVUE 14, 163-175 (Annex K); 355 TTABVUE 131-133 at 128:19-130:13.

⁵ A December 12, 1977, internal GC memorandum refers to the use of “Cohiba” in Cuba and notes that GC would want to start using the trademark in around 1978 or so. 198 TTABVUE 143-46. There appear to be only two U.S. magazine articles referring to the Cuban Cohiba before 1982. 180 TTABVUE 69-71, 73-76, 78-84.

⁶ The 1977 Tobacco Merchants Association of the U.S. Report mentioned twenty-four Cuban cigar brands exported from Cuba outside the U.S. and Cuban cigar marks which had then “been registered” in the U.S., but did not mention the CT Cohiba. 291 TTABVUE 32-35. “Cohiba” was not mentioned in a list of CT cigar brands in the July-December 1979 issue of *Cubatabaco International* magazine. 291

TTABVUE 288-93 at 25:10-27:24; 30:8-13; 342 TTABVUE 1067 at 133:15-134:11. CT has admitted that “Cohiba” was an “anonymous” brand outside Cuba before at least 1982. 179 TTABVUE 943.

GC adopted the mark “Cohiba” for a cigar because it was short and easy to say. 341 TTABVUE 6, 8-9, 39-40, 58; 338 TTABVUE 1149-51 at 1280:18-1282:5. In February and June 1978, in order to establish use for trademark registration, GC sold cigars labeled with the COHIBA mark to retailers, who then sold the cigars to the public. 291 TTABVUE 501-04. GC’s application to register the word mark COHIBA for cigars was filed with the PTO on March 13, 1978. 291 TTABVUE 524-28, 543-45. The application was published for opposition on November 4, 1980. No opposition was filed and COHIBA was registered on February 17, 1981 as Reg. No. 1147309 (First Registration).

GC shipped the following amounts of COHIBA-branded cigars to retailers in the indicated years: (1) 1978: 650; (2) 1979: 600; (3) 1980: 1,000; (4) 1981: 700; and (5) 1982: 200. 291 TTABVUE 501-02, 503-05, 506-23, 1098-99; 346 TTABVUE 207-10 at 51:13-54:16. These sales figures were not in dispute in the Federal Action. *See Empresa I*, 213 F. Supp. 2d at 257. Because these sales were made to retailers who then sold the cigars to consumers, the COHIBA-branded cigars were available for public purchase even in months without GC shipments. 346 TTABVUE 211-16 at 55:22-56:2, 57:17-22; 58:4-5; 60:10-13; 342 TTABVUE 1121 at 210:2-5.

Starting in 1982, GC substantially increased the volume of its shipments to merchants of COHIBA-branded cigars as follows: (1) 1982: 90,000; (2) 1983: 323,000; (3) 1984: 118,000; (4) 1985: 70,000; (5) 1986: 5,000; and (6) 1987: 3,000. 193 TTABVUE 196-203, 606, 608-09, 611-15, 617-25, 627-35, 679-86; 291 TTABVUE 816-24, 825-26, 827-29, 830-35, 836-42, 843-50, 1100-08. While GC intended to use the COHIBA name for a high-end cigar, the conditions of the cigar market in the 1980s did not permit this (341 TTABVUE 10, 12), and so during this time GC used the COHIBA mark on its pre-existing Canario D’Oro “upscale bundle” premium cigar, which was manufactured in the Dominican Republic and sold “bundled”

TTABVUE 495-500. It was not until the July-December 1981 edition of the *Cubatabaco International* that the CT “Cohiba” cigar was first referenced. *Id.* at 533. A book written by the in-house counsel for CT, published in 1997, states that the CT Cohiba cigar did not emerge from “anonymity” until 1982 when it was shipped in small quantities to Spain. 179 TTABVUE 510-856.

in a clear plastic canister. 297 TTABVUE 235, 237-38, 240-44; 341 TTABVUE 11-12; 193 TTABVUE 196-203, 671-77; *see, e.g.*, 291 TTABVUE 807-08; 809-15. GC advertised these cigars with in-store advertisements. 342 TTABVUE 420 at 54:14-20. As of the filing of the § 15 Declaration for the First Registration in June 1986, GC's sales of COHIBA cigars to retailers had been continuously ongoing from 1978, as retailers sold their stock of cigars to the public.⁷ 346 TTABVUE 366 at 241:6-17; 345 TTABVUE 772-73 at 137:22-138:3.

Given the decline in the cigar market, however, the COHIBA upscale bundle was not commercially successful. 341 TTABVUE 12. As the U.S. cigar market was approaching its nadir in 1987, GC discontinued sales of the COHIBA cigar and awaited improvement in the market. It had no intent at any time between that date and its resumption of shipments on November 20, 1992 (342 TTABVUE 16; 193 TTABVUE 857) to abandon the COHIBA mark and First Registration, as demonstrated contemporaneously by: (1) its internal strategy discussions throughout the period about converting COHIBA from a "bundled" to a super-premium cigar, to be sold in wooden boxes as one of GC's primary cigars (341 TTABVUE 12-14, 58; 338 TTABVUE 1040-1165 at 1166:22-1167:4, 1296:1-22; 345 TTABVUE 353-57 at 37:2-40); (2) starting in April 1989, GC consulted counsel to determine whether it could relaunch a COHIBA branded cigar also using the Cuban Cohiba trade dress, discussions which continued through 1993 (341 TTABVUE 30, 36-44, 58-60; 199 TTABVUE 78-79; 297 TTABVUE 246-49, 250-52; 338 TTABVUE 160-62 at 209:7-14, 211:10-13; 338 TTABVUE 284-85 at 335:8-336:1; 338 TTABVUE 1072 at 1200:2-12; 296 TTABVUE 258-77; 194 TTABVUE 285-305; 180 TTABVUE 591-93); (3) GC did not include COHIBA in a list of marks that it intended to abandon when they came up for renewal (346 TTABVUE 417-419 at 304:18-306:6; 194 TTABVUE 565-567; 297 TTABVUE 308); and (4) GC continued to enforce the registered

⁷ In 1983, CT sought to register a Cohiba mark in the U.S. but decided not to proceed after learning of GC's First Registration. 291 TTABVUE 547-50, 552-74 at No. 32; 343 TTABVUE 408-11 at 82:14-85:22; 190 TTABVUE 18-22. CT also chose not to take any action to cancel GC's First Registration. 341 TTABVUE 35-36. It was also aware that GC filed Section 8 and 15 Declarations for the First Registration at the time they were filed, but chose not to take any action to cancel the First Registration on the basis that these Declarations were allegedly fraudulent. 190 TTABVUE 54-56 at No. 43; 338 TTABVUE 793 at 910:1-17; 342 TTABVUE 58 at 85:2-7.

COHIBA mark against infringers (341 TTABVUE 44-45; 276 TTABVUE 8-11 at ¶¶ 20-27, 13-95 (Annex A); 355 TTABVUE 748-51 at 52:20-55:5; 169 TTABVUE 11-13, 486-679).

Most importantly, in November 1992, GC resumed very substantial sales of a COHIBA-branded cigar at the very beginning of the “cigar boom”⁸ (347 TTABVUE 2, 69; 342 TTABVUE 334 at 91:9-14), and thereafter shipped large quantities of COHIBA cigars to merchants through 1997: (1) 1992: 5,600; (2) 1993: 50,000; (3) 1994: 49,000; (4) 1995: 101,000; (5) 1996: 96,000; and (6) 1997: 27,000 (in the first 3 months of the sales period). 291 TTABVUE 891, 893, 901, 903-909, 911-14, 916-35, 937, 939, 1109-17; 193 TTABVUE 857, 841-48; 297 TTABVUE 253-54, 255-62, 790-96, 798-805, 807-14. This COHIBA cigar was an interim product, sold in the U.S. through Alfred Dunhill and Mike’s Cigars. 345 TTABVUE 47-50 at 76:19-78:23, 79:3-79:23; 193 TTABVUE 3-17 at MC00496; 342 TTABVUE 1183 at 292:14-294:17; 341 TTABVUE 15-17, 66-67. GC’s plans to relaunch the COHIBA cigar as a super-premium product were delayed by (1) GC’s need to find the proper blend of aged tobaccos needed for such a product, and (2) the worldwide shortage of available aged tobacco caused, ironically, by the boom and explosive growth of cigar manufacture. 341 TTABVUE 27-29. GC did not want to introduce its new COHIBA cigar only to be unable to satisfy market demand because of lack of tobacco. *Id.* at 27-28. As of 1996, tobacco supplies became more plentiful and GC’s marketing plan for 1997 set forth a plan to release a new super-premium COHIBA for the 1997 Retail Tobacco Dealers Association (“RTDA”) convention. *Id.* at 28-29. The super-premium GC COHIBA cigar was launched in September 1997 and GC sold 509,000 units of its new COHIBA line from August-December 1997.⁹ 291 TTABVUE 1119-1121; 341 TTABVUE 54.

⁸ It is irrelevant for purposes of this case whether the publication of the first issue of *Cigar Aficionado* in September 1992 spurred the cigar boom as CT claims (365 & 366 TTABVUE 10, 13), or merely coincided with it. *Cigar Aficionado*, in its own history of the U.S. cigar market published in 2012, did not suggest that the story about the Cuban Cohiba that appeared in its first issue played any role in the U.S. cigar boom – in fact, the *Cigar Aficionado* history did not even mention the Cuban Cohiba. 283 TTABVUE 288-306 (Annex M). In any event, all agree the boom began in late 1992, and it is indisputable that GC resumed sales of a COHIBA cigar in November 1992, immediately after the market began to improve – thus validating that it had no intent to abandon its COHIBA mark during the five previous years.

⁹ In the period between April and August 1997 GC decided not to ship any COHIBA cigars in order to ready the marketplace for the new super-premium COHIBA. 341 TTABVUE 25, 27-29.

Second Registration: On December 30, 1992, GC filed a second application to register a stylized version of its COHIBA mark, with a first use in commerce date of December 31, 1992, and a first use in commerce in another form dating back to February 1978 (referring to the First Registration). The PTO granted GC's application and published the mark for opposition on April 12, 1994. CT was aware of the publication but chose not to file an opposition. 341 TTABVUE 42. The Second Registration issued on June 6, 1995 as Reg. No. 1898273.

Sales of GC COHIBA Since 1997: GC developed a new trade dress for the super-premium COHIBA with a red dot in the middle of the "O" of COHIBA featured on the cigar band and box. 341 TTABVUE 30; 190 TTABVUE 34-40; 296 TTABVUE 865-72. Both the box and the cigar band of each COHIBA cigar contain a clear statement of the country of manufacture (Dominican Republic, Honduras, or Nicaragua). 283 TTABVUE 29-30, 912-930 (Annex X). There is no resemblance between the GC COHIBA trade dress and the trade dress of the CT Cohiba, which uses an "Indian head" logo and a black-and-white "checkerboard" pattern above a bright yellow background. In addition, CT Cohiba cigars prominently feature the "Habanos" sticker on the boxes in which they are packaged, and a band that states "Habana, Cuba." 283 TTABVUE 25-27. GC identifies the manufacturing location of its cigars as the Dominican Republic, Nicaragua, or Honduras on the cigar band and cigar box.

GC's super-premium COHIBA cigar has been a market leader in the U.S. ever since the relaunch. GC has sold well over [REDACTED] of COHIBA cigars since 1997.¹⁰ GC has also invested over [REDACTED] in advertising and promoting its COHIBA brand to U.S. customers. 283 TTABVUE 16, 307- 366 (Annexes N, O, P). The GC COHIBA (which now contains about ten sub-brand extensions (283 TTABVUE 10-14,

¹⁰ The value of sales of the super-premium COHIBA cigar in the U.S. have been: (1) 1997: \$500,000; (2) 1998: \$858,000; (3) 1999: \$985,000; (4) 2003: [REDACTED]; (5) 2004: [REDACTED]; (6) 2005: [REDACTED]; (7) 2006: [REDACTED]; (8) 2007: [REDACTED]; (9) 2008: [REDACTED]; (10) 2009: [REDACTED]; (11) 2010: [REDACTED]; (12) 2011: [REDACTED]; (13) 2012: [REDACTED]; (14) 2013: [REDACTED]; (15) 2014: [REDACTED]; (16) 2015: [REDACTED]; (17) 2016: [REDACTED]; (18) 2017: [REDACTED]; (19) 2018: [REDACTED]; and (20) 2019: [REDACTED]. 283 TTABVUE 14-15, ¶ 24; 37-113 (Annex A); 281 TTABVUE 9-10 (¶ 28); 12-165 (Annex A); 291 TTABVUE 1109-17, 1119-1121. GC's sales figures from 2000-2002 were not available during the Federal Action and were not part of TTAB discovery although there is no dispute of fact that GC's sales of its super-premium COHIBA cigar were either consistent or increased between 2000-2002.

¶¶ 17-18, 20)), has been very highly rated among cigar reviewers. 283 TTABVUE 33-34; 286 TTABVUE 176-187 (Annex CC).

Today, GC has about [REDACTED] direct sales accounts for its COHIBA line of cigars in the following channels: (1) internet/catalog; (2) distributors; (3) retail; and (4) liquor. 281 TTABVUE 4-5. Some distributors may sell GC's COHIBA cigars further downstream, and GC does not receive detailed statistics from its distributors about any indirect accounts, although given the GC COHIBA cigars' high price-point and positioning, GC's COHIBA cigar is not typically found in a non-tobacconist outlet. *Id.*; 283 TTABVUE 18. CT claims to have purchased individual COHIBA cigars in convenience stores and gas stations; this is not impossible, but counterfeit Cohiba cigars circulate, and CT has not presented any evidence that the single cigars its handful of investigators purchased were genuine, nor has it made any attempt to show the volume of cigars sold through such channels as opposed to through GC's direct accounts was material.

PROCEDURAL HISTORY

CT commenced this Proceeding ("Proceeding" or "Cancellation") by filing a Petition on January 15, 1997. 1 TTABVUE; 365 & 366 TTABVUE 11. Later in 1997, it filed an infringement action in federal court (the "Federal Action," defined above) in which it sought cancellation of the First and Second Registrations on virtually the same grounds stated in its Cancellation Petition.¹¹ CT then moved for and obtained Board suspension of the Cancellation, representing to the Board that, "[t]he determination of this pending [federal] action will be dispositive of all of the issues raised in the instant Cancellation Proceeding, including the issue of entitlement to registration." 11 TTABVUE 1.

¹¹ To assist the Board in distinguishing among the many reported judicial decisions captioned *Empresa Cubana del Tabaco v. General Cigar Co., Inc.* that are relevant to this Cancellation, this brief uses the following short references:

Empresa I: 213 F. Supp. 2d 247 (S.D.N.Y. 2002).

Empresa II: No. 97 Civ. 8399, 2002 WL 31251005 (S.D.N.Y. Oct. 8, 2002).

Empresa III: No. 97 Civ. 8399, 70 USPQ2d 1650, 2004 WL 602295 (S.D.N.Y. Mar. 26, 2004).

Empresa IV: No. 97 Civ. 8399, 2004 WL 925647 (S.D.N.Y. Apr. 30, 2004).

Empresa V: 399 F.3d 462, 73 USPQ2d 1936 (2d Cir. 2005).

Empresa VI: 547 U.S. 1205 (2006).

Empresa VII: 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014).

In the Federal Action, CT moved for partial summary judgment on its claim for cancellation of the Registrations under Articles 7 and 8 of the IAC. On June 26, 2002, the District Court instead granted partial summary judgment dismissing the IAC claims on the merits. *Empresa I*, 213 F. Supp. 2d at 279-82, and made this dismissal with prejudice in its final judgment. *Empresa IV*, 2004 WL 925647, at *3. CT cross-appealed from this portion of the judgment, but the dismissal of the IAC claims was affirmed by the Second Circuit in *Empresa V*, 399 F.3d at 481-83.

The District Court also ruled, in deciding the partial summary judgment motion, that GC abandoned the First Registration between 1987 and 1992. *Empresa I*, 213 F. Supp. 2d at 267-71. Following trial, the District Court ruled that CT had obtained priority over GC and thus ownership of the COHIBA mark in the U.S. through the “famous marks” doctrine, *Empresa III*, 70 USPQ2d at 1675-82, and that CT had shown a likelihood of confusion. *Id.* at 1682-89. Its final judgment enjoined GC from further use of the COHIBA mark and ordered the Registrations to be cancelled. *Empresa IV*, 2004 WL 602295, at *2. GC appealed to the Second Circuit from the portions of the final judgment that favored CT, including the order of cancellation. In *Empresa V*, the Second Circuit reversed all portions of the District Court opinion (except as to the District Court’s dismissals with prejudice of CT’s claims under Articles 7, 8, 20, and 21 of the IAC, and Article 10*bis* of the Paris Convention for the Protection of Intellectual Property (“Paris Convention”), which were affirmed), vacated all relief that the District Court had granted in favor of CT, and remanded for entry of an order dismissing all of CT’s remaining claims. *Id.*, 73 USPQ2d at 1954. CT petitioned the U.S. Supreme Court for a writ of certiorari and requested, *inter alia*, review of the Second Circuit’s affirming dismissal of its cancellation claims under IAC Articles 7 and 8. In *Empresa VI*, the Supreme Court denied certiorari. *Id.*, 547 U.S. at 1205.

In 2011, after additional Federal Action skirmishes not relevant here, the Board resumed the Proceeding (60 TTABVUE), CT filed an Amended Petition raising eleven grounds for cancellation (61 TTABVUE), and GC filed an Answer and affirmative defenses (62 TTABVUE). GC then filed a motion for summary judgment asking that the petition be dismissed on the basis of the Second Circuit ruling (64 TTABVUE), which the Board granted solely on the basis that, as a result of the Second Circuit ruling, CT

lacked standing to seek cancellation. 75 TTABVUE. GC appealed to the Federal Circuit, which reversed on the basis that CT did have standing to seek cancellation. *Empresa VII*, 111 USPQ2d at 1062-63. The Federal Circuit also addressed preclusion in its decision although the Board had not, and concluded that neither issue preclusion nor claim preclusion barred CT's grounds for cancellation. *Id.* at 1063-65.

On October 28, 2015, discovery in the Proceeding reopened (88 TTABVUE 2), and the parties engaged in a three-year discovery period, which included a number of disputes that the Board ruled on (99, 122, 131 TTABVUE). One of the rulings which denied CT's motion to belatedly disclose additional experts on social media and marketing confusion set forth an important principle for this case: "[T]he Board's determination of likelihood of confusion claims is based on the factual situation as of the time of trial. *See, e.g., Hornby v. TIX Cos.*, 87 USPQ2d 1411, 1416 (TTAB 2008)." 122 TTABVUE 7. As shown below, despite this ruling, CT's confusion claim relies heavily on facts well predating the trial.

On July 1, 2021, CT submitted its trial brief (365 & 366 TTABVUE), asking for cancellation of the Registrations in full or in part on six of its eleven cancellation grounds (First, Third (in part), Fifth (in part), Sixth, Seventh (in part), and Eighth Grounds).¹² It has not argued and has therefore waived its Second, Fourth, Ninth, Tenth, and Eleventh Grounds for Cancellation, as well as the portions of its Fifth and Seventh Grounds based on Article 7 of the IAC and the Third Ground based on the § 8 Declaration for the First Registration. *See Alcatraz Media, Inc. v. Chesapeake Marine Tour Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner's pleaded claims not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014).¹³

¹² CT conceded the Board does not recognize its pleaded cancellation grounds under Article 6bis of the Paris Convention and the well-known marks doctrine. 365 & 366 TTABVUE 9, n.1. However, it impermissibly attempts, by reference to these grounds in a footnote in its brief, to preserve them for appeal. Failure to argue the grounds (and even more so when relegated to a footnote) is a conclusive waiver. *See Smithkline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320, 78 USPQ2d 1097, 1103 (Fed. Cir. 2006) (arguments raised in a footnote are not considered preserved in an appeal).

¹³ *See also* TBMP § 801.01 ("If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived."); *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1136, 2013 WL 4635990, at *1 n.4 (TTAB Aug. 16, 2013) (pleaded claims not argued in brief deemed waived).

ARGUMENT

I. CT'S CLAIMS FOR CANCELLATION OF THE FIRST AND SECOND REGISTRATION UNDER THE IAC ARE BARRED BY ISSUE PRECLUSION ARISING FROM A FINAL FEDERAL JUDGMENT

The Fifth and Seventh Grounds for Cancellation of the Amended Petition allege that GC violated Article 8 of the IAC by using and registering the COHIBA mark in the U.S. with knowledge of CT's prior use of the mark for cigars and continuous use and employment of the same mark on the same goods. CT asserts that GC's First and Second Registrations must therefore be cancelled by the Board. 61 TTABVUE 30-31, ¶¶ 111, 115. The Board should dismiss these claims on the ground of issue preclusion.¹⁴

In *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045 (2015) ("*B&B Hardware*"), the U.S. Supreme Court held for the first time that, where issues of law or fact have been fully decided in a final federal court judgment, issue preclusion prohibits the losing party in the federal case from relitigating those issues against the winning party in a later Board proceeding. All of the required elements for issue preclusion are demonstrated on the record of this Proceeding. *First*, the legal issue of whether Article 8 of the IAC gives a foreign mark owner a cause of action to cancel a U.S. trademark registration was at issue in the Federal Action, and is at issue here. *Second*, the IAC issue was fully and finally determined in the Federal Action, with the District Court dismissing CT's IAC claim for cancellation with prejudice and making the dismissal part of its final judgment. *Third*, determination of the IAC issue was necessary to the District Court's final judgment. *Finally*, the parties in both proceedings are the same. The Board must therefore dismiss the Fifth and Seventh Grounds for Cancellation with prejudice.

In *B&B Hardware*, on writ of certiorari from the Eighth Circuit, the U.S. Supreme Court determined that issue preclusion applies between federal court litigation and Board *inter partes* proceedings, and that where the elements of issue preclusion are satisfied, a district court judgment should be given preclusive effect in a later Board proceeding. *B&B Hardware* held that a final Board decision (in that case, finding likelihood of confusion) will be preclusive in a later district court proceeding raising the

¹⁴ GC raised collateral estoppel (*i.e.*, issue preclusion) as one of its affirmative defenses in its Answer. 62 TTABVUE 24-25 (Second Defense).

same issue “[s]o long as the other ordinary elements of issue preclusion are met [and] the usages adjudicated by the TTAB are materially the same as those before the district court.” *Id.* at 2054.

Most relevantly, the decision also held that where a district court is the first to rule on a legal issue and that ruling is essential to its judgment, the *Board* is bound by the district court judgment in a later *inter partes* proceeding where the elements of issue preclusion are satisfied: “Neither is issue preclusion a one-way street. When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB’s analysis, the TTAB gives preclusive effect to the court’s judgment.” *Id.* at 2053. In the same vein, the Court noted that “where a single issue is before a court and an administrative agency, preclusion often applies.” *Id.* at 148. *See also V.V.V. and Sons Edible Oils Ltd. v. Meenakshi Overseas, LLC*, 946 F.3d 542, 547 (9th Cir. 2019) (“To the extent a party before the TTAB litigates an issue that also arises in infringement proceedings before a federal district court, issue preclusion would bar relitigation.”).

B&B Hardware rooted its holding in the Restatement (Second) of Judgments (113 USPQ2d at 2051, quoting Restatement (Second) of Judgments § 27 at 250 (1980)), which identifies four requirements for issue preclusion: (1) an issue of fact or law must have been presented in both the prior and current actions; (2) that issue must have been actually litigated in the prior action and determined adversely to the precluded party in a valid and final judgment; (3) determination of that issue must have been necessary and essential to the prior judgment; and (4) the parties are the same, or the precluded party’s position in the prior action was fully represented by another party. Restatement (Second) of Judgments § 27 at 250; *see also Hagans v. Levine*, 415 U.S. 528, 542 (1974). The fourth element is indisputably satisfied here, since CT and GC were also the parties in the Federal Action. As shown below, the remaining three elements are also satisfied.

1. The Issue of Law – Whether Article 8 of the IAC Provides a Foreign Mark User with the Right to Cancel a U.S. Trademark Registration – Is Identical in Both the Federal Action and This Cancellation

The IAC issue here – whether Article 8 of the IAC gives CT a right to cancel GC’s U.S. COHIBA Registrations – is sufficiently identical to the issue CT asked the District Court to decide and which that court did decide, and thus meets the first requirement of issue preclusion. *B&B Hardware* holds that an

issue in a prior case need not be totally identical to the issue currently under litigation for the earlier judgment to be preclusive. Where the same question of statutory (or here, treaty) law is raised in both proceedings, the issue is considered the same for preclusion purposes even if the later tribunal's precedents interpreting the law are contrary to the ruling of the first tribunal.

B&B Hardware emphasized that courts and the Board must take a sufficiently broad view of what an "issue" is so that a losing litigant cannot evade the preclusive effect of an adverse judgment. It held a prior Board decision in an opposition proceeding on likelihood of confusion to be preclusive of likelihood of confusion when raised in a later federal infringement litigation, even though "registration is not a prerequisite to an infringement action [but] a separate proceeding to decide separate rights." *B&B Hardware*, 113 USPQ2d at 2053.

While the Eighth Circuit decision reviewed in *B&B Hardware* analyzed likelihood of confusion differently from the Board's analysis, the Supreme Court made clear that if the underlying law being applied is the same in two proceedings, the issue remains the same for issue preclusion analysis even if the two tribunals differ in their interpretations of that law. "More important, *if federal law provides a single standard, parties cannot escape preclusion simply by litigating anew in tribunals that apply that one standard differently*. A contrary rule would encourage the very evils that issue preclusion helps to prevent." *Id.* (emphasis added). *B&B Hardware* also cited Restatement (Second) of Judgments § 27, Comment c, at 252–53, as "explaining that 'issue' must be understood broadly enough 'to prevent repetitious litigation of what is essentially the same dispute.'" 113 USPQ2d at 2055.

The IAC issue presented and decided in the Federal Action satisfies *B&B Hardware*'s test of identity between issues. CT's factual allegations supporting its IAC claims in the Federal Action and in its Amended Petition are the same. *Compare* 11 TTABVUE 15, ¶¶ 49-52 (CT Complaint), with 61 TTABVUE 30-31, ¶¶ 111, 115 (CT Amended Petition). CT's arguments and evidence for its IAC claim here are the same ones it raised in the Federal Action. *Compare* Appendix D (CT SJ Br.) at 33, 40-43; with 365 & 366 TTABVUE 13-20, 28 (CT trial brief). The same legal question now before the Board, whether Article 8 of the IAC gives a claimed foreign mark holder or user the right to cancel a U.S. registration, was presented

by CT in its February 2002 partial summary judgment motion in the Federal Action. Indeed, CT argued that the District Court should follow the Board's decision in *British-American Tobacco Co. Ltd v. Philip Morris, Inc.*, 55 USPQ2d 1585 (TTAB 2000), and cancel GC's registration under IAC Articles 7 and 8. Appendix D (CT SJ Br.) at 34-37. However, the District Court did not find the Board's decision persuasive, and instead followed a Second Circuit decision, *Havana Club Holding*, 53 USPQ2d 1609, which addressed "the issue of whether the [IAC] provides additional substantive rights other than those available under the Lanham Act." *Empresa I*, 213 F. Supp. 2d at 270.

Havana Club concluded that only substantive rights under the IAC that are "related to the repression of unfair competition" (quoting Lanham Act § 44(h)) would give rise to a cause of action to cancel a trademark registration in the U.S., and that the IAC did not treat rights under Article 23, the specific provision involved in the case, as related to unfair competition. 53 USPQ2d at 1623 n.19. The District Court applied the analysis of *Havana Club* to CT's IAC claims under Articles 7 and 8 of the IAC, holding that those provisions, like Article 23, do not involve rights "related to the repression of unfair competition" and therefore do not create rights enforceable in the U.S. It dismissed CT's claims under Articles 7 and 8. *Empresa I*, 213 F. Supp. 2d at 282. The Second Circuit affirmed this dismissal on the same reasoning. *Empresa V*, 73 USPQ2d at 1951-52. It is essential to note that the Embargo played no role in the District Court's dismissal of the IAC claims or the Second Circuit's affirmance. The District Court noted that the IAC remained "in force between the United States and Cuba notwithstanding the embargo on trade between the two countries." *Empresa I*, 213 F. Supp. 2d at 279.

Although the Second Circuit and the Board differ in their interpretation of Article 8, the IAC issue in this Cancellation is nonetheless the *same issue* that the District Court ruled on for preclusion purposes. As stated in *B&B Hardware*, "federal law provides a single standard here": the IAC and the Lanham Act, to the extent relevant, are the same whether interpreted by a federal court or the Board. *Id.* at 113 USPQ2d 2054. While the Board may "apply that standard differently" than the federal courts do, *B&B Hardware* makes clear that CT "cannot escape preclusion" because of that difference in interpretation. *Id.* As the Restatement puts it, the IAC dispute here is "essentially the same dispute" as CT advanced in federal court.

Restatement (Second) of Judgments § 27, Comment *c* (1982), cited in *B&B Hardware*, 113 USPQ2d at 2055. Allowing CT to engage in repetitious litigation of the same issue because the Board reads the same treaty provision differently than the Second Circuit does would, in the Supreme Court’s words, “encourage the very evils that issue preclusion helps to prevent.” *B&B Hardware*, 113 USPQ2d at 2054.

2. Availability of Cancellation Under IAC Article 8 Was Fully Litigated in Federal Action and Was Decided Adversely to CT in a Valid Final Judgment

The second requirement of issue preclusion is satisfied because CT had a full and fair opportunity to litigate its IAC claims in the Federal Action and those claims were decided adversely to CT by a valid final court judgment that was affirmed on appeal. The District Court’s dismissal of CT’s IAC claim was recognized in its final judgment as dismissed with prejudice. *Empresa IV*, 2004 WL 925647, at *3. CT cross-appealed to the Second Circuit from the dismissal with prejudice of its IAC claims, but the Second Circuit affirmed the dismissal on the same reasoning as the District Court. *Empresa V*, 73 USPQ2d at 1951-52. CT subsequently filed a petition for writ of certiorari with the U.S. Supreme Court, in which it argued that Articles 7 and 8 of the IAC do in fact relate to the repression of unfair competition and were not “abrogated” by enactment of § 44 of the Lanham Act. 2005 WL 2438064, at *28-29 (Petition for a Writ of Certiorari to the U.S. Supreme Court). On June 19, 2006, the Supreme Court denied the petition. *Empresa VI*, 547 U.S. 1205.

B. The District Court’s Dismissal of IAC Claims Was Necessary and Essential To Final Judgment

It cannot be contested that the District Court’s dismissal with prejudice of CT’s IAC claims was necessary to its final judgment. As stated in *Mother’s Restaurant, Inc. v. Mama’s Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 398 (Fed. Cir. 1983), “[t]he requirement that a finding be ‘necessary’ to a judgment does not mean that the finding must be so crucial that, without it, the judgment could not stand. Rather, the purpose of the requirement is to prevent the incidental or collateral determination of a nonessential issue from precluding reconsideration of that issue in later litigation.” Unquestionably, the District Court’s determination that CT’s IAC claims did not state a cause of action for cancellation was neither “incidental” nor “collateral” to the judgment. As all elements of preclusion are satisfied, the Board should therefore

obey the authority of *B&B Hardware* and dismiss the Fifth and Seventh Grounds for Cancellation on the ground that they are issue-precluded by the District Court’s final judgment.

C. The Federal Circuit’s Decision Reversing the Board’s Grant of Summary Judgment to GC is No Bar to Issue Preclusion

CT may respond that the decision of the Federal Circuit (*Empresa VII*; 83 TTABVUE 1-18) reversing this Board’s grant of summary judgment to GC (75 TTABVUE 1-17) is law of the case that prevents the Board from applying issue preclusion as required by *B&B Hardware*. The Board should reject this argument. Law of the case is a discretionary doctrine “even respecting a prior appellate decision in the case,” unlike issue preclusion which is mandatory, and rests on considerations of judicial economy. *Mendenhall v. Barber-Greene Co.*, 26 F.3d 1573, 1582, 31 USPQ2d 1001, 1007 (Fed. Cir. 1994). One long-recognized exception to law of the case is an intervening change in applicable authority. *Id.* Departure from a prior ruling is justified where, since the date of the ruling, there has been a “significant change in the ‘legal atmosphere’ – whether in the form of new legislation, a new court decision, or even a new administrative ruling.” *Bingaman v. Dep’t of Treasury*, 127 F.3d 1431, 1438 (Fed. Cir. 1997). Here, the Federal Circuit decided the interlocutory appeal before *B&B Hardware* was issued. The grounds on which the Federal Circuit’s cursory IAC preclusion analysis rested are no longer valid in light of the changed “legal atmosphere” created by *B&B Hardware*.

The Federal Circuit decision denied preclusion of the IAC claim because, “unlike the federal courts, the Board can cancel registrations directly under Article 8 of the IAC, pursuant to the Board’s jurisdiction under 15 U.S.C. § 1067(a). Unlike in the district court, the Board need not consider the interplay with Section 44(h).” *Empresa VII*, 111 USPQ2d at 1064 (citations omitted). The view that the Board has greater statutory authority to cancel registrations than federal courts do is, however, no longer tenable following *B&B Hardware*.

Section 1067(a) says nothing about the IAC or any other grounds for cancellation, and does not give the Board superior rights to cancel a registration. The provision simply authorizes the Board to determine the right to register in opposition and cancellation proceedings. Even before *B&B Hardware*, it

was recognized that courts' authority to cancel registrations in an infringement action, which is created by 15 U.S.C. § 1119, is "concurrent" with the Board's cancellation authority. *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 9 F.3d 1091, 1092, 28 USPQ2d 1765, 1771 (4th Cir. 1993). Where there are limitations on the Board's authority to cancel, the courts' powers to cancel are subject to the same limitations. *Id.* at 1769. Thus, there was and is no statutory support for a conclusion that the Board has broader power than a federal court to cancel marks on IAC grounds. In any event, *B&B Hardware* eliminated the distinction between Board registration proceedings and court infringement proceedings that the Federal Circuit assumed in *Empresa VII*. The Supreme Court expressly held that "likelihood of confusion for purposes of registration is the same standard as likelihood of confusion for purposes of infringement," *B&B Hardware*, 113 USPQ2d at 2054, because the "operative language" of the relevant statutes "is essentially the same," *id.* (quoting, at n.3, 15 U.S.C. § 1114(1) (authorizing infringement suits) and 15 U.S.C. § 1052(d) (governing the right to register)), and because "district courts can cancel registrations during infringement litigation, just as they can adjudicate infringement in suits seeking judicial review of registration decisions." *Id.* (citing 15 U.S.C. § 1119).

The present case is on all analytical fours with *B&B Hardware*. As noted above, while the Board's precedents may differ with the Second Circuit's analysis and conclusion that Articles 7 and 8 of the IAC do not give foreign mark owners an enforceable right to cancel U.S. registrations, the legal standard governing cancellation in both proceedings is the *same*. Article 8 of the IAC is the *same* in this Proceeding and in the federal courts, just as the legal standard of likelihood of confusion in the court case and Board proceedings in *B&B Hardware* was the *same*, having been derived from virtually identical statutory language. *B&B Hardware*, 113 USPQ2d at 2054. Moreover, as noted above, the statutory power of the courts to cancel registrations under 15 U.S.C. § 1119 is the *same* as the Board's power to cancel registrations under 15 U.S.C. § 1067(a) – no more, no less.

At bottom, all the Federal Circuit opinion says is that, in proceedings initially tried to the Board where an IAC ground for cancellation is asserted, the Board interprets and applies the IAC differently than does the Second Circuit in cases tried in federal court. Under *B&B Hardware*, however, this difference is

no longer a basis to deny preclusive effect to the federal judgment, because, “if federal law provides a single standard, parties cannot escape preclusion simply by litigating anew in tribunals that apply that one standard differently.” 113 USPQ2d at 2054.¹⁵ That is precisely what CT is impermissibly attempting to do here – relitigate its loss on the IAC in the Federal Action because it is now in a forum which interprets that law differently, one of the “very evils that issue preclusion helps to prevent.” *Id.*

Thus, *B&B Hardware* created a clearly changed legal atmosphere which undermined the rationale of the Federal Circuit in *Empresa VII*, and the latter decision cannot be considered law of the case. Since all issue preclusion factors are satisfied here, the Board should dismiss CT’s IAC grounds for cancellation on the basis of issue preclusion. Moreover, the equities and considerations of finality that underlie the doctrine strongly support preclusion here. CT *chose* to litigate its IAC claim in District Court by initiating federal litigation and obtaining suspension of this Cancellation. Had it not done so, it could have had the advantage of this Board’s IAC jurisprudence, and in particular the Board’s decision in *British American Tobacco*. Instead, CT sought to convince the District Court to follow *British American Tobacco* and failed.¹⁶

II. CT HAS FAILED TO PROVE THE § 15 DECLARATION FILED IN CONNECTION WITH THE FIRST REGISTRATION WAS FRAUDULENT

CT’s Third Ground for Cancellation (61 TTABVUE 29, ¶ 107) seeks cancellation of GC’s First Registration on the ground that the §§ 8 and 15 Declarations (“§ 15 Declaration”) filed by GC for the First Registration were fraudulent.¹⁷ The Board should reject this claim under the authority of *In re Bose Corp.*,

¹⁵ The Federal Circuit also remarked that “the Second Circuit certainly did not address whether CT could request that the Board cancel the registrations directly under those same IAC provisions.” *Empresa VII*, 111 USPQ2d at 1064. This consideration is no longer relevant to issue preclusion in this case (if it ever was), because *B&B Hardware* does not require, for a judgment to be issue-preclusive, that the deciding court must append to the judgment an advisory opinion stating that the judgment would be preclusive in a later proceeding before a different tribunal.

¹⁶ See also *Mother’s Restaurant*, which found an earlier state court judgment preclusive in a later Board proceeding which had been stayed pending the completion of the litigation, saying: “Nor is this a case where a second proceeding involving the same issues was unforeseen ... MRI should have been aware of the possibility that the Board would accord preclusive effect to the state court findings.” 221 USPQ at 399. CT, like the petitioner in *Mother’s Restaurant*, chose to litigate its IAC issue in federal court first, and it is proper that it live with the decision of that court and not be allowed to relitigate it.

¹⁷ CT does not argue, and has therefore abandoned, its Second Ground for Cancellation, which asserted that the First Registration was obtained fraudulently. 61 TTABVUE 29, ¶ 104.

580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). To prevail under *Bose*, a petitioner must show clear, convincing, and unequivocal evidence that a registrant made (1) a false, material statement to the PTO, and (2) the registrant intended to deceive the PTO in making that statement. *Id.* at 1939. CT has shown neither element.

Fraud in obtaining or renewing a trademark registration occurs when a “registrant knowingly makes a false, material representation with the intent to deceive the PTO.” *Id.* at 1940-41. “A party seeking cancellation of a trademark registration for fraudulent procurement bears a *heavy burden of proof*” which must “be proven “to the hilt” with *clear and convincing evidence*. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Id.* at 1939 (citation omitted) (emphases added). “Unless the challenger can point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim.” *Id.* at 1942. Further, “there is a material legal distinction between a ‘false’ representation and a ‘fraudulent’ one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like.... In other words, deception must be willful to constitute fraud.” *Id.* at 1940 (citations and internal quotation marks omitted).

A. The § 15 Declaration Did Not Make a False Material Statement

On the first element of fraud (providing a false material statement), CT has not met its heavy burden under the “strictly applied” and “rigorous clear and convincing evidence standard.” *Enbridge, Inc. v. Excelerate Energy Ltd. P’ship*, 92 USPQ2d 1537, 1540, 1542 (TTAB 2009). CT claims that the statement in the § 15 Declaration, filed on June 23, 1986, of “continuous use in interstate commerce for five consecutive years from February 17, 1981 to the present,” was false because, from the issuance date of the First Registration (February 17, 1981), until November 1982, GC did not make continuous use of the COHIBA mark. CT is wrong: Under the Lanham Act as interpreted prior to the 1989 Trademark Law Revision Act (“TLRA”), GC’s use of the COHIBA mark during that period was sufficient to satisfy the “continuous use” requirement.

First, the evidence shows that during this short period, GC was in the process of commercially determining how the COHIBA cigar should be repositioned in the marketplace and was planning to commence large-scale sales of COHIBA cigars. During that time, GC developed a COHIBA cigar that would be manufactured in the Dominican Republic and sold “bundled” in a cylindrical plastic canister. *See supra* at 12-13.

Second, as shown in the Statement of Facts, from February 1981 through November 1982, at least hundreds of COHIBA cigars in a prior trade dress were publicly sold by GC through retailers. *Id.* at 12. These sales figures were not in dispute in the Federal Action. *See Empresa I*, 213 F. Supp. 2d 247, 257 (S.D.N.Y. 2002). Thereafter, GC began to sell much larger quantities of cigars through 1987. *Supra* at 12-13. Consistent with its commercial repositioning plans described above, GC then started to sell large volumes of COHIBA cigars: 90,000 in the last two months of 1982 alone, and over 500,000 additional cigars before the § 15 Declaration was filed. *Id.* As of the filing of the § 15 Declaration in June 1986, GC’s sales of COHIBA cigars to retailers had been continuously ongoing from 1978, as retailers sold their stock of cigars to the public. *Id.*

CT calls these sales from February 17, 1981 to November 1982 part of a “trademark maintenance program” (365 & 366 TTABVue 11-12, 15-16, 19-20), but the law, not labels, are what counts.¹⁸ Before enactment of the TLRA, many courts considered trademark maintenance programs legally sufficient to preserve acquired trademark rights.¹⁹ *See, e.g., P.A.B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328, 334 n.10, 196 USPQ 801, 806 n.10 (CCPA 1978) (“We note that the realities of commercial life may compel manufacturers to make initial, and continuing,

¹⁸ The Board must apply pre-TLRA law to determine whether GC’s use was sufficient to preserve the First Registration. *Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357, 90 USPQ2d 1301 (Fed. Cir. 2009).

¹⁹ CT also misuses the phrase “token use” to refer to sales in this period. “Token use” in pre-TLRA days meant minor uses of a mark that were sufficient to permit *registration* of a mark as long as the transaction was *bona fide* and the applicant intended to continue using the mark after registration. *Ralston Purina Co. v. On-Cor Frozen Foods*, 746 F.2d 801, 805, 223 USPQ 979, 982 (Fed. Cir. 1984); *Cnty. of Roquefort v. Santo*, 443 F.2d 1196, 1200, 170 USPQ 205, 208 (CCPA 1971). CT does not, however, contest the validity of the First Registration itself or assert that GC procured the First Registration through fraud.

use on a small scale in order to obtain, and maintain, registrations.... We are not convinced that this practice, per se, would necessarily raise a ‘specter,’ requiring forfeiture of the registrations.”); *Procter & Gamble Co. v. Johnson & Johnson Co.*, 485 F. Supp. 1185, 1207, 205 USPQ 697, 702 (S.D.N.Y. 1979), *aff’d*, 636 F.2d 1203 (2d Cir. 1980) (“P&G’s minor brands program might well be legally effective in other circumstances, as where a brand is reserved in connection with reasonably well-formulated plans to use it on a particular product under development, especially if the artificial maintenance does not continue for an unreasonably long time.”); *see also* 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:120 (5th ed.). All that matters is that the GC COHIBA-branded cigars were sold during the period, which they were. 342 TTABVUE 818 at 86:21-25; 820-850.

CT has not presented clear and convincing evidence that GC’s averment of continuous use in the § 15 Declaration was false. Between February 17, 1981, and November 1982, as the record shows, GC had “reasonably well-formulated plans to use [the COHIBA mark] on a [cigar] under development.” *Procter & Gamble Co.*, 205 USPQ at 716; *see supra* at 12-13. Twenty months between issuance of the First Registration and the commencement of large-scale sales of the GC COHIBA was not an “unreasonably long time” from a commercial perspective, and the sales made during that period were therefore “legally effective” to preserve GC’s rights in the First Registration and make the § 15 Declaration not false. *Procter & Gamble*, 205 USPQ at 702.²⁰ Also, GC’s declaration of continuous use could not have been false when there was substantial judicial authority at the time holding that such use was sufficient to preserve trademark rights.

B. CT Has Failed to Prove GC Willfully Intended to Defraud the PTO

CT also does not carry its “heavy burden” of proving “to the hilt” GC’s willful intent to defraud the PTO by “clear and convincing evidence.” *Bose*, 91 USPQ2d at 1939. Its sole evidence is a February 19,

²⁰ The “token use” cases cited by CT are not applicable: They involved situations where there were no shipments of goods with the mark at issue (*see, e.g., Times Mirror Mags., Inc. v. Sutcliffe*, 205 USPQ 656, 662 (TTAB 1979); *Dynamet Tech., Inc. v. Dynamet, Inc.*, 197 USPQ 702, 710 (TTAB 1977), *aff’d*, 593 F.2d 1007 (CCPA 1979); or where the practice of minor sales lasted for decades (*see, e.g., La Societe Anonyme des Parfums le Galion v. Jean Patou*, 495 F.2d 1265, 1272-74, 181 USPQ 545, 548-49 (2d Cir. 1974) (defendant had only eighty-nine sales of product bearing mark over twenty-year period)).

1982 memorandum to GC management from Charles Sparkes, the company's internal trademark manager, involving an unrelated third-party application to register a "COHIBA" mark, and relaying a comment by GC's outside counsel as to whether GC would risk cancellation of its First Registration if it opposed the other application. 194 TTABVUE 321-22. However, Sparkes was responsible for maintaining 350-400 trademarks for GC and for determining that the § 15 continuous use requirement was met before any § 15 Declaration was filed. Based upon his reading of PTO publications, he "had information of what was required for filing a Section 8 and a Section 15" and believed that the sales of COHIBA cigars during the relevant five-year period constituted continuous use in commerce for trademark purposes. 346 TTABVUE 286 (Sparkes Dep. 172:17-25); *id.* at 287 (173:2-174:4); *id.* at 410 (292:8-24); *id.* at 412-3 (294:8-295:8); *id.* at 413-4 (297:13-298:4). As noted above, there was contemporaneous legal support for Sparkes' belief. His un rebutted testimony conclusively establishes that CT has failed to meet the *Bose* standard of proving, by clear and convincing evidence, that the § 15 Declaration was filed by GC with willful intent to defraud the PTO. The Board should therefore dismiss the Third Ground for Cancellation.

III. CT HAS FAILED TO SHOW THAT GC ABANDONED ITS FIRST REGISTRATION

CT argues in support of its First Ground for Cancellation that GC abandoned the COHIBA mark registered under the First Registration by nonuse from 1987 to November 1992. 61 TTABVUE 29, ¶ 103. However, GC has produced substantial evidence showing that during the 1987-1992 period, GC always intended to resume use of the COHIBA mark when adverse conditions then affecting the U.S. cigar market ceased, that it took concrete steps to ready itself for resumed sales during this period, and that it immediately resumed use of the mark for cigars once the market for cigars improved. *Supra* at 12-14. GC has therefore rebutted any presumption of abandonment arising from the claimed period of nonuse. CT bears the ultimate "heavy burden" of proving that GC lacked intent to resume use, and its evidence does not carry that burden.

A. The Board Should Disregard The District Court's Erroneous Finding of Abandonment

CT's arguments are primarily reliant on the District Court's reversed and vacated conclusion that GC had abandoned the First Registration. 365 & 366 TTABVUE 21, 27. The Board should give no weight

to this contention.²¹ First, “abandonment is a question of fact,” *Azteca v. Martin*, 128 USPQ2d 1786, 1789 (TTAB 2018), and all of the District Court’s findings of fact were vacated when the Second Circuit reversed the District Court judgment and ordered the remaining claims to be dismissed. *Empresa V*, 73 USPQ2d at 1954. Second, the Second Circuit found that the District Court applied the wrong burden of proof on the issue of abandonment. The District Court had asserted that, “Defendants must come forward with objective, hard evidence of actual ‘concrete plans to resume use’ in ‘the reasonably foreseeable future when the conditions requiring suspension abate.’” *Empresa I*, 213 F. Supp. 2d at 268, quoting *Silverman v. CBS, Inc.*, 870 F.2d 40, 46, 9 USPQ2d 1778, 1782 (2d Cir. 1989). The Second Circuit expressly found, however, that the District Court’s statement of the burden of proof was erroneous: “We do not agree that *Silverman* imposed such a heavy burden. *Silverman* required that, to overcome a presumption of abandonment after a sufficiently long period of non-use, a defendant need show only an intention to resume use “within the reasonably foreseeable future.” *Empresa V*, 73 USPQ2d at 1940 n.2, quoting *Silverman*, 870 F.2d at 46, 9 USPQ2d at 1783. The *Silverman* standard, which the District Court misapplied, is the same standard for abandonment applied in Board proceedings. *Exec. Coach Builders, Inc. v. SPV Coach Co., Inc.*, 2017 WL 3034059, at *26, 123 USPQ2d 1175, 1199 (TTAB 2017). The District Court’s vacated finding of abandonment was thus based on legal error found by its own reviewing court and is entitled to not even persuasive weight in this Proceeding. The Board should reach its own conclusions as to whether the First Registration was abandoned.

B. The Relevant Burdens of Proof Where Abandonment Is Alleged

Abandonment occurs when use of a mark “has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127. The purpose of the abandonment doctrine is to prevent “warehousing” of marks and perpetually preventing their use by others. *See Imperial Tobacco Ltd., Assignee of Imperial Grp. PLC v. Philip Morris, Inc.*, 899 F.2d 1575, 1581, 14 USPQ2d 1390, 1394 (Fed. Cir. 1990). During the period of

²¹ A vacated court decision is “without any validity, force, or effect,” and must “be treated thereafter as though it never existed.” *Khadr v. U.S.*, 529 F.3d 1112, 1115 (D.C. Cir. 2008), quoting *Butler v. Eaton*, 141 U.S. 240, 244 (1891); *see also Rumsfeld v. Freedom NY, Inc.*, 329 F.3d 1320, 1332 (Fed. Cir. 2003).

time addressed by the First Ground for Cancellation, nonuse of a mark for two consecutive years was considered prima facie abandonment, and the Board must apply the earlier law here. *Hornby*, 87 USPQ2d at 1422. The statutory presumption of abandonment only shifts “the burden of going forward (burden of production) ... to the trademark registrant.” MCCARTHY § 17:21, citing *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1026, 13 USPQ2d 1307, 1312 (Fed. Cir. 1989). “The ultimate burden of proof does not shift and remains with the challenger.” MCCARTHY § 17:21, citing *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1417 (TTAB 2016). The registrant may carry its burden of going forward by “provid[ing] evidence of an intent to resume use [during the period of nonuse] to disprove the presumed fact of no intent to resume use.” MCCARTHY § 17:21. Once the presumption is rebutted and the burden of persuasion returns to the challenger, the latter bears a “heavy burden” to establish abandonment. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1031, 213 USPQ 185, 191 (CCPA 1982).

In determining whether a registrant had an intent to continue use during a period of nonuse, the Board may consider evidence of the registrant’s practices occurring before or after the period of nonuse, and infer from that evidence that the registrant intended to resume use during that period. *See Exec. Coach Builders*, 123 USPQ2d at 1199, citing *Crash Dummy Movie LLC v. Mattel Inc.*, 601 F.3d 1387, 94 USPQ2d 1315, 1317 (Fed. Cir. 2010). “A proprietor who temporarily suspends use of a mark can rebut the presumption of abandonment by showing reasonable grounds for the suspension and plans to resume use in the reasonably foreseeable future when the conditions requiring suspension abate.” *Exec. Coach Builders*, 123 USPQ2d at 1199. The test is whether the activities during the period of nonuse are those “that a reasonable business with a bona fide intent to use a mark in U.S. commerce would have undertaken.” *Id.*

C. Non-Use Is Excused Where Caused by Adverse Business Conditions Coupled With an Intent to Resume Use When Conditions Improve

A reasonable business explanation coupled with an intention to resume use of a mark in the foreseeable future will excuse non-use and rebut any presumption of abandonment. *Silverman*, 9 USPQ2d at 1783; *Miller Brewing Co. v. Oland’s Breweries (1971) Ltd.*, 548 F.2d 349, 352 (CCPA 1976) (plaintiff

did not intend to abandon where nonuse was due to economic reasons). Temporary nonuse caused by depressed market conditions is a reasonable business explanation that will excuse nonuse. *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, 769 F.2d 1393, 1396, 227 USPQ 44, 46 (9th Cir. 1985) *Silverman*, 9 USPQ2d at 1783 (recognizing no abandonment where owner lacked business opportunities during period of nonuse).

D. GC Has Rebutted Any Presumption of Abandonment

GC's contemporaneous evidence rebuts any presumption that it did not intend to resume use of the COHIBA mark during the 1987-1992 period. It is undisputed that the overall U.S. cigar market was at its nadir during this entire period, as a history of the industry appearing in *Cigar Aficionado* described: "The year was 1992. The American cigar industry was in poor shape. The customer base was aging and contracting, sales had been in a steady 30-year decline.... American cigar consumption was spiraling to all-time lows, having dropped by more than 66 percent between the mid-1960 and early 1990s." 283 TTABVUE 114 (Abbot Decl., Ex. M); 345 TTABVUE 405 at 117:10-14, 722 at 38:3-22; 338 TTABVUE 207-209 at 257:12-14, 260:2-5; *see* 341 TTABVUE 5, ¶ 10 (Testimony of Edgar Cullman, Jr.) ("The late 1980s and early 1990s were a low point of the industry").²²

The facts show from 1987 through 1992 – the low point of the U.S. cigar market – GC nonetheless continued to intend to commercialize a COHIBA cigar and took actual steps to ready the mark for use. Prior to 1987, GC sold its COHIBA cigars in a upscale bundle, which it felt might create opportunity in the lower end of the premium cigar market, but this was "never a commercial success" and "did not work in the market place." 341 TTABVUE 11-12, ¶¶ 37, 40-41. A decision was made to consider repositioning COHIBA as a premium brand. During the 1987-1992 period, there were numerous internal discussions at GC about redeveloping COHIBA as a "super-premium, very expensive cigar manufactured from a unique blend with a robust flavor." *Id.* at 12, ¶ 44. GC needed to develop the right marketing approach for the new COHIBA: There were a "lot of meetings and conversations" during this period to develop the COHIBA marketing. *Id.* at 13, ¶ 47.

²² During the relevant period, Mr. Cullman was President and CEO of GC. *Id.* at 3, ¶ 1.

By April 1989, “there were internal discussions at General Cigar about the re-launch of the COHIBA as a premium cigar in the U.S.” *Id.* at 58, ¶ 7 (Testimony of Ronald S. Milstein). GC was also exploring whether it was permissible to use elements of the CT Cohiba trade dress in conjunction with GC’s COHIBA word mark on cigars sold in the U.S., just as GC and other manufacturers do with parallel brands such as PARTAGAS. Starting in April 1989, the internal legal department at GC began discussions with GC’s outside counsel as to the use of this trade dress on the relaunched COHIBA cigar, and what steps would be needed to do so. *Id.* at 59-60, ¶¶ 8-10, 180 TTABVUE 591-593, 183-184 (D256, 279). During the same period, GC management continued to consider use of elements of the Cuban Cohiba trade dress in the U.S. and to consult with GC’s counsel on this point. 341 TTABVUE 61-62, ¶¶ 14-15.

Additional contemporaneous evidence of no GC intent to abandon the COHIBA mark is shown in GC’s 1987 consultation with outside counsel about letting certain of its registered cigar marks “run to expiration,” rather than assigning them to a new corporate entity. 291 TTABVUE 1089-93 (Exs. 69-70). GC prepared a list of twenty-nine marks which it owned which it did not have “any real interest in pursuing.” *Id.* at 1089-91 (Ex. 69); 346 TTABVUE 418-19 (Ex. 100) (Sparkes 304:18-306:6). GC instructed its counsel that, with respect to the listed marks, “[i]f Section 8 Declarations become due, or an action by a third party arises, please inform us so we may consider early abandonment as we do not wish to incur extra expense with these registrations.” 291 TTABVUE 501-2 (Ex. 69); *see also id.* at 1092-93 (Ex. 70). *GC did not include COHIBA on the list of registrations it intended to abandon.*

As shown *supra* at 11, 14, a “boom” in U.S. premium cigar sales began in late 1992, and GC immediately responded to the changed market conditions by moving to market in late 1992 with a relaunched COHIBA sold in large quantities through Alfred Dunhill and Mike’s Cigars. This prompt resumption of sales demonstrates that GC never intended to abandon its COHIBA registered mark, was simply waiting for market conditions to improve, and returned to using the mark as soon as they did improve. 341 TTABVUE 15, ¶¶ 52-56 (Cullman Jr. Decl.). This shows that GC had “reasonable grounds for the suspension” – inarguably depressed conditions in the cigar market as of 1987 – and “plans to resume use in the reasonably foreseeable future when the conditions requiring suspension abate,” as demonstrated

by GC's prompt return to the market. *Exec. Coach Builders*, 123 USPQ2d at 1199. *See Star-Kist*, 227 USPQ at 46 ("Star-Kist's predecessors ceased using the trademarks in the United States during the period in question due to the unprofitability of importing fish into the United States, but that they intended to and did resume use of the trademarks when profits could again be made."). GC's evidence of subsequent use may be used to establish that during the 1987-1992 period, GC intended to resume use. *See MCCARTHY* § 17:16. Because GC's nonuse was excusable, it "has overcome the presumption that its nonuse was coupled with an 'intent not to resume use.'" *Imperial Tobacco*, 14 USPQ2d at 1395.

The burden of persuasion on intent to abandon thus shifts back to CT, which cannot meet it. The nonuse cases on which CT relies are distinguishable – most significantly, because none of the parties showed a valid economic reason for ceasing use of a mark and prompt resumption of the use once the economic excuse ended.²³ Accordingly, the Board should reject GC's abandonment claim and affirm the continued validity of the First Registration.

IV. CT'S CLAIM UNDER LANHAM ACT § 2(d) SHOULD BE REJECTED

CT's Sixth Ground for Cancellation, directed to the Second Registration only, is based upon § 2(d) of the Lanham Act. 61 TTABVue 30, ¶ 113. CT bears a substantial burden of proof on this claim, because GC has used its COHIBA mark on premium cigars for nearly thirty years, and has established its COHIBA cigar as one of the best-known cigar brands in the U.S. "Cancellation of a valuable registration around which a large and valuable business goodwill have been built should be granted only with 'due caution and only after a most careful study of all the facts.' Petitioner, to sustain its burden of proof, must leave nothing to conjecture." *Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F.2d 552, 555, 152 USPQ 599, 601

²³ In *Imperial Tobacco*, the registrant did not show any reasonable economic reasons for ceasing to use the JPS mark for cigarettes, and its evidence showed only that during nonuse it was considering marketing and licensing "incidental" products like whisky, pens, and watches under the JPS mark. *Id.* at 1395-96. In *Rivard v. Linville*, 133 F.3d 1446, 1449-50, 45 USPQ2d 1374, 1376-77 (Fed. Cir. 1998), the registrant failed to show any credible business reason for ceasing use, and only acted to license his mark to others after receiving notice of the cancellation proceeding. In *Exec. Coach Builders*, 123 USPQ2d at 1199, the registrant had discontinued use of its mark for more than twenty years, presented no reasonable justification for the discontinuation, and cited no evidence showing a contemporaneous intent to resume use in the future. In *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1487-8 (TTAB 2017), the opposer offered no excuse for ceasing to use the mark other than that a lease of a restaurant space had expired.

(CCPA 1967) (citation omitted). Moreover, CT was aware of GC's sales of its COHIBA cigar in the U.S. from an early date, knew that GC had filed its application for the Second Registration when it occurred, voluntarily chose not to oppose the application, and chose to file its cancellation petition only after GC had made substantial sales of COHIBA cigars between 1992 and 1997. Even though CT must carry its burden only by a preponderance of the evidence, "where a lengthy period of time ensues between registration and the cancellation request, the Board is required to pay even closer attention to the proof adduced to buttress the cancellation request." *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 123, 68 USPQ2d 1225, 1246 (D.D.C. 2003).

CT does not carry its heavy burden on its § 2(d) claim, which requires both proof of CT's prior *use* in the U.S. of a Cohiba mark and a likelihood of confusion arising from GC's use of the COHIBA mark. CT has *never* used a Cohiba mark in the U.S. because of the Embargo and will not do so in the foreseeable future. It attempts to bridge this chasm in its proof by citing the doctrine of "analogous use," but this is sleight-of-hand: in reality, CT is relying on the fame allegedly acquired in the U.S. for CT Cohiba cigars sold only outside the U.S. This is not "analogous use," but the "well-known marks" theory that the Board has decisively rejected as a basis for § 2(d) priority. *Sun Hee Jung v. Magic Snow*, 2014 WL 4174422, 124 USPQ2d 1041 (TTAB 2017). Moreover, CT has never sold any cigars under its "Cohiba" mark in the U.S. "Analogous use" of a mark without subsequent sales of goods in the U.S. under the mark is not sufficient to meet the *statutory* requirement of Section 2(d) that the challenger to a registration have "previously used its mark in the United States." Additionally, as shown below, CT fails to carry its heavy burden of proving likelihood of confusion under § 2(d).

A. CT's Priority Claim is a Re-Labeling of The "Well-Known Marks" Theory CT Pursued in the Federal Action, Which Does Not Provide a Basis for a § 2(d) Cancellation Under Board Precedent

Section 2(d) of the Lanham Act permits cancellation of a registration where a non-incontestable mark "consists of or comprises a mark which so resembles ... a mark or trade name previously *used* in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d) (emphasis

added); *see also id.* § 1064. “Hence, a party petitioning for cancellation under section 2(d) must show that it had priority and that registration of the mark creates a likelihood of confusion.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). On the issue of priority, “[t]he express statutory language of Section 2(d) requires prior use of a mark in the United States by the [challenger].” *Sun Hee Jung*, 124 USPQ2d at 1043.

“Because the concept of territoriality is central to trademark law, a Section 2(d) claim cannot be based on foreign use of a mark.” *Brouwerij Nacional Balashi NV v. t & beer, inc.*, Opp. No. 91223456, 15 TTABVUE 9-10, 2016 WL 6833497, at *5 (TTAB Aug. 25, 2016) (non-precedential), citing *Person’s Co. Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479-80 (Fed. Cir. 1990); *Aktieselskabet af 21. Nov. 2001 v. Fame Jeans Inc.*, 77 USPQ2d 1861, 1864 (TTAB 2006), *aff’d*, 525 F.3d 8, 86 USPQ2d 1527 (D.C. Cir. 2008). This use requirement led the Board to reject § 2(d) claims where priority was based on the assertion that a mark on goods sold abroad had become famous among U.S. consumers. “Under the ‘well known mark’ doctrine ... a party asserts that its mark, while as yet unused in the United States, has become so well known here that it may not be registered by another.... However, the ‘well known mark’ doctrine provides no basis for a Section 2(d) ground for opposition because it does not establish use of the mark in the United States as required by the statutory language of that section. Recognition in the United States is not the same as use in the United States[.]” *Sun Hee Jung*, 124 USPQ2d at 1043-44 (citations and internal quotation marks omitted). Thus, the Board found no use in the U.S. where a Korean opposer claimed its marks were exposed on its website and social media and were known to Korean-Americans who travel to Korea, *Sun Hee Jung*, 124 USPQ2d at 1043-44, or where American tourists might purchase beer sold in Aruba and bring it back to the U.S. to share with friends. *Brouwerij Nacional Balashi*, 15 TTABVUE 10. *See also Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1591 (TTAB 2009) (dismissing § 2(d) claim where no allegation that products “were manufactured or distributed in the United States by petitioner” or an authorized licensee).

CT has never sold Cohiba cigars or made any actual use of a Cohiba mark in U.S. commerce. CT’s uses of a Cohiba mark have occurred entirely outside of the U.S., and its priority argument relies entirely

on fame for the CT Cohiba cigar supposedly won in the U.S. through coverage of CT's foreign uses, through the initial September 1992 issue of *Cigar Aficionado* and visits to Cuba by American tourists. 61 TTABVUE 21, ¶¶ 60-76, 82. This is indistinguishable from the "well-known marks" theory argued by CT in the District Court, where it cited this *identical* press coverage as showing that the CT Cohiba cigar had acquired fame in the U.S., and that it thus had priority over GC in the U.S. COHIBA mark. The District Court agreed and found priority in the U.S. solely on the basis of Cohiba being a "famous mark." 70 USPQ2d at 1675-82. However, the District Court's ruling was vacated by the Second Circuit, *Empresa V*, 73 USPQ2d at 1954, and shortly thereafter, both the Second Circuit and the Board rejected the "famous marks" theory, holding that priority could not be obtained under § 2(d) because a mark only used abroad had obtained renown in the U.S. *See ITC Ltd v. Punchgini, Inc.*, 482 F.3d 135, 162-65, 82 USPQ2d 1414, 1431-34 (2d Cir. 2007); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d at 1591; *Fiat Grp. Autos. S.P.A. v. Ism, Inc.*, 94 USPQ2d 1111, 1112-13 (TTAB 2010); *Sun Hee Jung*, 124 USPQ2d 1041.

CT has done nothing more in this trial than to relabel the "famous marks" theory of priority it argued in the Federal Action as one for "analogous use." There is no difference between the two arguments or the facts beyond the new label: CT is still unable to show any sales of its Cohiba cigars in the U.S. or other actual use of its mark in U.S. commerce, and is still relying on fame in the U.S. allegedly acquired through press coverage of the CT Cohiba which is sold only abroad. CT's relabeled "famous marks" or "well-known marks" claim does not satisfy § 2(d)'s requirement of prior use in commerce. *See supra* at 37. The Board should therefore dismiss the § 2(d) claim for CT's failure to show that it used a Cohiba mark in the U.S. prior to the first use date claimed in GC's Second Registration.

B. CT Has Not Shown "Analogous Use" of the COHIBA Mark In the U.S.

A second reason for rejecting CT's § 2(d) claim is that its evidence does not meet settled requirements for obtaining U.S. priority via "analogous use." "[S]ome form of pre-sales activity can constitute 'trade name' use to establish priority so as to prevent registration of a mark to another who was first to actually sell goods under the mark." MCCARTHY § 16:14. "The key is that any such pre-sales activity 'must have been of such a nature and extent as to create an association in the mind of the consuming public

between the mark and the services to be rendered.” *Id.*, citing *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d 75, 198 USPQ 271 (CCPA 1978). Because § 2(d) requires “use[] by another,” the challenger must show that *it* made the analogous use, not someone else. Thus, as shown in the cases cited by CT, priority through analogous use requires substantial advertising, promotion, or non-sales activities in the U.S. *by the priority claimant itself*.²⁴ In contrast, [REDACTED]

[REDACTED] (a publication sold outside as well as in the U.S.), CT has not alleged it engaged in any advertising, marketing, or public relations in the U.S. using the Cohiba mark before GC’s first use date of December 31, 1992 claimed in the Second Registration.

Moreover, mention of a mark in a single magazine does not attest to the level of recognition that the analogous use doctrine requires. *See T.A.B. Sys.*, 37 USPQ2d at 1884 (one story in a national trade wire service and eleven articles appearing in various publications in a two-month period, which “were not advertisements per se but news articles,” found insufficient); *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, 569 F.2d 1130, 1133, 196 USPQ 808, 810 (CCPA 1978) (twelve stories “in various newspapers and trade journals” over a four-month period held insufficient).

Fatally for its analogous use argument, CT has never actually used its Cohiba mark on cigars sold in the U.S. No amount of advertising or promotion of a product without sales of the product under the mark will confer priority rights over one who actually uses the mark. “[A]ctual, technical trademark use must follow the use analogous to trademark use within a commercially reasonable period of time.” *Dyneer Corp. v. Auto. Prods. Plc.*, 37 USPQ2d 1251, 1255, 1995 WL 785742, at *5 (TTAB 1995). “[P]rior use and

²⁴ *See T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1376, 37 USPQ2d 1879, 1881-84 (Fed. Cir. 1996) (defendant’s own advertising expenditures deemed insufficient to establish analogous use); *Herbko Int’l*, 64 USPQ2d at 1378-80 (defendant’s use of its mark in a book title held insufficient); *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1578, 19 USPQ2d 1424, 1429 (Fed. Cir. 1991) (extensive use of ACE abbreviated trade name in organization’s publications and correspondence and in its references to its award program deemed sufficient); *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065-66, 11 USPQ2d 1638, 1639-40 (Fed. Cir. 1989) (use of mark in product guides and in invoice deemed sufficient); *Am. Stock Exch., Inc. v. Am. Express Co.*, 207 USPQ 356, 363-64 (TTAB 1980) (opposer had extensively represented itself as AMEX in publications, films, studies, and advertisements and acquired priority of term in investment services).

advertising of a mark in connection with goods or services marketed *in a foreign country* (whether said advertising occurs inside or outside the United States) creates no priority rights in said mark in the United States as against one who, in good faith, has adopted the same or similar mark for the same or similar goods or services in the United States prior to the foreigner's first use of the mark on goods or services sold and/or offered in the United States." *Mother's Rests. Inc. v. Mother's Other Kitchen, Inc.*, 218 USPQ 1046, 1048 (TTAB 1983) (emphasis added);²⁵ see also *Adolphe Lafont, S.A. v. Ellera, S.P.A.*, 228 USPQ 589, 595 (TTAB 1985). Here, almost thirty years has passed since CT's alleged events of "analogous use" in 1992 with no sales of the CT Cohiba cigar in the U.S., which certainly exceeds a "reasonable time" by which sales must begin.

CT raises the Embargo as its excuse for nonuse of the mark in the U.S., but cites no precedent where the Board has granted § 2(d) priority to a Cuban entity which has never sold goods in the U.S., and thereby ignored the § 2(d) *statutory* requirement of actual use in the U.S. Indeed, *Taboca AS v. Philip Morris USA, Inc.*, Opp. No. 91172571, 25 TTABVUE, 2007 WL 4616272 (TTAB Dec. 18, 2007) (non-precedential), strongly suggests that there is no such excuse. See *id.*, 25 TTABVUE 14, 14 n.6 (dismissing opposition where opposer's tobacco products "[we]re precluded from the U.S. market due to the U.S. trade embargo against Cuba," and any sale of the product in the U.S. would have been illegal and "hardly qualifies as use of the designation in the United States").

The non-precedential decision of *Archeabala v. Havana Rums and Liquors, S.A.*, Cancellation No. 22,891 (TTAB Oct. 19, 1996), cited by CT, does not help its position. The Board there relied on the statutory provisions of § 8 of the Lanham Act (15 U.S.C. § 1058(b)(2)(B)), which, unlike § 2(d), expressly provides that a § 8 declaration of continued use for an already-registered mark may "include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark," and deemed the Embargo to be "special circumstances," citing precedents holding that trademark

²⁵ *Mother's Restaurants* suggested that a "famous" mark never used in the U.S. might still acquire priority, but this suggestion was definitively rejected by the Board's later decision in *Sun Hee Jung* rejecting the "well-known marks" theory. 124 USPQ2d at 1043-44. In addition, knowledge of a foreign use of a mark does not preclude good faith adoption and use in the U.S. *Person's*, 14 USPQ2d at 1480.

rights, once acquired, cannot be lost because use of the mark is prohibited by law. But neither *Archeabala* nor any other precedent cited by CT holds that prior trademark rights can be *acquired* under § 2(d) in the absence of use or analogous use followed by commercial use. Such a rule would allow substantial abuses by a Cuban entity, which could cancel any U.S. registration merely by alleging that it would have entered the U.S. market with the same mark at an earlier date than the registrant, but for the Embargo. In short, CT's § 2(d) ground fails for absence of proof of prior use. The Board need not consider likelihood of confusion and should dismiss on that basis alone.

C. CT Has Not Carried Its Heavy Burden of Proving Likelihood of Confusion

CT also has “the burden, at trial, of proving ... likelihood of confusion, in addition to its priority of use.” *Dyneer Corp.*, 37 USPQ2d at 1257. CT fails that burden as well. Its evidence (most of which is inadmissible, for reasons detailed in GC's separate evidentiary objections), does not show that, at the time of trial, U.S. premium cigar smokers are likely to be confused from GC's use of the COHIBA mark registered in the Second Registration.

There are several unique aspects to this case that require discussion before analyzing the more traditional *DuPont* confusion factors. First, in weighing confusion, the Board looks to evidence of likelihood of confusion as of the time of trial. *See Hornby*, 87 USPQ2d at 1416. CT improperly asks the Board to weigh potential confusion not on today's facts, but as of a hypothetical date in the far future when an imaginary future Congress may repeal the statutory prohibitions on trade with Cuba and an imaginary future President signs such legislation.²⁶ 365 & 366 TTABVue 37-39. This request flouts the settled rule that facts on confusion are assessed at the time of trial and asks the Board to issue an impermissible advisory

²⁶ Because the Cuban government that succeeded Fidel Castro has shown itself to be just as repressive of the freedoms of the Cuban people as when he was alive, and the U.S. has consequently imposed additional sanctions on Cuban officials, *see, e.g.*, Miami Herald, “Biden sanctions more Cuban officials for repression of July 11 protesters” (Aug. 13, 2021), available at <https://www.miamiherald.com/news/nation-world/world/americas/cuba/article253471284.html>, the chances of any change in U.S. Cuban trade policy are likely worse now than when this Cancellation commenced.

opinion. *Windsurfing Int'l Inc. v. AMF Inc.*, 828 F.2d 755, 758, 4 USPQ2d 1052, 1055 (Fed. Cir. 1987) (“a federal court may not give” an advisory opinion).

CT tries to yoke its request to speculate on the future to the *DuPont* factor of “area of probable expansion.” None of the decisions CT cites, however, has ever held that a territory where sale of a product is illegal is an area of probable expansion for that product. To the contrary: In *Taboca AS* (non-precedential), the Board rejected a § 2(d) claim based partly on the fact that the opposer could not sell its tobacco products in the U.S. because, “to the extent that opposer’s products bearing the TABOCA designation are of Cuban origin, they are precluded from the U.S. market due to the U.S. trade embargo against Cuba.” *Id.*, 25 TTABVUE 14.²⁷ Moreover, the cases cited by CT (365 & 366 TTABVUE 37-38), all involve expansion from one portion of the U.S. to another. No case cited by CT holds that, where a mark is exclusively used *in a foreign* country, as CT’s Cohiba mark is, the U.S. is a natural market of probable expansion for the mark.

Where real rather than imaginary facts are considered, analysis of likelihood of confusion is not an abstract exercise. Rather, the Board must consider “not only the marks but the goods and the whole situation, as revealed by the record, as it bears on their distribution in the market,” and whether there is a “practical likelihood of such confusion, mistake, or deception We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969). Moreover, prior rulings in other cases involving different products and markets are “of little value,” because evaluation of likelihood of confusion “is subjective and requires ... a consideration of the probable psychological reactions of potential

²⁷ CT cites to an Examining Attorney’s brief in an *ex parte* appeal involving a claim that a rum mark, OLD HAVANA, was geographically deceptively misdescriptive. Opp. No. 75010230, 29 TTABVUE 15-17. However, the Board decision on which the Examining Attorney relied, *In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945-46 (TTAB 2000), noted a similar argument but made no reference to the Embargo, finding that a “Royal Havana Resort and Casino” mark had primary geographic significance and refused registration.

purchasers to the respective marks.” *Star Watch Case Co. v. Junghans*, 267 F.2d 950, 952, 122 USPQ 370, 371 (CCPA 1959); *see* MCCARTHY § 23.31.

In this case, it is appropriate to consider evidence on the final factor in the *DuPont* list first – “any other established fact probative of the effect of use.” 476 F.2d at 1361.²⁸ The cigar market is not like any other product market in the U.S.: it has been operating for six decades under the Embargo, which prohibits the sale of Cuban cigars in this country (*supra* at 9-10); there is a practice of “parallel brands,” under which non-Cuban cigars are sold in the U.S. under the same brands as Cuban cigars sold outside of the U.S. (*id.* at 9); and the trademark dispute between GC and CT has been widely covered in the cigar and general press, further alerting the public that the GC COHIBA and CT Cohiba have different origins. These facts sharply minimize the likelihood that today’s cigar consumers will be confused by GC’s longtime use of its COHIBA mark in the U.S. for non-Cuban cigars, and affect the relevance and weight that the Board should give to evidence on the other *DuPont* factors.

First, the Embargo, and the inability to buy Cuban cigars in the U.S., is a fact widely known to cigar smokers. The Embargo and the legal prohibition on sale of Cuban cigars in the U.S. has been repeatedly explained over the decades in dozens of articles in *Cigar Aficionado* (which CT claims is read by a majority of cigar smokers and was the only cigar publication such consumers read for many years (365 & 366 TTABVUE 30)), as well as other cigar-oriented publications and the general press and media. *See* 284 TTABVUE 2-138 (Annex S).

Richard Carleton Hacker, a renowned cigar expert who wrote *The Ultimate Cigar Book*, the leading guide to cigars for U.S. consumers (now in its fourth edition), who was a contributing editor to *Robb Report* until 2019 and published hundreds of articles on cigars, and who has met and spoken with many U.S. cigar consumers as part of his professional activities, testified that today’s cigar consumer is far better informed and more sophisticated about the origin and nature of premium cigars than at the time of the Federal Action.

²⁸ These facts also bear on the third *DuPont* factor, “similarity or dissimilarity of established, likely-to-continue trade channels,” the fourth factor, “conditions under which, and buyers to whom, sales are made,” *i.e.*, impulse vs. careful, “sophisticated” purchasing, and the eighth factor, “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.”

273 TTABVUE 8-9. In his opinion, even potential smokers of premium cigars know about the Embargo and its ban on U.S. sales of Cuban cigars, and that any cigar bought from a U.S. seller is not Cuban in origin. *Id.* at 10. Potential and actual smokers of premium cigars know that the COHIBA cigar sold in the U.S. is “completely different and unconnected to the Cuban cigar,” *id.* at 11, because (a) one can buy the U.S. COHIBA in the U.S., and no Cuban cigars can be sold in the U.S., (b) books and publications read by cigar smokers, including Hacker’s own book, point out that the GC COHIBA and Cuban Cohiba are different cigars from different manufacturers with different tobacco, and (c) the trade dress and bands of the COHIBA cigar sold in the U.S. have a clearly different appearance from those of the Cuban Cohiba. *Id.* at 11-12; *see also* 362 TTABVUE 816-21 (Hacker Dep. 125:12-130:16) (specifying differences in trade dress). GC’s trial and deposition witnesses also testified, on the basis of their broad contact with consumers of GC’s products, that consumers of premium cigars were well aware of the Embargo and that the COHIBA cigar purchased in the U.S. was not a Cuban product.²⁹ 342 TTABVUE 282-326 at 19:3-10, 70:19-71:13, 73:13-16, 76:7-78:8; 343 TTABVUE 7-25 at 11:21-23, 18:15-17, 19:2-6, 41:8-19; 273 TTABVUE 8, 11-12; 343 TTABVUE 804 at 18:13-15, 829 at 66:13-15, 870-871 at 197:25-198:15. Finally, CT, which bears the burden on all aspects of its § 2(d) claim, produced no testimony from any U.S. cigar consumer stating that he or she was unaware of the Embargo prior to purchasing a COHIBA cigar in the U.S.

CT cites decisions of the Board in which knowledge of the Embargo was addressed in proceedings involving whether a mark was primarily geographically misdescriptive under Lanham Act § 2(e)(3). 365 & 366 TTABVUE 53-54, n.69. These decisions have no application to a § 2(d) claim, however, where consumer confusion, not misdescription of geographical origin, is at issue. In *In re Bacardi & Co, Ltd.*, 48 USPQ2d 1031 (TTAB 1998), the Board stated that the relevant question was whether consumers would make a goods/place association for a number of applied-for marks containing HAVANA. It concluded that

²⁹ Alan Willner, an ex-GC employee formerly in charge of marketing whose direct testimony was submitted by CT on its behalf, testified on cross-examination that as part of his GC work responsibilities he visited approximately seventy cigar stores each year, and was never told by any employee that any customer of the store ever expressed confusion about the origin of the GC COHIBA. 361 TTABVUE 46-7 (Willner Dep. 44:18-45:19).

the Embargo was irrelevant to this inquiry because the only issue was whether consumers would assume goods with the HAVANA name would originate in that city, stating that, “regardless of the existence of trade sanctions against Cuba, we have determined that the marks herein would be subject to refusal under either Section 2(e)(2), if the identified goods are intended to originate in HAVANA, or Section 2(e)(3), if the identified goods are not intended to originate in HAVANA.” *Id.*, 48 USPQ2d at 1036. In contrast, a cigar smoker’s knowledge of the Embargo is directly relevant to whether that consumer may be confused into believing that the COHIBA cigar that can be bought in a U.S. cigar store or from a merchant website originates with a Cuban manufacturer.

The parallel brands practice, *see supra* at 9-10, also minimizes the likelihood of confusion among cigar smokers. Cigar expert Hacker testified that American cigar consumers are familiar with the parallel brands practice, with the “great majority” being aware that the non-Cuban and Cuban cigars sold under the same brands in different countries are not connected. 362 TTABVUE 833-4 (Hacker Dep. 142-4:143:5). Moreover, the facts about parallel brands, including the absence of connection between the non-Cuban and Cuban cigars, are frequently covered in publications that U.S. cigar consumers are likely to read, including *Cigar Aficionado* (which mentions COHIBA as one of the parallel brands with a Cuban counterpart), and other cigar-oriented and general publications. *See* 284 TTABVUE 139 (Abbot Decl. ¶ 39, Annex T).

Finally, since the late 1990s, there have been dozens of articles in *Cigar Aficionado* (which, again, CT claims is widely read by cigar smokers), and other smoker-oriented and general media which discuss the progress of the ongoing trademark dispute between GC and CT over ownership of the COHIBA mark in the U.S. 283 TTABVUE 28-9, 284 TTABVUE 139, 145 (Abbot Decl. ¶ 45 and Annex T, V). These articles all take care to explain to the reader that the GC COHIBA and Cuban Cohiba are two separate cigars, originating with different manufacturers who are at legal war with one another (a fact negating CT’s speculation that some cigar smoker might think CT has licensed GC to use the COHIBA mark in the U.S.).

Thus, in the “practicalities of the commercial world,” *Witco Chem. Co.*, 418 F.2d at 1405, potential U.S. consumers of cigars have been exposed to and know about the unavailability of Cuban cigars in the U.S., know that many non-Cuban cigars are sold in the U.S. under one mark while Cuban cigars bearing

the same mark but made by a different manufacturer are sold outside of the U.S. (COHIBA being one of these marks), and know that the maker of the non-Cuban COHIBA cigar sold in the U.S. and the maker of the Cuban Cohiba cigar sold outside of the U.S. are not only not connected or associated, but also have been litigating over ownership of the mark for over twenty years. Given this unique consumer market and unique set of commercial facts, the Board should accord no weight to the parties' use of identical word marks for cigars (*DuPont* factors one and two). In every case cited by CT on these factors, the senior and junior parties' products could both legally be sold in the U.S. market and there was no established practice of using the same mark by two unconnected manufacturers inside and outside of the U.S.

CT's own discussion of the thirteenth *DuPont* factor wrongly argues that GC's U.S. actions to enforce its registered COHIBA mark "effectively concede likelihood of confusion." 365 & 366 TTABVUE 42. In reality, GC has enforced its rights in COHIBA against all infringers, both those seeking to sell counterfeit GC COHIBA cigars and those seeking to sell or import counterfeit or actual CT Cohiba cigars. All this shows is that GC protects its valuable COHIBA mark against all infringers; it is no evidence of consumer confusion. 276 TTABVUE 8-11 at ¶¶ 20-27, 13-95 (Annex A); 355 TTABVUE 748-51 (McKee 52:20-55:5 ("General Cigar protects its ownership of the COHIBA word in the U.S., the COHIBA mark in the U.S., so that's what these seizures would have been about, about protecting that trademark"); 169 TTABVUE 11-13, 486-679.

The third *DuPont* factor, "similarity or dissimilarity of established, likely-to-continue trade channels," cuts sharply against confusion. It is indisputable that Cuban Cohiba cigars are not sold in the same U.S. channels of trade as the GC COHIBA cigar, because the Cuban product cannot be legally sold by any U.S. merchant, whether a brick-and-mortar store or internet seller, and has not been advertised in the U.S. except on two occasions in 1992.³⁰

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The fourth *DuPont* factor, the conditions under which, and buyers to whom, sales are made, *i.e.*, “‘impulse’ vs. careful, sophisticated purchasing,” also weighs against confusion. Consumers of premium cigars are “sufficiently enthusiastic ... to spend a significant amount of money on that pleasure, and are therefore presumably discerning purchasers.” *General Cigar Co., Inc. v. G.D.M., Inc.*, 988 F. Supp. 647, 664, 45 USPQ2d 1481, 1495 (S.D.N.Y. 1997). *See also Camacho Cigars, Inc. v. Compania Insular Tabacalera, S.A.*, 171 USPQ2d 673, 674 (D.D.C. 1971) (premium cigar purchasers “are careful, well-informed buyers”). These past observations are confirmed in the present by competent testimony in this case that potential U.S. buyers of premium cigars are discerning, and do research about cigars before they purchase one. 347 TTABVUE 97-98 at 104:25-105:2, 131-140 at 141:2-23, 151:16-152:20; 342 TTABVUE 318 at 70:22-25; 343 TTABVUE 870-871 at 197:25-198:5; 280 TTABVUE 268-90; *see also* 283 TTABVUE 16, ¶ 31.

CT cites Board decisions stating that the applicable standard of care for likelihood of confusion is to be based on the “least sophisticated potential purchasers.” 365 & 366 TTABVUE 41. Notwithstanding this principle, the Board has concluded that even the least sophisticated consumer will exercise some caution and thought before parting with substantial money in buying a product or service. *In re Guild Mortgage Co.*, 2020 USPQ2d 10279, at *5 (TTAB 2020). That both novice and sophisticated cigar smokers do exercise care as to origin before purchasing premium cigars is demonstrated by CT’s own proffered evidence of consumers asking store clerks, making searches on Google, and going on Reddit, with questions about whether Cuban cigars can be purchased in the U.S. and whether the GC COHIBA they are considering buying is a Cuban cigar, before making a purchase. *Cf.* 365 & 366 TTABVUE 54. This effectively shows that cigars of this nature are not an “impulse buy” even for novice smokers, and that cigar buyers are not willing to part with \$10 or more for a cigar without learning about the origins of the product.

The fifth *DuPont* factor is “the fame of the prior mark (sales, advertising, length of use).” While CT spends nearly a fifth of its brief in self-praise as to the purported renown in the U.S. of the Cuban Cohiba, *see* 365 & 366 TTABVUE 28-37, the Board may not view this factor as counting toward likely confusion. This argument, which is based on the fame allegedly acquired in the U.S. by a Cohiba mark

never once used on a product sold in the U.S., is simply another attempt by CT to sneak its disguised “well-known marks” theory past the Board in the guise of a § 2(d) claim. *Sun Hee Jung* and the other precedents cited at 37-38, *supra*, reject such a theory.

CT fails to present any competent evidence on the seventh and eighth *DuPont* factors, which deal with actual confusion and the implications of no or weak actual confusion evidence, where, as here, GC has been using its COHIBA mark in commerce for decades. The Board should take a long and skeptical look at CT’s evidence on this issue. Much of it has to do with evidence that is inadmissible hearsay (*see* Appendix B (Evidentiary Objections)), about consumers allegedly asking GC employees, cigar store workers and each other questions as to whether the GC COHIBA comes from Cuba – questions which, from all appearances, were always answered by a clear “no.” 365 & 366 TTABVUE 43-45.³¹ In any event, it is established law that even admissible evidence of consumers asking questions about the origin of a product is not evidence of actual confusion. To the contrary, absence of confusion should be inferred from such questions, since they show that potential consumers who ask questions understand that the product may not be connected with the origin mentioned in the question. *Sterling Jewelers, Inc. v. Artistry Ltd.*, 896 F.3d 752, 758, 127 USPQ2d 1568, 1572 (6th Cir. 2018) (“But questions are not answers. And questions about potential affiliation do not necessarily demonstrate confusion in this setting. To the contrary, questions about potential affiliation confirm that these sophisticated retailers discern a difference between

³¹ CT’s confusion argument relies heavily on statements made by Rene Labor (365 & 366 TTABVUE 41, 44), but his testimony is hearsay and inadmissible speculation and the witness is not credible because of admitted exaggeration. Labor worked at a single cigar store in Miami as a sales-clerk and assistant manager from 2013 to 2017. 349 TTABVUE 1728 (Labor Dep. 4:7-10, 17:8-24). He also wrote cigar reviews for the store website (*id.* at 1745) (21:9-22:4), including a review of a GC COHIBA Nicaragua cigar where he made assertions that “Whenever I’m asked at the store if we carry Cohiba, 9 times out of 10 the person is referring to the Cuban variant.” 349 TTABVUE 1836-9 (Labor Dep., Ex. 4). This was obviously why he was selected as a witness by CT. Yet on cross-examination Labor admitted that in this statement “I am going by an exaggerated sense of feel ... It is just one of those figures of speech that I took an[d] exaggerated it, just because it seems that it seems that way sometimes to me, but there’s absolutely no survey done. There is no research done. There is no tally taken ... Yeah, there’s no fact at all. I could be completely wrong.” *Id.* at 1757-58 (34:10-35:5). Labor’s later assertion in deposition as to the proportion of people coming into his single Florida store who were “maybe” inexperienced smokers (*id.* at 1776) (56:14-15), on which CT now heavily relies for its confusion argument, also lacked any foundation in fact – no “survey,” “research” or “tally” was cited to support his statement. Like Labor’s other testimony, this statement was speculative, hearsay, and lacked credibility.

the marks, or at least put themselves in a position to do so.”). *See also Duluth News-Tribune, a Div. of Nw. Publ'ns, Inc. v. Mesabi Publ'g Co.*, 84 F.3d 1093, 1098, 38 USPQ2d 1937, 1941 (8th Cir. 1996); *Fisher Stoves, Inc. v. All Nighter Stove Works*, 626 F.2d 193, 195, 206 USPQ 961, 962-63 (1st Cir. 1980)).

CT's assertion that GC's ex-employees have acknowledged meaningful actual confusion also does not withstand examination. CT relies heavily on the declaration it introduced of Alan Willner, a former GC executive with an axe to grind. 365 & 366 TTABVUE 43-46. Willner, [REDACTED] (361 TTABVUE 109-10) (Willner Dep. 107:7-108:19), [REDACTED] (*id.* at 111) (at 109:10-18), and [REDACTED] (*id.* at 118-9) (at 116:24-117:11). Under cross-examination, Willner admitted substantial exaggeration in his direct testimony that CT now relies on. While CT cites his declaration asserting that he had five to ten conversations each year in which consumers expressed confusion between the GC and CT cigars (365 & 366 TTABVUE 43), on cross-examination, Willner acknowledged that almost none of these interactions involved a face-to-face talk with a consumer (361 TTABVUE 56-7) (Willner Tr. Dep. 54:24-55:4). His declaration asserted that he actually had conversations with consumers indicating that they were confused as to origin, and that “consumers told me that they were surprised to learn that the General Cigar Cohiba cigar they had smoked was not the Cuban Cohiba cigar,” (223 TTABVUE 4-5, ¶ 9) (Willner Decl.), but on cross-examination, Willner admitted that only *one* individual had made such a comment in all of Willner's years at GC, and did so at a cigar club where Willner was handing out GC cigars for free – hardly a typical retail setting that might indicate actual confusion among people who buy their cigars (361 TTABVUE at 58-9, 60) (56:21-57:1, 58:1-18).³² This

³² Willner – *CT's own voluntary witness in this case* – also acknowledged under cross-examination many facts that cut against CT's claim of likely confusion (361 TTABVUE): (1) when he was VP for marketing for GC, he visited approximately 200 retail cigar stores in the course of his duties and could not recall an instance where a cigar store owner or employee ever told him that consumers were confused as to the origin of the GC COHIBA (*id.* at 47) (45:10-19); (2) that despite his many interactions with premium cigar consumers, both socially and for business, he had only “casual conversations” with a “miniscule” number in which the subject of the GC COHIBA was ever discussed (*id.* at 51) (49:2-17); (3) despite his high level of interaction with consumers, any expressions that he interpreted as showing confusion were “quite rare,” (*id.* at 77) (75:18-23); (4) the GC COHIBA sold in the marketplace always had a statement of geographic origin of Dominican Republic or Honduras origin on the box or tube (*id.* at 81-82, 160) (79:25-

is the kind of *de minimis*, anecdotal, hearsay “vague evidence of confusion” that the Board and courts have consistently rejected as hearsay and deserving of no weight in considering actual confusion. *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1172 (TTAB 1987); *see also Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 269 F.3d 114, 124, 60 USPQ2d 1038, 1044-45 (2d Cir. 2001).

CT also relies on a summary of anonymous social media posts prepared by a marketing agency working for GC and a handful of anonymous social media posts where the picture of a GC COHIBA was shown adjacent to hashtags referencing Cuba (as well as many other hashtags, a technique which social media posters use to increase their “likes”). Such anecdotal evidence has been consistently found non-probative on likelihood of confusion, however, as it does not show that the unnamed social media posters are actually consumers of the product or are actually confused about the origins of the product in question. *Reply All Corp. v. Gimlet Media, LLC*, No. 20-952-cv, 843 F. App’x 392, 397 (2d Cir. 2021). The Board has highlighted the unreliability of such evidence in several decisions. *Double Coin Holdings Ltd. v. TRU Dev.*, Canc. No. 92063808, 74 TTABVUE 21, 2019 WL 4877349, at *11 (TTAB Oct. 1, 2019) (rejecting use of defendant’s website and images on third-party websites as showing actual confusion, and stating: “[W]ithout direct testimony from supposedly confused individuals (having viewed Double Coin’s proffered evidence), there is insufficient evidence to ascertain what they were thinking, or whether they were actually confused. This is not evidence of actual confusion (a mistaken perception of a purchaser about the source or sponsorship of the goods), and is entitled to no weight.”). *See also Ethika, Inc.*, Canc. No. 92063682, 70 TTABVUE 22-23, 2020 WL 6306141, at *9 (Oct. 26, 2020); *Starbuzz Tobacco, Inc.*, Opp. No. 91224065, 55 TTABVUE 13-14, 2019 WL 3524389, at *7 (July 11, 2019) (non-precedential).

80:1-22; 158:5-9); (5) “scores” of cigar brands sold in the U.S. have an association in the mind of consumers with Cuba (*id.* at 79-80) (77:18-78:5), and most premium cigar consumers make a close association between cigars as a product and Cuba (*id.* at 81) (79:4-10); and (6) during his tenure as head of GC’s marketing, he was responsible for the company’s advertising and marketing (*id.* at 83) (81:10-14), but never approved any marketing initiatives that he believed would deceive the cigar consumer, or took or approved any steps, including approving consumer-facing marketing, to confuse consumers as to the origin of the GC COHIBA cigar. *Id.* at 84 (82:10-83:15).

CT's remaining "confusion" evidence does nothing to fill in the gaps in its proof. Discussion within GC's marketing department about the COHIBA cigars' "Cuban equities" (365 & 366 TTABVUE 46) are meaningless: Willner testified under cross-examination that consumers associate "scores" of cigar brands sold in the U.S. with Cuba, premium cigar lovers make an association between cigars as a product and Cuba (361 TTABVUE 79-80) (77:18-78:5), and most premium cigar consumers make a close association between cigars as a product and Cuba (*id.* at 81) (79:4-10). The fact that a handful of internet cigar catalogues have mentioned the Cuban Cohiba when offering the GC COHIBA cigar for sale is hardly probative of what consumers believe about whether there is any association between the products, and indeed many cigar catalogues take care to explain that the GC COHIBA cigar originates from GC, not CT, and point out the trademark dispute between the two companies. *See, e.g.*, 221 TTABVUE 4-5 (explaining COHIBA brand was taken by GC for use in the U.S. for a Dominican-origin cigar); 5 ("Cohiba is a brand of premium cigars made by two different manufacturers, the Cuban version is handmade by Habanos, S.A., and the non-Cuban is produced by General Cigar Company in the Dominican Republic"); 7-8; 9-11. Again, CT has not presented a single consumer witness to testify that he/she was misled into believing that GC COHIBA cigars ordered from one of these merchants actually originated with CT in Cuba.

One glaring omission in CT's alleged evidence of actual confusion is any recent properly-conducted survey showing that potential consumers are actually confused by GC's current use of its COHIBA mark. While the Board does not require surveys in *inter partes* proceedings, largely due to the expense it imposes on parties, CT's failure to present a consumer survey here is highly meaningful. In the Federal Action, CT submitted and relied heavily on a consumer survey conducted by its expert Alvin Ossip in 2000 as purported proof of actual confusion. *See Empresa III*, 70 USPQ2d at 1672-73, 1685-86. However, CT did not ask Ossip or, to GC's knowledge, any other expert to conduct a survey in this Cancellation. Ossip was deposed in this Proceeding and acknowledged that, since the close of the Federal Action in 2003, he had done no research or surveys on consumer confusion in the premium cigar market (347 TTABVUE 317 at 21:4-13), and that confusion can dissipate over time (*id.* at 341 at 45:21-23). The Board should draw a negative inference from CT's failure to submit a consumer survey in this Cancellation

conducted similarly to the one CT provided to the District Court.³³ It cannot simply be that CT was trying to avoid expense: it has litigated this dispute to the hilt since the end of the Federal Action. There can be only one likely reason for CT's failure to present such evidence: awareness that due to changes in consumer knowledge and attitudes, including increased sophistication among premium cigar consumers, a survey of today's consumers would yield results negating the existence of consumer confusion.

CT's failure to present any current probative evidence of actual confusion is another strike against its § 2(d) claim, under the eighth *DuPont* factor, "the length of time and conditions under which there has been concurrent use without evidence of actual confusion." Because this is a cancellation proceeding, not an opposition, which was initiated years after the Registrations issued, and because GC has developed "long established and valuable rights" in its COHIBA mark over nearly thirty years, *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co. (W.D. Byron)*, 377 F.2d 1001, 1003-04, 153 USPQ 749, 750-51 (CCPA 1967), CT is required to show greater evidence of actual confusion existing today. *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (CCPA 1974). The GC COHIBA cigars have been widely sold throughout the U.S. since the Federal Action trial in 2003, and there is no expense CT has spared in litigation, yet it was unable to produce a sworn statement from a single, actually confused premium cigar consumer or a properly conducted survey evidencing current actual confusion among consumers.

CT's argument about intentional copying of the COHIBA trademark in the U.S. does not advance its § 2(d) claim. Because trademarks are territorial, no inference of improper intent can be drawn because GC chose to use and register the COHIBA mark, never previously used by CT in the U.S., for its cigar. *Person's Co.*, 14 USPQ2d at 1480-81 (no bad faith can be inferred from registration of mark used by another

³³ "If, as herein, a party plaintiff comes upon what it believes to be additional or newly discovered evidence of actual confusion, the proper avenue to proceed is by way of a motion to reopen its testimony period for the specific purpose of offering said testimony providing that all of the elements necessary to support such a motion are present." *Fin. Co. of Am. v. BankAmerica Corp.*, 205 USPQ 1016, at *14 (TTAB Oct. 11, 1979) (citing *Chemetron Corp. v. Self-Organizing Sys., Inc.*, 166 USPQ 495 (TTAB 1970)) (rejecting opposer's improper rebuttal testimony relating to actual confusion, and stating that, "[e]vidence of actual confusion is the best evidence of a likelihood of confusion and, as a consequence, it is properly a salient feature of a plaintiff's case-in-chief").

in Japan); *Green Spot (Thailand) Ltd. v. Vitasoy Int’l Holdings Ltd.*, 86 USPQ2d 1283, 1285 n.4 (TTAB 2008) (holding unclean hands defense would not apply even if opposer adopted its mark with knowledge of applicant’s use of the mark abroad).

Finally, CT’s extended attack on the evidence presented by GC (365 & 366 TTABVUE 50-54) is unavailing.³⁴ It is not GC’s burden to disprove likely confusion; rather, it is CT’s “heavy burden” as a cancellation petitioner to show, by substantial, non-speculative, and competent evidence, that an appreciable number of U.S. consumers are likely to be confused by GC’s use of the COHIBA mark. It has not come close to satisfying that burden. Because CT has neither established prior use of the COHIBA mark in the U.S., nor shown likely confusion from GC’s use of its registered marks, the Board should dismiss CT’s § 2(d) claim.

V. PETITIONER’S CLAIM UNDER LANHAM ACT § 14(3) MUST BE DISMISSED

The Board should dismiss CT’s Eighth Ground for Cancellation, under Lanham Act § 14(3), as legally insufficient. It is settled that showing “willful use of a confusingly similar mark” by a registrant is not sufficient to state a cancellation claim under § 14(3). *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1632 (TTAB 2014), *aff’d*, 338 F. Supp. 3d 477 (E.D. Va. 2018), *aff’d in relevant part, vacated and remanded on other grounds*, 987 F.3d 284 (4th Cir. 2021) (“*Belmora*”). Rather, the petitioner must produce substantial evidence that the respondent made a “blatant misuse of the mark ... in a manner calculated to trade on the goodwill and reputation of petitioner.” *Otto Int’l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). The Board has said “[w]e look for evidence reflecting respondent’s deliberate misrepresentation of the source of its product, ‘blatant misuse’ of the mark, or conduct amounting to the deliberate passing-off of respondent’s goods.” *Belmora*, 110 USPQ2d at 1632.

The handful of § 14(3) claims that have been sustained have involved truly egregious misconduct, bearing no resemblance to the current case. In *Belmora*, the plaintiff adopted the trademark and trade dress of Flanax, a popular analgesic sold in the Mexico market, and marketed it in the U.S. primarily to Mexican

³⁴ GC responds to CT’s attack on the admissibility of this evidence in Appendix C hereto.

immigrants. The Board found the “most important and telling fact distinguish[ing] this claim from a Section 2(d) claim” was that the defendant’s marketing repeatedly represented its Flanax was the same product sold in Mexico for many years and now made in the U.S., thus “repeatedly holding itself out as the source in the United States of the product sold for decades under the same mark in the bordering country of Mexico.” *Id.* at 1636. Likewise, in the recent decision of *The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021), Coca-Cola had sold THUMS UP and LIMCA sodas for many years in India, and the products were familiar to Indian-American consumers in the U.S. The registrants made and sold THUMS UP and LIMCA soda (in the same flavors) in the U.S. that directly copied the trade dress, logos, and taglines used by Coca-Cola in India for its legitimate products. In finding a violation of § 14(3) and cancelling the registration, the Board also considered respondents’ “broader pattern of copying the word marks and logos of others, particularly brands from India.” *Id.* at *51.

CT, in contrast, presents *no evidence* that GC sought to deceive U.S. cigar consumers into the belief that its cigars originate with the same source that makes the Cuban Cohiba. It alleges that GC “selected and registered COHIBA in 1992 in order to exploit the reputation and renown of the Cuban COHIBA” (365 & 366 TTABVUE 55), but this simply means GC intentionally chose to use the same word mark in the U.S. that CT does in Cuba. As a matter of law, under *Belmora*, that argument fails to state a § 14(3) claim. CT also contends that a handful of retailers not associated with GC, in catalogues and online cigar retailing, have mentioned the CT Cohiba in the course of describing the GC COHIBA cigars they are selling. In fact, this is a rare occurrence. Most cigar catalogues and online retail offers make no reference at all to the CT Cohiba or, when they do, make clear that the GC COHIBA is an entirely different non-Cuban cigar with a different origin. *See, e.g.*, 253 TTABVUE 124-203; 253 TTABVUE 205-52; 254 TTABVUE 3-120; 254 TTABVUE 122-191; 255 TTABVUE 3-58; 255 TTABVUE 229-385; 259 TTABVUE 3-161; 258 TTABVUE 170-359; 261 TTABVUE 139-287; 283 TTABVUE 310-384 (Annexes O, P, Q). In any event, CT has provided no evidence that retailers who make reference to the CT Cohiba are doing so at the instigation of GC. To the contrary: GC witnesses testified that GC disapproves of such references and seeks to discourage them. 275 TTABVUE 5; 353 TTABVUE 227-29 at 226:9-228:3; 349 TTABVUE 1348-1358

at 255:9-256:4, 265:1-18. This is not proof of “blatant misuse of the mark *by the respondent*,” *Otto Int’l*, 83 USPQ2d at 1863 (emphasis added), and is not deliberate passing off of the GC COHIBA cigar as a version of the CT Cohiba. The Board should therefore dismiss the Eighth Ground for Cancellation.

CONCLUSION AND SUMMARY

For the reasons shown above, the Board should dismiss the Amended Petition in its entirety.

Dated: September 1, 2021

Respectfully submitted,

By: /s/ Andrew L. Deutsch

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CERTIFICATE OF SERVICE

I hereby certify that on this date I have caused to be served a true and correct copy of the foregoing Respondent General Cigar Co., Inc.'s Trial Brief and Annexes A-D have been sent via email to Petitioner's counsel:

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Andrew L. Deutsch

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

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EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	Cancellation No. 92025859
Petitioner,	:	
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v.	:	
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GENERAL CIGAR CO., INC.,	:	
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Respondent.	:	
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APPENDIX A
RESPONDENT'S INDEX OF EVIDENCE

Pursuant to the Board’s September 29, 2018 Order, Respondent General Cigar Co, Inc. (“GC”) provides an “index of the evidence with each entry consisting of a description of the item and the TTABVUE entry number ... [and] a reference to the TTABVUE entry for the stipulation that addresses the admissibility.”¹

For ease of reference, GC (1) has organized the Index by TTABVUE Docket No; and (2) includes in this Index evidence relied upon by GC whose admissibility is not based on a Stipulation.

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
169 TTABVUE 011-13 (¶¶27-31 and exhibits cited therein); 169 TTABVUE 486-679	CT’s Notice of Reliance Exhibit Nos. 26-31: GC’s actions for trademark infringement against third parties for those third parties’ use of a COHIBA trademark on cigars that included a design similar to the design used by the Cuban COHIBA cigar; documents produced by GC	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE; to the extent not covered by the above, Fed. R. Evid. 201; TBMP § 704.12 and 37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07
179 TTABVUE 510-856	Federal Action CT’s Trial Exhibit PX0702: we will call it Cohiba – Legend of a Pleasure (Spanish version)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

¹ GC agrees with CT’s explanation that “the Federal Action trial transcript, written direct testimony, and deposition transcripts, identified here in Appendix A were designated and filed with the Board pursuant to the procedure approved by the Board in 138 TTABVUE; 136 TTABVUE. The transcripts of the discovery depositions taken in this proceeding and introduced as evidence, identified in the Index below, were designated and filed with the Board pursuant to the procedure approved by the Board in 165 TTABVUE; 157 TTABVUE. The Parties further stipulated that they need not utilize a Notice of Reliance to introduce the above as well as the other Federal Action materials identified in this Index. *Supra* & 132 TTABVUE 3 (¶¶ 1-3); 137 TTABVUE 5 (¶ 6).” GC further adds that these stipulations addressing admissibility were all without prejudice to make evidentiary objections thereto, as GC has done in Appendix B.

² Citations to the Parties’ confidential filings with the Board assume that there is a cover page added to the first page of the docket entry.

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
179 TTABVUE 857-1034	Federal Action CT's Trial Exhibit PX0703: we will call it Cohiba – Legend of a Pleasure (English Translation)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 69-72	Federal Action CT's Trial Exhibit PX0842: Forbes Magazine, <i>Help from Havana?</i>	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 73-77	Federal Action CT's Trial Exhibit PX0843: New York Magazine, <i>Are Cuban Cigars Worth Smuggling?</i>	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 78-85	Federal Action CT's Trial Exhibit PX0846: Tropic Magazine: <i>Plain Brown Wrapper:</i>	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 182 -	Federal Action CT's Trial Exhibit PX0923: Letter regarding Proposed Use and Registration in the U.S.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 591-594	Federal Action CT's Trial Exhibit PX1083: Culbro Corp. Memo re: Cohiba Design	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
190 TTABVUE 18-22	Federal Action GC's Trial Exhibit DX0077: Search Report	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
190 TTABVUE 34-40	Federal Action GC's Trial Exhibit DX0177: Images of Cohiba Cigar Box	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
190 TTABVUE 42-65	Federal Action GC's Trial Exhibit DX0212: Response of Empresa Cubana Del Tabaco D.B.A. Cubatabaco to Defendants Culbro Corp. and General Cigar Co., Inc.'s Second Set of Interrogatories	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
191 TTABVUE 71 - 73	Federal Action GC's Trial Exhibit DX0253: General Cigar Co. memo re: 1995 Plans	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
193 TTABVUE 3-17 (Confidential)	Federal Action CT's Deposition Exhibit 5: Media Presentation	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 195-203 (Confidential)	Federal Action CT's Deposition Exhibit 43: General Cigar Co. Inc. Cohiba 1982-1983 Invoices	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 606 – 609 (Confidential)	Federal Action CT's Deposition Exhibit 221: General Cigar Dominicana Invoice	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 610-615 (Confidential)	Federal Action CT's Deposition Exhibit 222: General Cigar Dominicana Invoices for 1984	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 616 – 625 (Confidential)	Federal Action CT's Deposition Exhibit 223: General Cigar Sales Information for 1980	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 626-635 (Confidential)	Federal Action CT's Deposition Exhibit 224: General Cigar Sales Information for 1981	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 670-677 (Confidential)	Federal Action CT's Deposition Exhibit 231: General Cigar Sales Information for 1986	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 678-686 (Confidential)	Federal Action CT's Deposition Exhibit 232: General Cigar Sales Information for 1988	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 840-848 (Confidential)	Federal Action CT's Deposition Exhibit 248: General Cigar Sales Information for 1997	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 857– 858 (Confidential)	Federal Action CT's Deposition Exhibit 255: General Cigar Sales Invoice for 1992	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 283-305 (Confidential)	Federal Action CT's Deposition Exhibit 360:	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
	Dec. 4, 1992 Draft opinion of GC outside counsel and GC memo re same	(Stipulation granted)
194 TTABVUE 321-323 (Confidential)	Federal Action CT's Deposition Exhibit 369A: Feb. 19, 1982 Culbro Corp. memo from Sparkes (GC trademark custodian) to Cullman, Jr. (GC VP)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 563-	Federal Action CT's Deposition Exhibit 453: March 20, 1987 Letter regarding Trademark Registrations	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
198 TTABVUE 142-146	Federal Action CT's Summary Judgment Exhibit 58: Dec. 12, 1977 memo in GC trademark file re Cuban Cohiba	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
199 TTABVUE 77-79 (Confidential)	Federal Action CT's Summary Judgment Exhibit 52: April 20, 1989 GC outside counsel memo on proposed use and registration in U.S. of marks used by CT abroad	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
273 TTABVUE 2-13	Trial Declaration of Richard Carleton Hacker, GC's Expert	Trial Testimony, 37 C.F.R. § 2.123(a)(1)
275 TTABVUE	Trial Declaration of Victoria McKee Jaworski, Independent Consultant for GC	Trial Testimony, 37 C.F.R. § 2.123(a)(1)
281 TTABVUE 1-10 (Confidential)	Trial Declaration of Eugene Paul Richter, III, GC's Vice-President of Sales	Trial Testimony, 37 C.F.R. § 2.123(a)(1)
283-286 TTABVUE 1-35, Annex A-EE	Trial Declaration of Steven Abbot, GC's Senior Brand Manager and Annexes thereto.	Trial Testimony, 37 C.F.R. § 2.123(a)(1)
291 TTABVUE 32-35	Federal Action GC's Summary Judgment Exhibit 04: Tobacco Merchants Association – Pre-Embargo and Post-Embargo Cuban Cigar Brand Names: The Current Trademark and Importation Situation	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 495-500	Federal Action GC's Summary Judgment Exhibit 06: Cuba Tobacco Has Great Friends	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 501-502	Federal Action GC's Summary Judgment Exhibit 07: General Cigar Invoice	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
291 TTABVUE 503-505	Federal Action GC's Summary Judgment Exhibit 08: General Cigar Invoice	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 506-523	Federal Action GC's Summary Judgment Exhibit 09: 1979-1981 Invoices	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 524-528	Federal Action GC's Summary Judgment Exhibit 10: Culbro Corp. Letter regarding New Trademark Application in the U.S.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 529-533	Federal Action GC's Summary Judgment Exhibit 11: Cuba Tabaco International, Cohiba the highest quality cigar	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 543-545	Federal Action GC's Summary Judgment Exhibit 13: Cohiba Application Excerpt	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 546-550	Federal Action GC's Summary Judgment Exhibit 14: Plaintiff's Supplemental Privilege Log	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 551-574	Federal Action GC's Summary Judgment Exhibit 14: Response of Empresa Cubana Del Tabaco D.B.A. Cubatabaco to Defendants General Cigar Co., Inc.'s Second Set of Interrogatories	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 782-806	Federal Action GC's Summary Judgment Exhibit 30: Cigar Aficionado Magazine, Spring 1994	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 807-808	Federal Action GC's Summary Judgment Exhibit 31: Image of Cigar Wrapper	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 809-815	Federal Action GC's Summary Judgment Exhibit 32: Images of Cigar labels	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
291 TTABVUE 816-824	Federal Action GC's Summary Judgment Exhibit 33: Cohiba Invoices for 1982-1983	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 825-826	Federal Action GC's Summary Judgment Exhibit 34: General Cigar Invoice	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 827-829	Federal Action GC's Summary Judgment Exhibit 35: General Cigar Invoices for 1983	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 830-835	Federal Action GC's Summary Judgment Exhibit 36: General Cigar Invoices for 1984	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 836-842	Federal Action GC's Summary Judgment Exhibit 37: General Cigar financial documents for 1986	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 843-850	Federal Action GC's Summary Judgment Exhibit 38: General Cigar financial documents	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 890–891	Federal Action GC's Summary Judgment Exhibit 36: General Cigar Invoices for 1992	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 892-893	Federal Action GC's Summary Judgment Exhibit 46: General Cigar Invoices for 1992	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 894-901	Federal Action GC's Summary Judgment Exhibit 47: General Cigar Invoices for 1993	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 902-909	Federal Action GC's Summary Judgment Exhibit 48: General Cigar Invoices for 1994	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 910 - 914	Federal Action GC's Summary Judgment Exhibit 49: General Cigar Financial information for 1996	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
		(Stipulation granted)
291 TTABVUE 915-935	Federal Action GC's Summary Judgment Exhibit 50: General Cigar Invoices for 1995	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 936-937	Federal Action GC's Summary Judgment Exhibit 51: General Cigar Invoices for 1995	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 938-939	Federal Action GC's Summary Judgment Exhibit 52: General Cigar Invoices for 1995	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 1089-1091	Federal Action GC's Summary Judgment Exhibit 69: Culbro Corp. letter regarding Trademark Registration	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 1092-1093	Federal Action GC's Summary Judgment Exhibit 70: Memorandum regarding Culbro Trademark Registration	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 1098-1099	Federal Action GC's Summary Judgment Exhibit 72: General Cigar Invoice for 1978	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 1100-1108	Federal Action GC's Summary Judgment Exhibit 73: General Cigar financial documents for 1988	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 1109-1117	Federal Action GC's Summary Judgment Exhibit 74: General Cigar financial documents for 1997	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
291 TTABVUE 1118-1121	Federal Action GC's Summary Judgment Exhibit 75: General Cigar financial documents for 1998	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
296 TTABVUE 258-526	Federal Action GC's Trial Exhibit 83: Letter regarding U.S. Rights to Cohiba Trademark	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
296 TTABVUE 865-872	Federal Action GC's Trial Exhibit DX0177: Images of Cohiba Cigar Box	89 TTABVUE 2-3 (Stipulation, ¶¶2-3);

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
		91 TTABVUE (Stipulation granted)
297 TTABVUE 234-235	Federal Action GC's Trial Exhibit DX0223: General Cigar Invoice for 1993	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 236-238	Federal Action GC's Trial Exhibit DX0224: General Cigar Invoice for 1993	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 239-244	Federal Action GC's Trial Exhibit DX0225: General Cigar Invoice for 1984	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 245-249	Federal Action GC's Trial Exhibit DX0229: July 6, 1989 Letter regarding Proposed Use and Registration in the U.S. of Marks Used Abroad by Cubatabaco	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 250-252	Federal Action GC's Trial Exhibit DX0230: Dec. 5, 1991 Letter regarding U.S. Registration of Trademark	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 253-254	Federal Action GC's Trial Exhibit DX0235: General Cigar Invoice for 1992	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 255-262	Federal Action GC's Trial Exhibit DX0236: General Cigar Invoice for 1993	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 789-796	Federal Action GC's Trial Exhibit DX0288: General Cigar financial information	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 797-805	Federal Action GC's Trial Exhibit DX0289: General Cigar financial information	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
297 TTABVUE 806-814	Federal Action GC's Trial Exhibit DX0289: General Cigar financial information	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
338 TTABVUE 117-245	Federal Action Trial Transcript from May 28, 2003	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
338 TTABVUE 243-419	Federal Action Trial Transcript from May 29, 2003	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
338 TTABVUE 672- 804	Federal Action Trial Transcript from June 3, 2003	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
338 TTABVUE 932-1175	Federal Action Trial Transcript from June 11, 2003	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
339 TTABVUE 199-288	Federal Action Plaintiff's Written Direct Testimony of Ana Lopez Garcia	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
339 TTABVUE 337 -339	Federal Action Appendix I to Plaintiff's Written Direct Testimony of Ana Lopez Garcia	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
341 TTABVUE 2 - 31	Federal Action Defendant's Written Direct Testimony of Edgar M. Cullman, Jr.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
341 TTABVUE 33-45	Federal Action Defendant's Written Direct Testimony of Harry Marcus	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
341 TTABVUE 46-54	Federal Action Defendant's Written Direct Testimony of William McCaffery	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
341 TTABVUE 55-71	Federal Action Defendant's Written Direct Testimony of Ronald S. Milstein	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 2-72	Federal Action Discovery Deposition Transcript of Howard A Aronson	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
		(Stipulation granted)
342 TTABVUE 268-389	Federal Action Discovery Deposition Transcript of Oscar L. Boruchin	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 976-1163	Federal Action Discovery Deposition Transcript of Edgar M. Cullman, Jr., Vol. I	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 1164-1298	Federal Action Discovery Deposition Transcript of Edgar M. Cullman, Jr., Vol. II	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 2-115	Federal Action Discovery Deposition Transcript of Dickson Farrington	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 374-463	Federal Action Discovery Deposition Transcript of Adargelio Garrido de la Grana	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 791-895	Federal Action Discovery Deposition Transcript of Steven Johnson	
345 TTABVUE 2-152	Federal Action Discovery Deposition Transcript of Warren Pfaff	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
345 TTABVUE 333-491	Federal Action Discovery Deposition Transcript of John Rano	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
345 TTABVUE 749 - 790	Federal Action Discovery Deposition of Lewis Rothman 30(b)(6) and 45	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
346 TTABVUE 161-313	Federal Action Discovery Deposition of Charles H. Sparkes from July 14, 2000	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
346 TTABVUE 314-472	Federal Action Discovery Deposition of Charles H. Sparkes from August 7, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

TTABVUE No.²	Description of Document	Stipulation Addressing Admissibility
347 TTABVUE 2, 69	TTAB Discovery Deposition of Richard Carleton Hacker dated June 15, 2017.	137 TTABVUE 2-3 Stipulation, ¶ 1); 138 TTABVUE (Stipulation granted)
349 TTABVUE 1724-1805; Labor Dep. Ex. 4 (Confidential)	TTAB Discovery Deposition of Rene Labor; Labor Dep. Ex. 04: Cohiba Nicaragua Web print out.	137 TTABVUE 2-3 Stipulation, ¶ 1); 138 TTABVUE (Stipulation granted)
355 TTABVUE 1- 167 (Confidential)	Trial Cross Examination Under Oral Examination of Steven Abbot	Trial Testimony, 37 C.F.R. § 2.123(a)(1)
355 TTABVUE 696-768 (Confidential)	Trial Cross-Examination Under Oral Examination of Victoria McKee Jaworski	Trial Testimony, 37 C.F.R. § 2.123(a)(1)
361 TTABVUE 1-200 (Confidential)	Trial Cross-Examination Under Oral Examination of Alan Willner	Trial Testimony, 37 C.F.R. § 2.123(a)(1)
362 TTABVUE 703-850	TTAB Discovery Deposition Transcript of Richard Carleton Hacker	137 TTABVUE 2-3 Stipulation, ¶ 1); 138 TTABVUE (Stipulation granted)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

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	:	
EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
Petitioner,	:	Cancellation No. 92025859
	:	
v.	:	
	:	
GENERAL CIGAR CO., INC.,	:	
Respondent.	:	
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APPENDIX B

RESPONDENT GENERAL CIGAR CO., INC.'S STATEMENT OF EVIDENTIARY

OBJECTIONS

Pursuant to Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 707.03, Respondent, General Cigar Co., Inc. (“GC”), through its undersigned counsel, hereby submits its Statement of Evidentiary Objections to evidence submitted by Petitioner, Empresa Cubana del Tabaco d.b.a. Cubatabaco (“CT”), listed in Appendix A to CT’s Trial Brief (365 TTABVUE), and to other evidence that CT submitted during its trial period and may be used in CT’s reply papers. In the column below titled “Pages of Evidence Cited in CT Trial Brief,” GC identifies where CT relies on inadmissible evidence. If that column includes the response “N/A,” GC anticipates that CT may try to rely on such evidence in its reply papers.

In the sections below, GC summarizes its objections to the admissibility of material evidence submitted by CT on its direct case and asks that the Board deny admission to that evidence and not consider it in the final determination of this matter for the reasons explained herein. Given the volume of the record underlying this matter, GC separately provides objections in chart form, similar to Appendix B submitted with CT’s trial brief. (365 TTABVUE Appendix B).

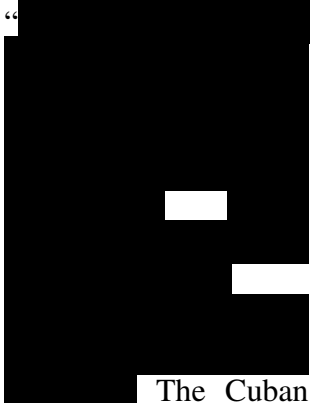
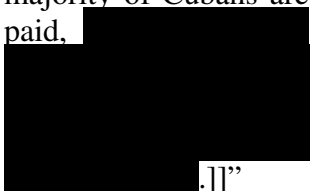
Like CT, GC maintains the objections it made on the record at the discovery depositions and trial in the Federal Action between the Parties and asks that the Board deny admission to objected-to testimony. 338, 342-347 TTABVUE.

Description	TTABVUE No.¹	Objection(s)	Pages of Evidence Cited in CT Trial Brief
Declaration of Enrique Babot Espinosa (“Babot”) Statements by Babot concerning activities by	139 TTABVUE ¶¶ 5, 26-30, generally	FRE 602—Lack of Foundation. CT has not provided a foundation for Babot’s testimony for periods when his responsibility did not include CT’s or Habanos’ marketing efforts	365 TTABVUE 27, 46-47

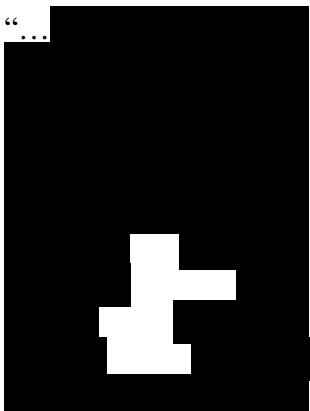
¹ Citations to the Parties’ confidential filings with the Board assume that there is a cover page added to the first page of the docket entry.

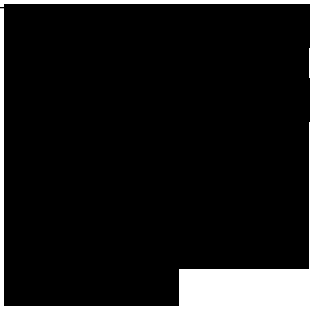
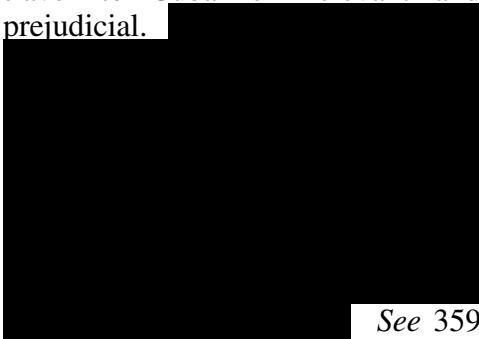
<p>CT or Habanos S.A. (“Habanos”) in the periods prior to April 2005, between August 2008 and July 2014, and after April 2017.</p>		<p>as Director for Operational Marketing for Habanos: that is prior to April 2005, between August 2008 and July 2014, and after April 2017. Prior to 2005 Babot was a sales representative of Habanos. 139 TTABVUE 26 at ¶¶ 4-5. Between August 2008 and July 2014 Mr. Babot was not employed by CT or Habanos S.A but by a French company, Coprova S.A.S. 139 TTABVUE 26 at ¶¶ 5-6. After April 2017 Babot was International Supervisor of Markets for Habanos for specific already-established international markets, with no direct responsibility for CT’s Cohiba cigar. 139 TTABVUE 26 at ¶ 6. CT has failed to meet its burden of showing that Babot had personal knowledge of the events during this period that he testified to. FRE 602; <i>First Nat. Bank of Louisville v. Lustig</i>, 96 F.3d 1554, 1576 (5th Cir. 1996).</p> <p>FRE 802 – Hearsay.</p> <p>Babot’s statements of CT’s marketing efforts prior to April 2005, between August 2008 and July 2014, and after April 2017, to the extent that he recounts or summarizes statements made to him by out-of-court declarants, are hearsay. Babot declined to identify the sources of his information in this direct testimony or cross-examination on written questions (259 TTABVUE at 21:13-23:23; 58:13-17), thus making it impossible for GC to examine any witnesses with actual knowledge supporting Babot’s characterization of events. CT has failed to show that Babot’s testimony falls within any exception to the hearsay rule.</p>	
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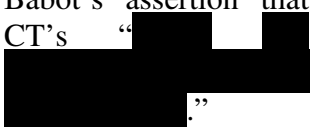

		<p>FRE 401 – Relevancy.</p> <p>Babot’s statement based on information, conversations, or data occurring or created after 2003 but prior to 2017 are irrelevant to any of CT’s cancellation grounds, including:</p> <ul style="list-style-type: none"> • CT’s Sixth Cancellation ground (Lanham Act §2(d)), both as to CT’s claim of priority based on alleged “analogous use” of a Cohiba mark in the U.S. prior to November 20, 1992, which predates Babot’s personal knowledge by at least 11 years, and as to CT’s claim of likelihood of confusion, which under Board precedent is measured by facts existing at the time of trial. 122 TTABVUE 7; <i>see Lesley Hornby a/k/a Lesley Lawson a/k/a Twiggy v. Tjx Cos., Inc.</i>, 87 USPQ2d 1411 (TTAB 2008) (“<i>Hornby</i>”). 	
<p>Paragraph 11 of the Declaration of Enrique Babot Espinosa</p> <p>“The media articles reporting on COHIBA demonstrate the success of positioning COHIBA as the most exclusive cigar at the pinnacle of Cuban cigar brands and show that the press reported on COHIBA in a way that distinguished it from all other cigars, including by reporting that it is associated with Fidel Castro as the cigar created for and smoked by him, that it is the</p>	<p>139 TTABVUE 27 at ¶ 11</p>	<p>FRE 403, 602, 701(a) – Prejudice; Lack of Personal Knowledge; Lay Opinion on Legal Issues</p> <p>This statement should be excluded as a legal conclusion of the witness regarding “associations” and an unsupported opinion lacking foundation since Babot never identified the articles on which his opinion is based, and did not testify that these were articles circulated in the U.S., so there is no basis to conclude that they had an impact on U.S. cigar consumers.</p>	<p>N/A</p>

highest quality and most expensive Cuban cigar and that it is made from the highest quality Cuban tobacco.”			
<p>Paragraph 13 of the Declaration of Enrique Babot Espinosa</p> <p>“ The Cuban COHIBA cigar is sold in Cuba only in the Cuban Convertible Currency (CUC), not the National Cuban Peso in which the vast majority of Cubans are paid, .”</p>	<p>139 TTABVUE 28 at ¶ 11</p>	<p>FRE 401 – Relevancy.</p> <p>Babot’s comparison of the price of CT’s Cohiba against CT’s Montecristo, both as sold in Cuba is not relevant to any cancellation ground or defense in this proceeding. The relevant comparison shows that the GC COHIBA is priced higher on average than the CT Cohiba. <i>Compare</i> price per unit in Para 16 of the Declaration of Enrique Babot Espinosa at ~\$5.5 USD per cigar, <i>with</i> Paragraph 8.e. of the Declaration of Steven Abbot (283 TTABVUE 18 (¶ 33)).</p>	N/A
<p>Paragraph 15 and Annex A of the Declaration of Enrique Babot Espinosa</p> <p>“The Cuban COHIBA cigar is sold in Cuba and throughout the world, except in the United States. Attached as Annex A is a list of the countries with</p>	<p>139 TTABVUE 29 at ¶ 15</p>	<p>FRE 401 – Relevancy</p> <p>Annex A, which is a list of countries where Habanos S.A. currently has a distribution agreement and has other statements by Babot concerning sales of CT’s sales outside the U.S., is not relevant to any of CT’s cancellation grounds.</p>	

Habanos, S.A. authorized distributors. Additionally, Habanos, S.A. authorized distributors outside Cuba also sell the Cuban COHIBA cigar in other countries.”			
<p>Paragraphs 16-17 of the Declaration of Enrique Babot Espinosa</p> <p>Babot’s statements of CT’s sales statistics for markets within and outside Cuba (excluding U.S.).</p>	<p>139 TTABVUE 29-30, 31 at ¶¶ 16-17, 23.</p>	<p>FRE 401, 403 – Relevancy; Undue Prejudice if Considered for the Truth of The Matter Asserted.</p> <p>CT’s sales from 2003-2017 to consumers outside the US have no relevance to any grounds for cancellation. CT submits no evidence that any of these sales were to U.S. consumers. Sales of these products abroad cannot be used to establish use of the Cohiba mark in the U.S. <i>See Brouwerij Nacional Balashi NV v. t & beer, inc.</i>, No. 91223456, 15 TTABVUE 10, 2016 WL 6833497, at *5 (TTAB Aug. 25, 2016) (non-precedential), citing <i>Person’s Co. Ltd. v. Christman</i>, 900 F.2d 1565, 14 USPQ2d 1477, 1479-80 (Fed. Cir. 1990)); <i>Sun Hee Jung v. Magic Snow</i>, 124 USPQ2d 1041, 1044, 2014 WL 4174422 (TTAB 2017). In addition, CT has not produced any evidence within its trial submission that show how these statistics were maintained and has therefore failed to lay the foundation necessary for their introduction as business records. <i>See</i> 359 TTABVUE at 78:13-83:18; 280:6-282:5.</p> <p>FRE 602 / 701(a) – Lack of Foundation; Speculative Opinion Testimony.</p>	<p>365 TTABVUE 27, 33, 46-47</p>

		CT has failed to provide a foundation for admission of Babot's testimony concerning volume of sales by CT or Habanos. Babot previously testified during a deposition that "sales is not a category that I am, or have been in charge of to this point at Habanos S.A." and could not even provide rough approximations of CT's Cohiba sales at his discovery deposition. <i>See</i> 359 TTABVUE at 21:13-23:23; 58:13-17; 57:3- 58:4; 59:11-60:14; 67:11-69:18. He therefore lacks personal knowledge of the facts regarding sales. In addition, Babot's testimony concerning knowledge of sales of Cuban Cohiba cigars in his trial testimony is inconsistent with his testimony in deposition. <i>See</i> 359 TTABVUE at 67:11-69:18.	
<p>Paragraph 18-19 of the Declaration of Enrique Babot Espinosa</p> <p>"From my contacts with both distributors and retailers of COHIBA, I know that COHIBA has been available in the most prestigious and well-known tobacco shops throughout the world."</p> <p>"...</p> 	<p>139 TTABVUE 30 at ¶¶ 18-19.</p>	<p>FRE 401 – Relevancy</p> <p>Sales of the CT Cohiba outside of the U.S. are not relevant to any issue in this Proceeding. The CT Cohiba is, by Babot's own admission, not sold in any tobacco shops in the U.S. Babot answered "I do not know" when asked whether the Cuban Cohiba cigar is legally available in any of the "'most prestigious' and 'well-known' tobacco shops located in the United States?" and admitted that neither he nor CT maintained any data about how many cigars were purchased by U.S. consumers in duty free shops around the world. <i>See</i> 359 TTABVUE 78:3-83:18.</p>	<p>365 TTABVUE 47</p>

			
<p>Paragraphs 20-22 of the Declaration of Enrique Babot Espinosa</p> <p>In Paragraphs 20-22 Babot provides general testimony that Cuban Cohibas are sold at <i>La Casa del Habano</i> or <i>Punto Oficial de Venta</i> locations in Cuba and that those locations, including near the airports, are where US travelers (and travelers from every other country) travel through.</p>	<p>139 TTABVUE 30-31 at ¶¶ 20-22.</p>	<p>FRE 401 – Relevancy</p> <p>Testimony concerning consumer purchases of the CT Cohiba in Cuba is irrelevant to the issues in this case.</p> <p>Additionally, any connection drawn by Babot from the fact that CT sells cigars at airports and Americans travel to Cuba is irrelevant and prejudicial. </p> <p><i>See</i> 359 TTABVUE 68:15-69:18; 70:17-74:23; 78:13-93:18.</p> <p>In addition, Babot’s testimony concerning sales at trial is inconsistent with his prior testimony in a discovery deposition. <i>See</i> 359 TTABVUE at 67:11-69:18, 78:13-83:18; 88:16-89:2.</p>	<p>365 TTABVUE 27, 33, 46, 47</p>
<p>Paragraph 25 of the Declaration of Enrique Babot Espinosa</p> <p>Assertion by Babot that “Since at least May 2003, the Cuban</p>	<p>139 TTABVUE 31-32 at ¶ 25.</p>	<p>FRE 602 – Lack of Personal Knowledge / Foundation.</p> <p>Babot testified on cross-examination that his statement is speculation, and CT failed to lay a foundation to show that Babot has personal knowledge of</p>	<p>365 TTABVUE 27, 32, 33, 46, 47</p>

COHIBA cigar was so well-known and had built up such fame in the U.S....”		<p>the alleged fame of the CT Cohiba in the U.S. <i>See</i> 359 TTABVUE 68:15-69:18; 70:17-74:23; 78:13-93:18.</p> <p>FRE 401 – Relevancy</p> <p>Alleged fame acquired in the U.S. from use of a mark abroad is not relevant to CT’s § 2(d) claim since the Board rejects the “well-known marks” theory. <i>See Sun Hee Jung v. Magic Snow</i>, 124 USPQ2d 1041, 1043, 2014 WL 4174422 (TTAB 2017).</p>	
<p>Paragraph 27 of the Declaration of Enrique Babot Espinosa</p> <p>Babot’s assertion that CT’s “.”</p>	139 TTABVUE 32-33 at ¶ 27	<p>FRE 403 – Irrelevant and Prejudicial Evidence.</p> <p>This statement is irrelevant and unduly confusing as Babot also admitted that . 359 TTABVUE 102:9-103:25; 105:20-25; 107:8-24.</p>	365 TTABVUE 27, 32, 33, 46, 47
<p>Paragraph 32 of the Declaration of Enrique Babot Espinosa</p> <p>Babot’s assertions as to press mentioned arising from XVIII Festival</p>	139 TTABVUE 35-36 at ¶ 32	<p>FRE 401 – Relevancy</p> <p>On cross-examination Babot could not identify how many among the Cohiba press mentions he cites were in publications read by US cigar consumers, 359 TTABVUE 108:20-111:10, and his testimony is therefore not probative on any issue in the case.</p>	365 TTABVUE 27, 33, 46
<p>Paragraph 42 of the Declaration of Enrique Babot Espinosa</p> <p>Statement that Habanos, S.A. “developed a website,</p>	139 TTABVUE 38-39 at ¶ 42	<p>FRE 701/801(d)(1)(A) – Unsupported and Contradicted Opinion Testimony.</p> <p>Babot’s statement is contradicted by his cross-examination testimony where he admitted that 5 other cigar</p>	365 TTABVUE 46, 47

www.habanos.com, to promote Cuban cigars, including most prominently the Cuban COHIBA cigar”		<p>brands were given “equal” prominence with the CT Cohiba on the Habanos website. 359 TTABVUE 112:9-113:22.</p> <p>FRE 802/901 – Hearsay; Authenticity</p> <p>Babot’s testimony, to the extent based on Google analytics reports, should be excluded for lack of foundation and hearsay grounds as CT did not maintain these reports in the ordinary course of its business and no witness from Google was presented subject to cross-examination as to the reliability of methods used by Google in its analytics reports. <i>Ayoub, Inc. v. ACS Ayoub Carpet Serv.</i>, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016) (statements made on website constitute hearsay); 359 TTABVUE 121:5-127:12.</p>	
<p>Paragraph 43 of the Declaration of Enrique Babot Espinosa</p> <p>Babot’s direct testimony concerning Habanos’ Twitter Account and assertion that 19% of the followers of Habanos’ Twitter account are from the U.S.</p>	<p>139 TTABVUE 39 at ¶ 43</p>	<p>FRE 401, 403, 602 – Relevance; Unduly Prejudicial; Lack of Foundation</p> <p>The statement that 19% of the followers of Habanos’ Twitter account are from the U.S. should be excluded for lack of foundation and relevance grounds, and as speculative because: (1) the Habanos Twitter account contains many posts about cigars other than the CT Cohiba; (2) the total number of U.S. followers of the Habanos website, according to CT’s own data, is 585 accounts, which (even if all such persons were potential consumers of cigars) is insufficient to show attitudes or understandings among the more than 3.5 million U.S. consumers of premium cigars, and (3) CT does not</p>	<p>365 TTABVUE 27, 46, 47</p>

		<p>maintain data to show whether its Twitter followers are real individuals or “bots.” CT also did not provide any support for its claim that the users are actually located in the U.S. 359 TTABVUE 134:5-136:13.</p> <p>FRE 802, 901 – Hearsay; Authenticity.</p> <p>Babot’s testimony regarding the claimed number of U.S. followers of Habanos Twitter account (which deals with all cigars sold by Habanos, not just the CT Cohiba) should be excluded because (1) the Twitter account contains many posts about cigars other than the CT Cohiba, so “following” that account is not indicative that the follower is interested in the CT Cohiba; (2) CT did not maintain Twitter user origin records in the ordinary course of its business; and (3) no witness from Twitter was presented to testify and be cross-examined as to the reliability of methods used by Twitter in its user location analytics reports. <i>Ayoub, Inc. v. ACS Ayoub Carpet Serv.</i>, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016) (statements made on website constitute hearsay). In addition, there is no evidence showing that these records are maintained in the ordinary course of CT or Habanos business and they are therefore inadmissible as hearsay.</p>	
<p>Paragraph 44 of the Declaration of Enrique Babot Espinosa</p> <p>Testimony concerning Habanos’ Instagram</p>	<p>139 TTABVUE 39-40 at ¶ 44</p>	<p>FRE 401, 403, 602 – Relevancy; Unduly Prejudicial; Lack of Foundation.</p> <p>This testimony should be excluded on foundation and relevance grounds,</p>	<p>365 TTABVUE 27, 34, 46, 47</p>

<p>account and Babot's assertion that 28% of Habanos Instagram account followers are located in the U.S. and that the U.S. has the most number of followers for the Habanos Instagram account.</p>		<p>and as hearsay because: (1) the Habanos Instagram account contains many posts about cigars other than the CT Cohiba, so "following" that account is not indicative that the follower is interested in the CT Cohiba; (2) even if all followers of the Habanos Instagram account were actual U.S. cigar smokers, the amount of those followers (according to the witness) is approximately 19,000, which is minimal in proportion of the 3.5 million Americans who smoke premium cigars and, without more information about those individuals is insufficient to show attitudes or understandings among that consumer group; and (3) CT does not maintain data to show whether these Instagram followers are real U.S. persons who actually consume cigars or are, instead, "bots" or non-smokers. 359 TTABVUE 137:12-138:25; 139:16-141:16.</p> <p>FRE 802, 901 – Hearsay; Authenticity.</p> <p>Babot's testimony regarding claimed number of U.S. followers of Habanos Instagram account should be excluded because CT did not maintain Instagram user origin records and no witness from Instagram was presented to testify and be cross-examined as to the reliability of methods used by Instagram in its user location analytics reports. In addition, Babot could not testify that these records are maintained in the ordinary course of CT or Habanos business and they are therefore inadmissible as business records. 359 TTABVUE at 138:6-141:16.</p>	
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<p>Paragraph 47 of the Declaration of Enrique Babot Espinosa</p> <p>Assertion that CT Cohiba advertisements have been published in <i>OnCuba</i> magazine, circulated in U.S.</p>	<p>139 TTABVUE 39-40 at ¶¶ 44</p>	<p>FRE 401 – Relevancy.</p> <p>Babot’s testimony concerning purported CT “Cohiba” advertisements in <i>OnCuba</i> Magazine should be excluded because, on cross-examination, the witness admitted that these ads were not actually promoting or advertising CT Cohiba cigars but warning visitors who come to Cuba not to purchase counterfeit cigars in Cuba, and because the advertisement was directed at “all Cuban cigars” and only “indirectly” related to the CT Cohiba. 359 TTABVUE 141:17-143:14; 144:17-145:2.</p>	<p>365 TTABVUE 27, 34, 46, 47</p>
<p>Paragraphs 49-62 of the Declaration of Enrique Babot Espinosa</p> <p>Babot’s testimony “summarize[s] some elements of damage” to CT and contains legal conclusions concerning the fame of CT’s Cohiba, the confusion that might occur if the embargo ended, speculations about what U.S. consumers would believe if the embargo ended concerning the likelihood of confusion.</p>	<p>139 TTABVUE 41-45 at ¶¶ 49-62</p>	<p>FRE 701(a) – Speculative Opinion Testimony On Likelihood of Confusion and Legal Conclusions.</p> <p>This testimony should be excluded as the opinion of an interested witness on the ultimate legal issue of likelihood of confusion. <i>See, e.g., Fisons Ltd. v. UAD Laboratories, Inc.</i>, 219 USPQ 661, 663 (TTAB 1983) (“The opinions of witnesses...on the question of likelihood of confusion “are entitled to little if any weight and should not be substituted for the opinion of the tribunal charged with the responsibility for the ultimate opinion on the question.”); <i>Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC</i>, 124 USPQ2d 1184 (TTAB 2017); <i>Innovation L. Grp., Ltd.</i>, No. 91202418, 29 TTABVUE 5, 2013 WL 11247273, at *2 (June 10, 2013) (considering only factual claims submitted in connection with trial declaration). CT does not offer or maintain any reliable surveys, studies, or data that would support</p>	<p>365 TTABVUE 27, 33, 34</p>

		Babot's legal conclusions and opinions.	
Paragraphs 28-D, 28-E, 28-F, 28-G, 28-H of the Declaration of Lisset Garcia Fernandez	141 TTABVUE 35-36 at ¶¶ 28(d)-(h)	FRE 401 – Relevancy. This evidence is irrelevant to any issue in the Proceeding because the U.S. oppositions and cancellations cited in paragraphs 28(d)-(h) concern the CT Cohiba trade dress and CT's U.S. trademark registrations for that trade dress, not the U.S. COHIBA word mark at issue in this Proceeding. 357 TTABVUE at 71:3-75:5.	365 TTABVUE 47
Declaration of Brenna Murdock, Paragraph 13-14 and Annexes 4-5. Annex 4 provides the results of a Google search for the word Cohiba. Annex 5 provides the Google results for the term "cohiba cigar."	167 TTABVUE 5-6, 229- 304	FRE 401, 602, 802 – Relevancy; Lack of Foundation; Hearsay. Google search results are generally inadmissible in Board proceedings, especially without providing complete articles or supporting evidence concerning the "witness's" search history. <i>In re Bayer Aktiengesellschaft</i> , 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) ("Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations"); <i>In re Thomas Nelson, Inc.</i> , 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); <i>In re Innovative Cos.</i> , 88 USPQ2d 1095, 1099 n.4 (TTAB 2008); <i>In re Tea and Sympathy Inc.</i> , 88 USPQ2d 1062, 1064 n.3 (TTAB 2008); <i>In re King Koil Licensing Co.</i> , 79 USPQ2d	365 TTABVUE 42, 44, 46

		1048, 1050 (TTAB 2006); <i>In re Thomas</i> , 79 USPQ2d 1021, 1026 (TTAB 2006) (Google hits without any context for the hits are irrelevant).	
<p>Declaration of Brenna Murdock, Paragraph 25 and Annex 16.</p> <p>Annex 16 provides the results of a Google search for the words “jay-z” and “cuba.”</p>	167 TTABVUE 375-383	<p>FRE 401, 602, 802 – Relevancy; Lack of Foundation; Hearsay.</p> <p>Google search results are generally inadmissible in Board proceedings, especially without providing complete articles or supporting evidence concerning the “searchers” search history. <i>In re Bayer Aktiengesellschaft</i>, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations”); <i>In re Thomas Nelson, Inc.</i>, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); <i>In re Innovative Cos.</i>, 88 USPQ2d 1095, 1099 n.4 (TTAB 2008); <i>In re Tea and Sympathy Inc.</i>, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008); <i>In re King Koil Licensing Co.</i>, 79 USPQ2d 1048, 1050 (TTAB 2006); <i>In re Thomas</i>, 79 USPQ2d 1021, 1026 (TTAB 2006) (Google hits without any context for the hits are irrelevant).</p>	N/A

<p>Declaration of David Girolami and Annex A to the Declaration of David Girolami (“Girolami”)</p> <p>Girolami was engaged as an investigator by CT’s law firm for purposes of visiting three cigar stores. He posed as a “confused” customer and asked sales associates working at those stores whether GC’s Cohiba cigars were Cuban and then whether they are asked that question by other customers.</p> <p>As to Cigars International, 4078 Nazareth Pike, Bethlehem, PA, — Girolami declared he asked a sales associate whether the store sells Cuban Cohiba cigars and was told by the sales associate that Cuban Cohiba’s were illegal for sale in the US and that there was a running lawsuit about the name of the cigars.</p> <p>Girolami gave testimony regarding statements allegedly made by a sales associate at Cigars International, 525 Main Street, Bethlehem, PA, and a sales associate at Famous Smoke Shop as</p>	<p>167 TTABVUE 433-436</p>	<p>FRE 602, 701(a), 802 -- Lack of Foundation; Hearsay; Unqualified Opinion Evidence.</p> <p>Girolami’s testimony concerning statements made out-of-court by sales clerks in tobacco stores is single hearsay and Girolami’s testimony concerning statements made out-of-court by customers to sales clerks, and then communicated to Girolami is double hearsay, and CT has not shown any applicable exception to either level of hearsay.</p> <p>Girolami’s testimony of out-of-court statements made by customers to the sales clerks about confusion is double hearsay. Any opinion expressed by the associate as to customer confusion is inadmissible as single hearsay and as legal opinion from an unqualified law witness. The Board routinely excludes hearsay and double hearsay of this type. <i>See</i> Fed. R. Evid. 802; <i>see, e.g., Rocket Trademarks Pty Ltd. v. Phard S.p.A.</i>, 98 USPQ2d 1066, 1072 (TTAB 2011) (TTAB Feb. 25, 2011) (sustaining objection to testimony based on what the witness “was told by the store employees” as it was “clearly hearsay”); <i>Collegepath, Inc. v. Christine L. Sylvain</i>, No. 91248169, 2021 WL 3784236, at *19 (TTAB Aug. 24, 2021) (non-precedential) (“Applicant’s objection to this evidence on the ground that it is hearsay is well-taken. Indeed, the letter comprises multiple hearsay statements, since Opposer is relying on Mr. Edmonds’ letter for the truth of the matter that other (unknown) individuals have mistaken the parties’ names in the past.”)</p>	<p>365 TTABVUE 42</p>
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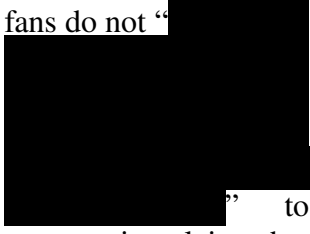
<p>to out of court statements allegedly made by the clerks and statements the clerks allegedly made about what customers had said to them.</p> <p>CT offers Girolami's testimony to support its claim that there has been actual consumer confusion. (365 TTABVUE 45).</p>			
<p>Declaration of Tom Bailey and Annex A to the Declaration of Tom Bailey</p> <p>Bailey was engaged as an investigator by CT's law firm for purposes of visiting three cigar stores in Philadelphia (Capell Brothers, Holt's Walnut Street, and Holt's NE Philly) posing as a "confused" customer and asking sales associates about whether the store sold Cuban Cohiba cigars and whether customers expressed confusion from asking the same question he did to the sales associates regarding the sale of the CT Cohiba in the US. His testimony purports to recount to what clerks said to him and their statements about what customers told them, and the clerks'</p>	<p>167 TTABVUE 462-465</p>	<p>FRE 602, 701(a), 802 -- Lack of Foundation; Hearsay; Unqualified Opinion Evidence.</p> <p>Bailey's testimony as to out-of-court statements made to him by store sales clerks is hearsay. Additionally, Bailey's testimony as to out-of-court statements made to him by store sales clerks about out-of-court statements made to the sales clerks by customers is double hearsay. Any out-of-court statement made by a sales clerk of a tobacco store to Bailey expressing the conclusion about whether unidentified customers are confused is also inadmissible legal opinion from an unqualified lay witness. The Board routinely excludes hearsay and double hearsay of this type. <i>See</i> Fed. R. Evid. 802; <i>see, e.g., Rocket Trademarks Pty Ltd. v. Phard S.p.A.</i>, 98 USPQ2d 1066, 1072 (TTAB 2011); <i>Collegepath, Inc. v. Christine L. Sylvain</i>, No. 91248169, 2021 WL 3784236, at *19 (TTAB Aug. 24, 2021) (non-precedential).</p>	<p>365 TTABVUE 42</p>

<p>belief as to the customers' state of mind.</p> <p>CT offers Bailey's testimony to support its claim that there has been actual consumer confusion. (365 TTABVUE 45).</p>			
<p>Declaration of Thomas J. Reilly and Annex A to the Declaration of Thomas J. Reilly</p> <p>Reilly was engaged as an investigator by CT's law firm for the purposes of visiting two cigar stores in NYC (Davidoff of Geneva and Nat Sherman), posing as a "confused" customer that asked sales associates about whether the store sold Cuban Cohiba cigars and whether customers expressed confusion by asking the same question he did regarding the sale of CT Cohiba in the US.</p>	<p>167 TTABVUE 466-472</p>	<p>FRE 602, 701(a), 802 -- Lack of Foundation; Hearsay; Unqualified Opinion Evidence.</p> <p>Reilly's testimony as to out-of-court statements made to him by store sales clerks is hearsay. Additionally, Reilly's testimony as to out-of-court statements made to him by store sales clerks about out-of-court statements made to the sales clerks by customers is double hearsay. Any out-of-court statement made by a sales clerk of a tobacco store to Reilly expressing the conclusion about whether unidentified customers are confused is also inadmissible legal opinion from an unqualified lay witness. The Board routinely excludes hearsay and double hearsay of this type. <i>See</i> Fed. R. Evid. 802; <i>see, e.g., Rocket Trademarks Pty Ltd. v. Phard S.p.A.</i>, 98 USPQ2d 1066, 1072 (TTAB 2011); <i>Collegepath, Inc. v. Christine L. Sylvain</i>, No. 91248169, 2021 WL 3784236, at *19 (TTAB Aug. 24, 2021) (non-precedential).</p>	<p>N/A</p>
<p>Declaration of Kevin A. Gregg, Esq. and Annex A to the Declaration of Kevin A. Gregg, Esq.</p>	<p>167 TTABVUE 473-476</p>	<p>FRE 602, 701(a), 802 -- Lack of Foundation; Hearsay; Unqualified Opinion Evidence.</p>	<p>365 TTABVUE 42</p>

<p>Gregg was engaged as an investigator by CT's law firm for the purposes of visiting one cigar shop in Florida (Mike's Cigar Shop) posing as a "confused" customer that asked whether the store sold Cuban Cohibas and whether customers expressed confusion by asking the same question regarding the sale of CT Cohiba in the US.</p> <p>CT offers Gregg's testimony to support its claim that there has been actual consumer confusion. (365 TTABVUE 45).</p>		<p>Gregg's testimony as to out-of-court statements made to him by store sales clerks is hearsay. Additionally, Gregg's testimony as to out-of-court statements made to him by store sales clerks about out-of-court statements made to the sales clerks by customers is double hearsay. Any out-of-court statement made by a sales clerk of a tobacco store to Gregg expressing the conclusion about whether unidentified customers are confused is also inadmissible legal opinion from an unqualified lay witness. The Board routinely excludes hearsay and double hearsay of this type. <i>See</i> Fed. R. Evid. 802; <i>see, e.g., Rocket Trademarks Pty Ltd. v. Phard S.p.A.</i>, 98 USPQ2d 1066, 1072 (TTAB 2011); <i>Collegepath, Inc. v. Christine L. Sylvain</i>, No. 91248169, 2021 WL 3784236, at *19 (TTAB Aug. 24, 2021) (non-precedential).</p>	
<p>Paragraphs/Exhibits 39-41 of CT's NOR</p> <p>In Paragraphs 39-41 of CT's NOR and the exhibits connected thereto, CT seeks to enter into evidence: (1) opposition/cancellation proceedings it has initiated; and (2) its current USPTO registrations.</p> <p>CT submits this evidence to show an intention to use the COHIBA mark in the U.S. in the future.</p>	<p>169 TTABVUE 18-21 (¶¶ 39-41); 170 TTABVUE 99-185</p>	<p>FRE 401, 401 – Relevancy; Prejudice.</p> <p>This evidence should be excluded as irrelevant because: (1) it involves oppositions/cancellation/registrations not dealing with the COHIBA mark; (2) the TTAB actions that are claimed to relate to the COHIBA mark in fact deal with the Indian head design and yellow/gold coloring pattern that CT uses outside of the U.S. for the Cuban Cohiba, and not with the COHIBA word mark; 170 TTABVUE 99-185. This point was conceded by CT's General Counsel. 357 TTABVUE, Tr. 71:3-75:5. CT has registered this trade dress and design only in connection with the mark BEHIKE in the US (291 TTABVUE 643-670,</p>	<p>365 TTABVUE 47</p>

		671-723; 343 TTABVUE 476-481 at 260:3-5, 264:6-15; 266:20-21) and therefore, these actions show only CT's intent to protect its trade dress in connection with the word BEHIKE in the US; (3) the other trademark applications / registrations cited herein do not relate to the COHIBA mark.	
<p>Paragraph 53, Exhibit 53 to CT's NOR</p> <p>These documents are printouts from US cigar retailer websites included in Exhibit A to the Declaration of David Goldstein from April 19, 2004.</p> <p>In its NOR, CT claims that these documents support its §2(d) cancellation claim.</p>	<p>174 TTABVUE 25; 171 TTABVUE 714-21</p>	<p>FRE 401 – Relevancy.</p> <p>This evidence from 2004 should be excluded since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).)</p>	<p>365 TTABVUE 45</p>
<p>Paragraph 54, Exhibit 54 to CT's NOR</p> <p>These documents are GC advertisements from a 2004 magazine included in Exhibit B to the Declaration of David Goldstein from April 19, 2004. In its NOR, CT claims that these documents support its §2(d) cancellation claim.</p>	<p>174 TTABVUE 25; 171 TTABVUE 722-727</p>	<p>FRE 401 – Relevancy.</p> <p>This evidence from 2004 should be excluded since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).)</p>	<p>N/A</p>
<p>Paragraph 55, Exhibit 55 to CT's NOR</p> <p>CT submits two advertisements of CT's Cohiba cigar in Smoke</p>	<p>174 TTABVUE 25; 171 TTABVUE 722-727</p>	<p>FRE 401 – Relevancy.</p> <p>This evidence from 2008-2009 should be excluded since likelihood of confusion is determined based on facts existing at time at trial. 122</p>	<p>N/A</p>

Magazine from 2008-2009 connection with Paragraph/Exhibit 55 of its NOR. In its NOR, CT claims that these documents support its §2(d) cancellation claim.		TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i> , 87 USPQ2d 1411, 1416 (TTAB 2008).)	
Paragraph 60, Exhibit 60 to CT's NOR. These are excerpts from GC's 2006 marketing plan for Cohiba. In its NOR, CT claims that these documents support its §2(d) cancellation claim.	174 TTABVUE 27; 175 TTABVUE 125-131	FRE 401: Relevancy. This evidence from 2006 should be excluded since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i> , 87 USPQ2d 1411, 1416 (TTAB 2008).)	N/A
Paragraph 61, Exhibit 61 to CT's NOR CT seeks to admit "Excerpts from "Transcript of Jury Trial" from October 11, 2006 at 9:30am in U.S. v. Penton, Case No. 2006-cr-20169 (S.D. Fla. 2006) (Docket Entry 152). CT claims these documents support its § 2(d) cancellation claim.	174 TTABVUE 27; 171 TTABVUE 850-872	FRE 401 – Relevancy. The evidence in Paragraph/Exhibit 61 to CT's NOR is inadmissible because testimony from a separate proceeding unrelated to the COHIBA mark from 2006 is not relevant here. Even if it were, this evidence is not admissible since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i> , 87 USPQ2d 1411, 1416 (TTAB 2008).)	365 TTABVUE 49
Paragraphs 3-5, Exhibits 3 to CT's NOR Partial Moosylvania slide decks sent to GC in 2015/2016 which include some statements relating to UGC ("User Generated Content") on social	174 TTABVUE 4, 40-162	FRE 403, 602, 802 – Irrelevant and Prejudicial; Lack of Foundation; Hearsay. This is hearsay evidence lacking foundation and is therefore not admissible evidence of actual confusion—the purpose for which it is offered by CT. Moosylvania's corporate representative who	365 TTABVUE 42

<p>media during that time. Moosylvania is a third-party marketing agency used by GC to help promote its brands, including Cohiba.</p> <p>CT offers statements contained within these slide decks that some fans do not “” to support its claim that there has been actual confusion. 365 TTABVUE 42-43.</p>		<p>provided testimony on these materials explained that those comments were made “anecdotally” and that Moosylvania did “not track” this information in the ordinary course of its work. 351 TTABVUE 75:3-17; 78:1-13. Moosylvania did not perform any surveys, consider any data or provide any analysis to GC on this subject other than pass along its anecdotal comments, nor did Moosylvania consider whether the UGC [user generated comments] stemmed from non-US persons or from actual cigar smokers. This type of hearsay evidence is routinely rejected by the Board. Fed. R. Evid. 602, 802; see, e.g., <i>Rocket Trademarks Pty Ltd. v. Phard S.p.A.</i>, 98 USPQ2d 1066, 1072 (TTAB 2011); <i>Collegepath, Inc. v. Christine L. Sylvain</i>, No. 91248169, 2021 WL 3784236, at *19 (TTAB Aug. 24, 2021) (non-precedential).</p>	
<p>Paragraphs 6-7, Exhibits 6-7 to CT NOR</p> <p>Draft internal brand plans from March 2016. Not shown to any customers or in GC’s sales action plans.</p>	<p>174 TTABVUE 5, 163-197</p>	<p>FRE 401, 403 – Relevancy and Prejudicial.</p> <p>These exhibits are draft documents, not part of GC’s final brand plans, and were never shown to the public or incorporated into any GC advertising or sales. (281 TTABVUE 10-11; 283 TTABVUE 29-30). They are therefore irrelevant to likelihood of confusion, which focuses on public perceptions of a mark.</p>	<p>365 TTABVUE 44</p>
<p>Paragraph 9-11 and Exhibit 9-11 of CT’s NOR</p> <p>Draft internal brand plans from October 2014. Not shown to any</p>	<p>174 TTABVUE 207-232</p>	<p>FRE 401, 403 – Relevancy and Prejudicial.</p> <p>These exhibits are draft documents from 2014, not part of GC’s final brand plans, and were never shown to the public or incorporated into any</p>	<p>N/A</p>

customers or in GC's sales action plans.		GC advertising or sales. (281 TTABVUE 10-11; 283 TTABVUE 29-30). They are therefore irrelevant to likelihood of confusion, which focuses on public perceptions of a mark. This evidence is also not admissible since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i> , 87 USPQ2d 1411, 1416 (TTAB 2008).)	
<p>Paragraph 68, Exhibit 68 to CT's NOR</p> <p>PTO docket sheet for an Opposition Proceeding (Opp. No. 91078568) related to a Montecristo trademark that was disputed between 1988-1992. In CT's NOR, it claims that this opposition proceeding shows that it "has now, and always has had the intention to sell Cuban cigars, including its COHIBA-branded cigars, in the United States..."</p>	173 TTABVUE 115-	<p>FRE 401 – Relevancy.</p> <p>This evidence is irrelevant and not admissible evidence. This opposition proceeding involved marks and cigars not at issue in the current proceeding (Montecristo) and is not admissible evidence of CT's "intent to sell" a Cohiba cigar in the U.S. today. Moreover, this opposition proceeding occurred between 1988-1992 and is not relevant to CT's current business plans since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).).</p>	N/A
<p>Paragraph 70-73, 82 and Exhibits 70-73, 82 of CT's NOR</p> <p>Ex. 70 – 2017 final internal brand plan. Not shown to any customers.</p> <p>Ex. 71 - Draft internal brand plan from April</p>	174 TTABVUE 207-232	<p>FRE 401, 403 – Relevancy and Prejudicial.</p> <p>Exhibits 71-73, 82 are draft planning or marketing documents and were not shown to the public or otherwise incorporated in GC advertising or sales. Exhibit 70 was a final brand plan, which was not shown to the public. (281 TTABVUE 10-11; 283 TTABVUE 29-30). These exhibits are therefore irrelevant to likelihood</p>	N/A

<p>2016. Not shown to any customers.</p> <p>Ex. 72 – Draft internal brand plan from April 2016. Not shown to any customers.</p> <p>Ex. 73 - Draft internal brand plan from April 2016. Not shown to any customers.</p> <p>Ex. 82 - Draft presentation of a brand launch. Not shown to any customers.</p>		<p>of confusion, which focuses on public perceptions of a mark.</p>	
<p>Declaration of Shkumbin Mustafa</p>	<p>200-201 TTABVUE</p>	<p>FRE 401, 403, 602, 701(a) – Relevancy; Prejudicial Evidence; Lack of Foundation; Unqualified Opinion Testimony of Lay Witness;</p> <p>Fed. R. Civ. P. 26 – Untimely Expert Disclosures;</p> <p>122 TTABVUE – Violation of Prior Board Order Rejecting CT’s Request to Designate a “social media” expert after the close of expert disclosure deadline.</p> <p>The Declaration of Shkumbin Mustafa and its Annexes should be excluded as inadmissible expert testimony from a purported expert not timely designated.</p> <p>First, CT failed to disclose Mustafa as an expert on social media/digital marketing before the deadline for expert disclosures, and so his testimony should be excluded under the Board’s prior orders and Fed. R. Civ. P. 26. The Mustafa Declaration constitutes inadmissible expert</p>	<p>365 TTABVUE 45, 46</p>

		<p>testimony in violation of the Board’s prior orders and Fed. R. Civ. P. 26. (113, 122 TTABVUE)</p> <p>On August 4, 2017, CT’s sought leave to use an undisclosed expert report from an unidentified expert concerning the subject matter “Internet and social media market research and strategy.” (113 TTABVUE; 122 TTABVUE 3)</p> <p>The Board denied CT’s motion and held that CT’s attempt to use new expert testimony concerning social media and internet evidence from an expert not timely disclosed, was too late. (122 TTABVUE 7).</p> <p>Mustafa testified that he works at the company Siegelvision, a company owned by Alan Siegel, a CT witness and expert in the Federal Action concerning digital media. He was engaged by CT’s counsel at Siegelvision’s hourly rate to present and provide expert testimony on social media and internet evidence. (200 TTABVUE 2; 363 TTABVUE 9:15-18; 11:3-13; 14:10-15:1; 18:3-8).</p> <p>The declaration is separately inadmissible under FRE 602 /701 as lacking foundation because Mustafa lacks personal knowledge of the matters testified and as expert opinion testimony by an unqualified lay witness for the following reasons and authorities:</p> <p>(1) The audiovisual evidence submitted with Mr. Mustafa’s declaration (Annexes 1, 3, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25) is not admissible evidence because</p>	
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		<p>it is not the witness’s own factual testimony, but a script written by Lindsey Frank, CT’s attorney, for Mustafa to read. (363 TTABVUE 28:11-29:14). The PDF files submitted as Annexes 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26 are not admissible evidence because Mr. Mustafa has no personal knowledge to confirm the representations made therein that the images sync up with his statements in the transcription; indeed, he testified that he had “no responsibility” for the syncing. (363 TTABVUE 30:14-31:12); <i>see also Kohler Co. v. Honda Giken Kogyo K.K.</i>, 125 USPQ2d 1468, 1485 (TTAB 2017) (sustaining objections to portions of testimony that left “the realm of informed lay opinion”); Committee Notes on 2000 Amendment to Fed. R. Evid. 701 (“By channeling testimony that is actually expert testimony to Rule 702, the amendment also ensures that a party will not evade the expert witness disclosure requirements set forth” in Rule 26 of the Federal Rules of Civil Procedure “by simply calling an expert witness in the guise of a layperson.”). (excluding industry expert’s testimony regarding consumer perception of engine design as improper lay opinion testimony under Fed. R. Evid. 701 where “details of the discussions . . . that led him to conclude that ‘the overall look was easily identified throughout the industry’ [were] not documented or otherwise specified”); <i>In-N-Out Burgers v.</i></p>	
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		<p>(6) Mustafa did not clear his cache before going to any of the internet pages or social media pages in his Declaration (all of which he was specifically instructed to visit by CT's attorney), which could impact the order and content of the results. (363 TTABVUE 40:12-41:11; 41:14-18; 42:4-10)</p> <p>(7) CT's attorney instructed Mustafa which images to click on and highlight versus which images to ignore and not click on. (363 TTABVUE 43:2-46:16; 46:21-47:8; 47:11-20; 48:18-24; 49:20-50:15; 51:22-52:15; 57:25-58:14; 58:22-59:12; 60:18-61:3; 61:17-62:12; 62:19-63:5; 63:14-24; 64:3-12; 65:22-66:10; 69:24-70:13; 71:3-20; 72:2-12; 73:7-10; 73:12-74:4; 77:8-19; 77:23-78:16; 78:23-79:10; 79:14-25; 80:5-81:2; 81:8-82:9; 82:18-83:1; 83:7-14; 84:13-85:12; 86:7-87:2; 87:9-24; 88:3-24; 89:5-13; 89:19-90:15; 91:24-92:13; 92:15-25; 93:7-25; 95:13-24; 97:3-13; 97:16-98:13; 111:24-112:13; 120:2-15; 135:4-136:8; 137:6-17; 138:22-139:5; 143:2-144:7; 147:3-14; 148:6-16; 149:13-22; 153:14-23; 154:3-13; 157:3-158:160:22-161:20; 165:13-21; 177:14-21); <i>See Smith v. Wal-Mart Stores, Inc.</i>, 537 F. Supp. 2d 1302, 1327, 86 USPQ.2d 1835, 1853 (N.D. Ga. 2008) ("Although, as Wal-Mart points out, it is possible that some consumers may view web pages randomly and may scroll through and click on links on pages that are not of interest to them, the Court finds that the survey protocol did not sufficiently reflect actual marketplace</p>	
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		<p>conditions or typical consumer shopping behavior and therefore was unlikely to have elicited a shopping mindset that would have allowed Jacoby to accurately gauge actual consumer confusion”).</p> <p>(8) Mustafa identifies social media users from outside the US, which has no bearing on any issues in this proceeding. FRE 401; (see also 363 TTABVUE 51:5-20; 173:5-23;) <i>See In re Canine Caviar Pet Foods, Inc.</i>, 126 USPQ2d 1590, 1595-96 (TTAB 2018) (website evidence of foreign use of caviar in pet food not probative of norms of pet owners in the U.S.); <i>In re Kysela Pere et Fils, Ltd.</i>, 98 USPQ2d 1261, 1265 n.9 (TTAB 2011) (not considering website for Australian brewery as there was no basis to conclude U.S. consumers were exposed to the website); <i>Disney Enterprises, Inc.</i>, No. 91218136, 29 TTABVUE 5-6, 2015 WL 2441549, at *3 (TTAB Apr. 29, 2015) (“because Applicant's foreign trademark rights are irrelevant to the trademark rights to be determined in this proceeding, the Board will not allow discovery, and will not consider trial evidence, regarding activities involving the parties' marks outside the United States”).</p> <p>(9) Mr. Mustafa did not contact any of the social media users to determine whether they were actually confused in adding the tags that they did. (363 TTABVUE 57:11-20; 160:13-21; 177:18-178:21)</p>	
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		(10) By only clicking on pictures that CT's counsel identified as supporting a likelihood of confusion, Mustafa scrolled past hundreds of images without consideration contrary to Mustafa's charge to "attempt[] to show what a user, ordinary internet user would see if they accessed [Instagram]." Because Mustafa only clicked on images pre-identified by CT's counsel, Mustafa did not recreate an ordinary user experience and thus his analysis is unreliable. (363 TTABVUE 102:10-106:22; 144:19-146:23; 160:5-12)	
<p>Paragraphs 1-4 and Annexes 1-5 from the Declaration of Gerardo Ruiz and Annexes 1-11 Thereto</p> <p>The Declaration and Annexes 1-11 from Ruiz, a former paralegal at CT's direction, includes "summaries" of searches run on various social media platforms and websites including:</p> <ul style="list-style-type: none"> - Paragraph 2, Annexes 1-4: A search for @Cohiba on Twitter and other compilations selected by CT's counsel related to this Twitter "@Cohiba" search. - Paragraph 3-4, Annex 5: A search 	205 TTABVUE	<p>FRE 401, 602, 802, 901, 1006 – Relevance, Lack of Foundation; Hearsay; Lack of Authenticity; Inadmissible Summaries.</p> <p>A proponent of a summary must establish a foundation that: (1) the underlying materials upon which a summary is based are independently admissible; and (2) the underlying documents were made available to the adversary. <i>See, e.g., Conoco Inc. v. Dep't of Energy</i>, 99 F.3d 387, 393 (Fed. Cir. 1996); <i>Paddack v. Dave Christensen, Inc.</i>, 745 F.2d 1254, 1259 (9th Cir. 1984). CT does not meet its burden to show the underlying materials upon which the summaries are based are "independently admissible."</p> <p><u>Paragraph 2, Annexes 1-4:</u> This summary of a search of "@Cohiba" on Twitter is offered to show confusion (365 TTABVUE 40, n.45 43, n.51), but such searches are routinely found inadmissible and should be excluded. (359 TTABVUE</p>	365 TTABVUE 39, 42

<p>of Habanos S.A. Twitter account on May 2, 2018 summarizing various information selected by CT's counsel Lindsey Frank.</p>	<p>at 132:12-24; 133:20-134:10.); <i>see also e.g., Ethika, Inc.</i>, Canc. No. 9206368, 70 TTABVUE, 2020 WL 6306141, at *9 (Oct. 26, 2020) (Non-Precedential) (“The evidence of mistaken social media “tags” is superficial, and not supported by any testimony or other evidence regarding exactly what the social media users thought, or why they “tagged” the posts the way they did.”); <i>Reply All Corp. v. Gimlet Media, LLC</i>, 843 F. App'x 392, 397 (2d Cir. 2021) (accidentally tagging plaintiff's goods/services on social media is not evidence of actual confusion); <i>Codename Enterprises, Inc. v. Fremantlemedia N. Am., Inc.</i>, No. 16CIV1267ATSN, 2018 WL 3407709, at *10 (S.D.N.Y. Jan. 12, 2018) (evaluating similar instances of mistaken tagging on social media and finding that they “do not constitute actual confusion” but rather “it appears viewers of Defendant's channel are likely being careless and reaching the wrong email address, phone number, or social media account.)</p> <p>In addition, Ruiz's testimony does not contain any separate analysis of Twitter posts limited to a verified universe of U.S. persons. As a result, this summary, which appears to include a number of non-U.S. persons, is inherently unreliable. CT did not maintain Twitter user origin records in the ordinary course of its business and no witness from Twitter was presented to testify and be cross-examined as to the reliability of methods used by Ruiz. Moreover, Ruiz admits that the data underlying this summary is not a CT business record because he was directed to</p>	
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		<p>perform this search by Lindsey Frank, CT's attorney, and therefore does not fall into any hearsay exceptions under FRE 803. <i>Ayoub, Inc. v. ACS Ayoub Carpet Serv.</i>, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016).</p> <p><u>Paragraph 3-4, Annex 5</u> (205 TTABVUE 5-16, 175-194): The same evidentiary objections and authorities are applicable to the search and summaries provided by Ruiz related to the "Habanos Official Twitter Account," where his searches and summaries were directed by CT attorney Lindsey Frank. (205 TTABVUE 5-16, 175-194).</p>	
<p>Declaration of Tahimi Arboleya Delgado</p> <p>Testimony from OnCuba Magazine Representative regarding circulation of its magazine.</p>	206 TTABVUE	<p>FRE 602 – Lack of Foundation.</p> <p>If offered by CT to show that its seven <i>OnCuba</i> Magazine advertisements related generally to counterfeiting in Cuba had an impact on U.S. cigar consumers, the testimony should be excluded because Delgado does not offer any data or survey indicating that any U.S. cigar smokers saw the alleged advertisements. (<i>See also</i> TTABVUE 359 at 166:22-167:13; 170:6-174:5.)</p>	N/A
<p>Paragraphs 1-8, Annexes 1-25 of the Declaration No. 3 of Annalisa Martini ("Martini")</p> <p>Paragraph 2, Annexes 1-9 is testimony related to the TV show "Keeping Up With The Kardashians" and its popularity, citing a</p>	215 TTABVUE (1-16, 83-278)	<p>FRE 401, 403 – Relevancy; Prejudicial Evidence.</p> <p>FRE 401 – A significant portion of this evidence dates back to 1998 and should be excluded since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).)</p>	365 TTABVUE 39

<p>particular episode where the Kardashian family went to Cuba.</p> <p>Paragraph 3, Annexes 10-12 is testimony related to the show “Sex In The City,” in particular an episode from Season 1, which aired in 1998 where one character references the CT Cohiba cigar.</p> <p>Paragraph 4, Annexes 13-15 is testimony related to a show “Comedians in Cars Getting Coffee,” which includes a few seconds of a 30 minute episode where Jerry Seinfeld holds a Cuban Cohiba cigar.</p> <p>Paragraph 5, Annexes 16-18 is testimony related to a show “How I Met Your Mother” and in particular one episode aired in 2006 where for 33 seconds one character held a Cuban Cohiba cigar.</p> <p>Paragraph 6, Annexes 19-21 is testimony related to a movie “Downsizing” which includes brief dialogue related to the Cuban Cohiba cigar.</p> <p>Paragraph 7, Annexes 22-23 is testimony related to a movie</p>		<p>FRE 403 – This evidence identifies very short segments of much longer shows or movies with a primary focus on issues unrelated to cigars and CT cites the popularity of those shows and movies as impacting the US cigar consumer perception of CT’s Cohiba. CT does not maintain any of this data as its own business records and cannot identify the number of US viewers of these TV shows and movies, let alone viewers that are US premium cigar smokers.</p>	
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<p>“Hotel Rwanda” released in 2004 which includes a 1 minute 9 second scene related to cigars, mentioning Cuban Cohiba cigars in a location outside the U.S.</p> <p>Paragraph 8, Annexes 24-25 is testimony related to a movie “Iron Man 2” released in 2010 which includes a 1 minute 40 second clip referencing Cuban cigars and the Cuban Cohiba.</p>			
<p>Paragraphs 9, 11-12, Annexes 27, 32 of the Declaration No. 3 of Annalisa Martini</p> <p>Paragraph 9 is a purported summary under FRE 1006 summarizing third party articles that reference Cuban cigars generally or in some cases the CT Cohiba.</p> <p>Paragraph 11, Annex 32 are excerpts from three books that reference “Cohiba” from 2005, 2012, and 2012, including a “Ultimate Guide For Travelers.” Martini also provides a summary of these books purportedly under FRE 1006.</p>	<p>215 TTABVUE (16-19 279-333, 350-392)</p>	<p>FRE 401, 403, 602 – Relevancy; Prejudicial Evidence; Lack of Foundation.</p> <p>FRE 401 – These materials and testimony should be excluded as irrelevant because CT waived its Paris Convention and “famous marks” doctrine cancellation grounds, and thus they have no bearing on any cancellation ground remaining in dispute. Separately, a significant portion of this evidence dates back to 2003 and should be excluded since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).)</p> <p>FRE 403 – This evidence identifies excerpts from these articles and books that reference the Cuban Cohiba without providing any data showing the proportion of US</p>	<p>N/A</p>

<p>Paragraph 12 is a purported summary under FRE 1006 of only 6 online articles that CT claims includes references to Cuban Cohiba but links to GC Cohiba within the articles.</p> <p>Paragraph 13 is a summary of a “Westlaw” search for the terms “Cohiba and cigars,” offered under FRE 1006.</p>		<p>premium cigar smoking population that accessed these materials.</p> <p>FRE 602 – Paragraph 13 summarizes the search results of a Westlaw search. This search engine search is generally inadmissible in Board proceedings. <i>In re Bayer Aktiengesellschaft</i>, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations”); <i>In re Thomas Nelson, Inc.</i>, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); <i>In re Innovative Cos.</i>, 88 USPQ2d 1095, 1099 n.4 (TTAB 2008); <i>In re Tea and Sympathy Inc.</i>, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008); <i>In re King Koil Licensing Co.</i>, 79 USPQ2d 1048, 1050 (TTAB 2006); <i>In re Thomas</i>, 79 USPQ2d 1021, 1026 (TTAB 2006) (Google hits without any context for the hits are irrelevant).</p>	
<p>Paragraphs 10, 28-29 of the Declaration No. 3 of Annalisa Martini</p> <p>Paragraph 10, 28-29 is a summary purported under FRE 1006</p>	<p>215 TTABVUE 19-27, 78- 82</p>	<p>FRE 1006 – Inadmissible Summaries Duplicative of Evidence in the Trial Record.</p> <p>The testimony in this paragraph is inconsistent with FRE 1006, which provides “The proponent may use a summary, chart, or calculation to</p>	<p>N/A</p>

summarizing documents provided in the Declaration of Miguel Suarez Medina (225 TTABVUE) and Brenna Murdock (167 TTABVUE)		prove the content of voluminous writings, recordings, or photographs that cannot be conveniently examined in court.” Fed. R. Evid. 1006. For the purported summaries contained in Paragraphs 10, 28-29, Martini admits that the evidence she summarizes are already submitted as part of the trial record through the Declarations of Brenna Murdock and Miguel Suarez Medina. (215-217, 225 TTABVUE); cf. 215 TTABVUE 19-20, 79-80). The best evidence are the actual documents that have been made part of the trial record and thus, these summaries are inadmissible.	
<p>Paragraphs 16-17, Annexes 38-39 of the Declaration No. 3 of Annalisa Martini</p> <p>Paragraph 16-17, Annex 38-39 is testimony related to a third-party Instagram Account “cohiba_habana”</p>	215 TTABVUE	<p>FRE 602, 802, 901, 1006 – Lack of Foundation; Hearsay; Lack of Authenticity; Evidence Summarized Is Not Independently Admissible.</p> <p>A proponent of a summary must establish a foundation that: (1) the underlying materials upon which a summary is based are admissible; and (2) the underlying documents were made available. <i>See, e.g., Conoco Inc. v. Dep’t of Energy</i>, 99 F.3d 387, 393 (Fed. Cir. 1996); <i>Paddack v. Dave Christensen, Inc.</i>, 745 F.2d 1254, 1259 (9th Cir. 1984). CT does not meet its burden to show the underlying materials upon which the summaries are based are “independently admissible.”</p> <p>FRE 602/901. Martini’s summary of the “Cohiba_Habana” Instagram account is not independently admissible. It is not a CT business record as Martini was directed to search this account by Lindsey Frank, CT’s lawyer and therefore does not fall into any hearsay exceptions under</p>	365 TTABVUE 39

		<p>FRE 803. <i>Ayoub, Inc. v. ACS Ayoub Carpet Serv.</i>, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016).</p> <p>FRE 802 To the extent CT seeks to draw inferences about this anonymous Instagram user’s state of mind or any of this user’s followers, this evidence is inadmissible hearsay.</p>	
<p>Paragraphs 18-21 of the Declaration No. 3 of Annalisa Martini</p> <p>Paragraph 18 purports to be a FRE 1006 summary of information provided on Facebook, Twitter, and Instagram’s websites and includes as Annex 43 a chart of “likes” between GC’s Cohiba and Habanos’ Cohiba.</p> <p>Paragraphs 19-21 contains additional data concerning social media posts.</p> <p>Paragraph 25 includes testimony relating to Google Analytics in summary form under FRE 1006.</p>	<p>215 TTABVUE 42-52</p>	<p>FRE 602, 802 – Lack of Foundation, Hearsay.</p> <p>This evidence submitted with these social media “summaries” should be excluded because they are not a substitute for sworn testimony from these platform providers and are not probative of whether users or commenters on social media are also potential purchasers of cigars.</p> <p>Paragraph 18 includes assertions of statements from the “help” pages of Facebook, Twitter and Instagram concerning how to “tag”, “tweet” at other users. CT does not introduce a witness from Facebook, Instagram, or Twitter who could be subject to cross-examination as to the reliability of the information the paralegal of CT’s law firm relied upon. This evidence thus lacks proper foundation and should be excluded.</p> <p>Paragraphs 19-21 summarizes the purported US consumer interactions with Habanos’ social media platforms, but CT’s own witness confirmed that CT does not have or maintain any reliable data and could not provide any reliable testimony that could support the summaries contained within these paragraphs, including whether any of these accounts were actual social media</p>	<p>N/A</p>

		<p>users or just “bots” or non-potential purchasers of cigars, and whether the analytic reports from these platforms are reliable or accurate 359 TTABVUE 137:12-138:25; 139:16-141:16; <i>Ayoub, Inc. v. ACS Ayoub Carpet Serv.</i>, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016).</p> <p>Martini’s testimony in Paragraph 25 is based on Google analytics reports and summaries of google search engine results and should be excluded for lack of foundation and hearsay, as CT did not maintain these reports in the ordinary course of its business and no witness from Google was presented subject to cross-examination as to the reliability of methods used by Google in its analytics reports. <i>Ayoub, Inc. v. ACS Ayoub Carpet Serv.</i>, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016) (statements made on website constitute hearsay); <i>In re Bayer Aktiengesellschaft</i>, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); (359 TTABVUE 121:5-127:12; 288:13-297:8)</p>	
<p>Paragraph 24 of the Declaration No. 3 of Annalisa Martini</p> <p>Paragraph 24 summarizes GC Cohiba sales of “small” versus “large” cigars.</p>	<p>215 TTABVUE 54-60</p>	<p>FRE 401, 403 – Relevancy; Prejudicial Evidence.</p> <p>Martini’s charts showing GC’s Cohiba sales between “small” and “large” cigars is highly misleading, not reliable, and prejudicial because Martini improperly measures number of cigars by “units,” which ignores the marketplace reality that “small” cigars are not sold individually but rather in tins of 6 or 10, at a price ranging between \$19.00-\$23.00. (355 TTABVUE 131-133 Abbot Trial Tr. at 128:19-130:13.) Thus, a</p>	<p>365 TTABVUE 39</p>

		“unit” for small cigars is a tin, not an individual small cigar as Martini has “calculated.”	
<p>Paragraph 26 of the Declaration No. 3 of Annalisa Martini</p> <p>Paragraph 26 contains charts showing travel to Cuba “when at least one point of service is in the United States or one of its Territories.”</p>	215 TTABVUE	<p>FRE 401, 403 – Relevancy.</p> <p>The fact that some travel to Cuba includes stops in the United States or that Americans travel to Cuba is irrelevant to any issue in the Proceeding. CT does not provide or maintain any data concerning whether American tourists purchase CT Cohiba cigars at these locations and if so, how many tourists make such purchases. CT witness Babot admitted that neither CT nor Habanos maintain any data related to purchases by US citizens and has no idea how many US customers buy cigars at authorized locations, if any do at all. <i>See</i> 359 TTABVUE 68:15-69:18; 70:17-74:23; 78:13-93:18.</p>	365 TTABVUE 39
<p>Declaration No. 2 of Annalisa Martini</p> <p>This evidence includes “calculations” comprising of a small number of social media posts on Facebook, Twitter, and Instagram selected by CT’s attorney that include mistaken tags or add hashtags referencing “Cuba” or “Cuban” to photos of GC’s Cohiba or “likes” to the selected posts.</p>	218-220 TTABVUE	<p>FRE 401, 403, 802 – Relevancy; Prejudice, and Hearsay.</p> <p>Evidence like this, in the form of summaries of social media posts, are routinely found to be inadmissible without independent declarations from the users themselves that they were confused and thus this evidence should be excluded. <i>see also e.g., Ethika, Inc.</i>, Canc. No. 9206368, 70 TTABVUE, 2020 WL 6306141, at *9 (Oct. 26, 2020) (Non-Precedential) (“The evidence of mistaken social media “tags” is superficial, and not supported by any testimony or other evidence regarding exactly what the social media users thought, or why they “tagged” the posts the way they did.”); <i>Reply All Corp. v. Gimlet Media, LLC</i>, 843 F. App’x 392, 397</p>	365 TTABVUE 46

		<p>(2d Cir. 2021) (accidentally tagging plaintiff's goods/services on social media is not evidence of actual confusion); <i>Codename Enterprises, Inc. v. Fremantlemedia N. Am., Inc.</i>, No. 16CIV1267ATSN, 2018 WL 3407709, at *10 (S.D.N.Y. Jan. 12, 2018) (evaluating similar instances of mistaken tagging on social media and finding that they "do not constitute actual confusion" but rather "it appears viewers of Defendant's channel are likely being careless and reaching the wrong email address, phone number, or social media account.)</p> <p>FRE 802 - This data consists of out-of-court statements made by individuals not identified by location or as potential purchasers of cigars and is therefore hearsay.</p>	
<p>Paragraphs 2-31 of the Trial Declaration of Susan Bailey ("Bailey")</p> <p>Paragraphs 2-31 – Bailey "summarizes" documents contained in the Declaration of Miguel Suarez Medina ("Medina")(225 TTABVUE).</p>	221 TTABVUE	<p>FRE 1006 – Best Evidence Rule</p> <p>For the purported summaries contained in Paragraphs 2-31, Bailey admits that the evidence she summarizes are already submitted as part of the trial record through the Declaration Miguel Suarez. (225 TTABVUE); <i>cf.</i> 221 TTABVUE 3-21 (citing to Annexes 1-9 of Medina)19-20, 79-80). The best evidence are the actual documents that have been made part of the trial record and thus, these summaries are inadmissible.</p> <p>Bailey's testimony consists largely of inadmissible legal argument as to whether certain documents evidence confusion. Such argument appears to have been included in these declarations to evade the Board's</p>	365 TTABVUE 44, 46, 53

		requirements concerning trial brief page limits. (332 TTABVUE)	
<p>Paragraphs 33-45 Trial Declaration of Susan Bailey (“Bailey”)</p> <p>In these paragraphs Bailey summarizes search engine results on “West Search” and Lexis.</p>	221 TTABVUE 21-28	<p>FRE 401, 602, 802 – Relevancy; Lack of Foundation; Hearsay.</p> <p>Google search results without actually reviewing the content of the articles are generally inadmissible in Board proceedings. <i>In re Bayer Aktiengesellschaft</i>, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations”); <i>In re Thomas Nelson, Inc.</i>, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); <i>In re Innovative Cos.</i>, 88 USPQ2d 1095, 1099 n.4 (TTAB 2008); <i>In re Tea and Sympathy Inc.</i>, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008); <i>In re King Koil Licensing Co.</i>, 79 USPQ2d 1048, 1050 (TTAB 2006); <i>In re Thomas</i>, 79 USPQ2d 1021, 1026 (TTAB 2006) (Google hits without any context for the hits are irrelevant). Bailey provides no testimony that she reviewed the actual articles from the database searches and thus, this evidence should be excluded.</p>	365 TTABVUE 41
<p>Paragraph 49 and Annex 30 to the</p>	221 TTABVUE	FRE 401 – Relevancy.	365 TTABVUE 46

<p>Declaration of Susan Bailey.</p> <p>Paragraph 49 and Annex 30 identify inactive, never used domain names owned by GC between 2011 and 2015 including: (1) cohibahabana.com; (2) cohibahabana.net; (3) cohiba-havana.com; (4) cohiba-havana.net; (5) cohiba-habana.com; (6) cohiba-habana.net</p>	<p>30-31, 129-165</p>	<p>This evidence is irrelevant to any issue in this Proceeding. CT appears to offer this evidence in support of its §2(d) cancellation ground. As the Board often holds, however, such evidence is not admissible to support CT's §2(d) grounds because registration of an inactive domain name is not relevant to §2(d) claims. <i>See Ramiro Canales v. ALM Media Properties, LLC</i>, 15 TTABVUE 9, 2012 WL 12517331, at *4 (TTAB Jul. 16, 2012) ("The registration of a domain name, alone, without further evidence, does not establish use in commerce."); <i>In Re Arthur M. Kurek</i>, No. 85267214, 10 TTABVUE 9, 2012 WL 2930646, at *4 (TTAB June 26, 2012) (non-precedential) (finding that the acquisition of a domain name for "for future use is not relevant to the question of likelihood of confusion."); <i>A Corp. DBA Rooter Man v. Pete Wood Plumbing and Heating Co.</i>, Opp. No. 91187976, 31 TTABVUE 2, 2011 WL 1399239, at *5 (TTAB Mar. 21, 2011) (non-precedential) (considering registration of an inactive domain name not relevant to a 2(d) claim noting "[t]he Board determines only trademark registrability, not the validity of domain name registrations."). Indeed, a party that tried to enter the identical "WHOIS" search into evidence was rejected by the Board because "WHOIS search...has no relevance to use of any mark.") <i>9 Round, LLC</i>, No. 9205426, 2014 WL 295255, at *6 (Jan. 10, 2014).</p>	
<p>Declaration of David B. Goldstein and Annexes A-B</p>	<p>222 TTABVUE</p>	<p>FRE 401 – Relevancy.</p> <p>This evidence from 2004 should be excluded since likelihood of</p>	<p>N/A</p>

<p>These documents are printouts from US cigar retailer websites included in Exhibit A to the Declaration of David Goldstein from April 19, 2004.</p> <p>Offered by CT to support its §2(d) cancellation claim.</p>		<p>confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).)</p>	
<p>Paragraph 11 of the Declaration of Alan Willner</p> <p>Testimony related to statements Moosylvania made to Willner that “U.S. cigar customers were confused between the General Cigar and Cuban COHIBA cigars.”</p>	<p>223 TTABVUE 5</p>	<p>FRE 802 – Hearsay.</p> <p>Willner’s testimony of alleged actual confusion is based on out-of-court statements made by a third-party marketing representative to Willner and is inadmissible as single hearsay and as legal opinion from an unqualified lay witness. The Board routinely excludes hearsay of this type. <i>See</i> Fed. R. Evid. 802; <i>see, e.g., Rocket Trademarks Pty Ltd. v. Phard S.p.A.</i>, 98 USPQ2d 1066, 1072 (TTAB 2011); <i>Collegpath, Inc. v. Christine L. Sylvain</i>, No. 91248169, 2021 WL 3784236, at *19 (TTAB Aug. 24, 2021) (non-precedential). To the extent Willner’s testimony refers to Moosylvania reports, Willner admitted that he only “sometimes” reviewed those. (223 TTABVUE 11-12 at ¶ 37).</p>	<p>365 TTABVUE 41</p>
<p>Paragraphs 13-15 of the Declaration of Alan Willner.</p> <p>Willner’s testimony that GC’s Cohiba brand “had the strongest Cuban brand association among General Cigar brands</p>	<p>223 TTABVUE 6</p>	<p>FRE 602 – Lack of Foundation.</p> <p>This testimony should be excluded because on cross-examination Willner admitted that this testimony was exaggerated and not based on empirical data, including an admission that all people who “love premium cigars have that association” between all premium</p>	<p>365 TTABVUE 44</p>

with Cuban brand associations.		cigars and Cuba. 361 TTABVUE 77-80 at Tr. 75:25-78:5	
<p>Paragraph 17 of the Declaration of Alan Willner.</p> <p>Testimony that “most cigar consumers in the U.S. believed that Cuban cigars were the highest quality and best cigars in the world.”</p>	223 TTABVUE 6	<p>FRE 701, 802 -- Lay Opinion on Legal Issues; Hearsay.</p> <p>This testimony should be excluded because it lacks foundation and out-of-court statements about what customers told to Willner about Cuban cigars is inadmissible hearsay.</p>	365 TTABVUE 44
<p>Paragraphs 20-23 and corresponding Annexes 19-26 of the Declaration of Miguel Suarez Medina (“Medina”)</p> <p>In each of these paragraphs Medina describes investigative efforts of third-party articles that he alleges include links to the wrong party’s cigar. His investigative efforts included the downloading of “computer source code” and he analyzes the meaning of that “source code.”</p>	225 TTABVUE 7-12, 376-419	<p>FRE 701 – Unqualified Lay Opinion.</p> <p>This evidence should be excluded because Medina “summarizes” / opines on technical information relating to the source code to make conclusions concerning alleged mistaken links. Medina identifies himself as a former paralegal at the law firm of CT’s counsel. Medina does not set forth any foundation of his background or experience with computer source code to provide “summaries” of information related thereto.</p>	365 TTABVUE 40, 42, 46, 47, 50
<p>Paragraphs 26-27 and corresponding Annexes 29-30 of the Declaration of Medina</p> <p>In Paragraph 26, Medina testifies that he visited craigslist.org pages for 13</p>	225 TTABVUE 12-13	<p>FRE 401, 802 – Relevancy; Hearsay.</p> <p>Third-party search results are generally inadmissible in Board proceedings, especially without providing complete articles or supporting evidence concerning the “witness’s” search history. <i>In re</i></p>	365 TTABVUE 40, 42, 46, 47, 50

<p>cities/states selected by CT's counsel and searched for the word "cohiba," printing the search results thereto.</p> <p>In Paragraph 27, Medina testifies that he printed the search results for Cohiba from a third-party website.</p>		<p><i>Bayer Aktiengesellschaft</i>, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) ("Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations"); <i>In re Thomas Nelson, Inc.</i>, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); <i>In re Innovative Cos.</i>, 88 USPQ2d 1095, 1099 n.4 (TTAB 2008); <i>In re Tea and Sympathy Inc.</i>, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008); <i>In re King Koil Licensing Co.</i>, 79 USPQ2d 1048, 1050 (TTAB 2006); <i>In re Thomas</i>, 79 USPQ2d 1021, 1026 (TTAB 2006) (Google hits without any context for the hits are irrelevant).</p>	
<p>Paragraphs 37-43 and corresponding Annexes 40-42 of the Declaration of Medina</p> <p>In Paragraphs 37-43 Medina testifies concerning U.S. Department of Transportation's Bureau of Transportation Statistics he downloaded from the internet related to travel between U.S. and Cuba.</p>	<p>225 TTABVUE 52-54, 514- 791</p>	<p>FRE 401, 403 – Relevancy</p> <p>CT offers this testimony concerning travel to Cuba in order to draw an association between the fact that U.S. citizens have traveled to Cuba and the alleged popularity or sales of the CT Cohiba cigar to U.S. persons in support of CT's §2(d) ground. This testimony and data is irrelevant and prejudicial. CT keeps no data on whether any American customers buy cigars in Cuba, and if so how many. CT's witness Babot admitted that neither CT nor Habanos maintain any data related to purchases by US citizens and has no idea how many US customers buy cigars at these</p>	<p>365 TTABVUE 40, 42, 46, 47, 50</p>

		locations, if any do at all. <i>See</i> 359 TTABVUE 68:15-69:18; 70:17-74:23; 78:13-93:18.	
<p>Paragraphs 50-51 of the Declaration of Medina</p> <p>Medina summarizes evidence he obtained from archive.org/web or the “Wayback Machine”</p>	<p>225 TTABVUE 59-60.</p>	<p>FRE 602; 802 – Lack of Foundation; Hearsay.</p> <p>CT offers testimony related to the Wayback Machine to establish that the content appeared on those websites on those various dates in the past and also for the truth of the underlying webpage. This evidence is inadmissible as lacking foundation and hearsay.</p> <p>“If a party wishes to rely on the Wayback Machine evidence not just for what it shows on its face but to establish that the webpages submitted were displayed on various dates in the past, (“the truth of the capture of the archive date”), witness testimony must be offered to authenticate the printouts and lay the foundation that the webpage printouts are business records. If a party wishes to go further and rely on the pages for the truth of the underlying webpage contents, which would constitute hearsay, competent witness testimony as to their accuracy may be required.” TBMP §704.08(b).</p>	<p>365 TTABVUE 40, 42, 46, 47, 50</p>
<p>Paragraphs 4-11 of the Declaration of Christina Licata</p> <p>In Paragraphs 4-11, Licata “summarizes” evidence of Federal Action Trial Exhibits that are already a part of GC’s trial submissions from the Federal Action.</p>	<p>226 TTABVUE 10-42</p>	<p>FRE 602 Lack of Foundation; Best Evidence Rule.</p> <p>For the purported summaries contained in Paragraphs 4-11 Licata summarizes evidence that was already entered in the Federal Action as summaries of news article references. This is inadmissible. Licata did not search for or find the articles underlying her summary of them, but merely relies on a summary</p>	<p>29, 31, 32, 33, 34, 46</p>

		<p>made by someone else to re-summarize the information. The best evidence is the Federal Action trial exhibits.</p> <p>By re-summarizing and characterizing news articles Licata's testimony amounts to inadmissible legal argument on confusion and should be construed as an evasion on the Board's requirements concerning trial brief page limits. (332 TTABVUE)</p>	
<p>Second Declaration of Susan Bailey</p> <p>Bailey is a non-attorney staff member at the law firm that represents Cubatabaco in this Proceeding. She testified at her deposition that in January 2021, Attorney Frank asked her to go to specific websites to print public materials from the internet that Frank had identified. Frank wrote her Declaration, including many conclusory assertions as to the facts and whether they show confusion. (364 TTABVUE 229, 247-250, 255 at Tr. 16:8-20:2; 33:17-34:8;</p>	308-311 TTABVUE	<p>Pursuant to 37 C.F.R. § 2.123(e)(3), TBMP §§ 527, 533, and 707.03, and Rules 26 and 37 of the Federal Rules of Civil Procedure, GC renews its motion to strike the testimony and exhibits from Bailey as Improper Rebuttal.² (333 TTABVUE)</p> <p>Improper Rebuttal – CT relied on the Second Declaration of Susan Bailey which it submitted during its rebuttal period in its Trial Brief. 365 TTABVUE 54. The Board should strike Bailey's second declaration and exhibits referenced in CT's Trial Brief in support of its §2(d) claims. To the extent CT relies on Bailey in its reply, it should be stricken as well.</p> <p>The very fact that CT relied on its rebuttal evidence to support its §2(d) claim in its Trial Brief supports the conclusion that CT offered the testimony and exhibits to bolster its</p>	365 TTABVUE 52

² The Board previously deferred GC's Motion to Strike CT's rebuttal disclosures (333 TTABVUE) on these grounds because "it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision." 337 TTABVUE 3. The Board noted that "Respondent should renew its objections in its trial brief on the case. *See* TBMP § 801.03. Evidentiary objections that may be raised in a party's brief may instead be raised in an appendix or by way of a separate statement of objections. Trademark Rule 2.128; TBMP § 801.03." *Id.* at 3, n.3. GC hereby renews and incorporates by reference its motion to strike the rebuttal testimony and exhibits of Bailey.

<p>35:24-36:16; 41:2-6.) The 67 exhibits attached to Ms. Bailey's Rebuttal Declaration are almost entirely Internet material that could have been downloaded before the close of Cubatabaco's trial period and included in its trial declarations, 11 including social media posts, excepts from magazines and websites, and the results of searches on Bing and Yahoo web search engines. (See e.g., 308 TTABVUE at Exs. 35-36).</p>		<p>case in chief. The Board routinely excludes rebuttal testimony of this type, which is evidence on the confusion issue that (a) was available to Cubatabaco before the start of its trial period and could have been submitted in the case-in-chief, or (b) is merely cumulative of Cubatabaco's already filed trial evidence – "Rebuttal testimony period is intended solely for the introduction of evidence or testimony that denies, explains, or discredits evidence adduced by the defendant." <i>See e.g., Belden Inc. v. Berk-Tek LLC</i>, 805 F.3d 1064, 116 U.S.P.Q.2d 1869, 1883 (Fed. Cir. 2015); <i>Carefirst of Maryland Inc. v. FirstHealth of the Carolina Inc.</i>, 77 U.S.P.Q.2d 1492, 1498 (TTAB 2005); <i>Life Zone Inc. v. Middleman Group Inc.</i>, 87 U.S.P.Q.2d 1953, 1958 (TTAB 2008); <i>General Electric Co. v. Graham Magnetics Inc.</i>, 197 U.S.P.Q. 690, 692 n.5 (TTAB 1977) (explaining that the rebuttal period is "intended to be limited to denials, refutations, or explanations of Applicant's[/Registrant's] testimony and evidence."); <i>Rowell Laboratories, Inc. v. Canada Packers Inc.</i>, 215 U.S.P.Q. 523, 525 n.2 (TTAB 1982) ("material intended to buttress petitioner's case-in-chief...constituted improper rebuttal"); <i>American Meat Institute v. Horace W. Longacre, Inc.</i>, 211 U.S.P.Q. 712, 719 (TTAB 1981) ("[i]t is the general rule that a party plaintiff may in his case on rebuttal introduce facts and witnesses appropriate to deny, explain, or otherwise discredit the facts and witnesses adduced by the opponent, but not any facts or witnesses which might appropriately have been</p>	
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		<p>introduced during its case-in-chief to sustain its pleading” and thus “a plaintiff may not utilize its rebuttal 12 period to prove its case-in-chief or to shore up its principal case in light of a defendant's evidence”); <i>Capital City, LLC v. Select Brands LLC</i>, Canc. No. 92054587, 2013 WL 5402086, at *4-5 (TTAB Aug. 26, 2013) (striking rebuttal evidence as improper rebuttal where it was cumulative of the likelihood of confusion evidence introduced in plaintiff's case-in-chief) (Non-Precedential).</p> <p>FRE 401, 403, 602; 701(a) – Relevancy; Cumulative Evidence; Lack of Foundation; Speculative Opinion Testimony From Unqualified Lay Witness.</p> <p>The witness is a paralegal with no knowledge of the case's underlying facts, who was simply directed by her attorney employer to go to and download information from certain websites and social media platforms, most of which existed long before the close of discovery but was never disclosed. 333 TTABVUE 14-15.</p> <p>Bailey's declaration, which was written by Cubatabaco's lawyer (364 TTABVUE 229, 247-250, 255 at Tr. 16:8-20:2; 33:17-34:8; 35:24-36:16; 41:2-6.), contains numerous conclusions of law and fact which the witness is not qualified to give. See, e.g., 308 TTABVUE ¶¶ 2(a), 3-10 (scattered social media and webpage posts allegedly show “actual confusion”); ¶17-24 (asserting that scattered webpages show that U.S. cigar retailers “associated General Cigar COHIBA Cigar with Cuba and</p>	
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		<p>the Cuban Cohiba Cigar”; ¶ 42 (block capital lettering of General Cigar COHIBA allegedly is similar to letter of Cuban Cohiba cigar). This appears to be an attempt to evade the page limits on trial briefs.</p> <p>Even the exhibits to the Bailey Rebuttal Declaration that post-date the close of the trial period may not be introduced as rebuttal evidence. TBMP § 509.01(b) (citing <i>Rowell Laboratories, Inc. v. Canada Packers Inc.</i>, 215 U.S.P.Q. 523, 529 n.2 (TTAB 1982) (improper to attempt to introduce newly discovered evidence by way of rebuttal testimony). To introduce this evidence, CT. would have had to move to reopen its trial period and submit the evidence as trial, not rebuttal evidence. Because CT did not do so, this evidence should be excluded.</p>	
<p>Designated Federal Action Plaintiff’s Written Direct Testimony and Appendices of Alvin Ossip, CT market research expert.</p> <p>Designated TTAB Discovery Deposition Transcript and Exhibits of CT’s expert, Alvin Ossip taken on June 29-30, 2017</p>	<p>340 TTABVUE 002-305; 347 TTABVUE 296-1010.</p>	<p>FRE 401, 703 – Relevancy; Inadmissible Expert Testimony</p> <p>FRE 401 – This evidence should be excluded because the survey and market research performed by Ossip over 20 years ago is not relevant to the likelihood of confusion, since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).)</p> <p>FRE 703 – CT designated Ossip as an expert for this Proceeding. Ossip, however, admitted that as an expert in the TTAB proceeding he would not be doing “any additional research” (347 TTABVUE 312 at Tr. 16:8-16), that he has done no “research relating to Instagram or Twitter” or Facebook (<i>id.</i> at 19:7-17); that he has not</p>	<p>365 TTABVUE 13, 28, 29</p>

		<p>measured consumer confusion or consumer awareness in the premium cigar market for any purpose since 2003 (<i>id.</i> at 21:4-13); and that if he were performing a new survey today, the “key group” for a confusion or awareness survey would be “current users” (<i>id.</i> at 40:3-41:5); he was not sure whether he would use the same methodology today (<i>id.</i> at 43:4-19); that he has “no idea what the status of the [GC COHIBA] brand is” and that “if it has grown a lot...that might affect some of the questions.” (<i>id.</i> at 43:20-44:23; 45:7-16; 60:18-61:1); that confusion can dissipate over time (<i>id.</i> at 45:21-23; 50:14-51:18). Ossip has therefore conceded that relying on his survey methodology and results from 2000 is not a reliable to measure confusion today. His testimony from the Federal Action and the TTAB deposition should be excluded on the basis of his own admissions of unreliability.</p>	
Designated Federal Action Plaintiff’s Written Direct Testimony and Appendices of Alan Siegel, CT market research expert. ³	340 TTABUE 306-745	<p>FRE 401 – Relevancy</p> <p>If offered by CT in support of its §2(d) claim, this evidence should be excluded because the digital media research performed by Siegel over 20 years ago is not relevant to the likelihood of confusion, since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i>, 87 USPQ2d 1411, 1416 (TTAB 2008).)</p>	365 TTABVUE 28, 29,
Designated TTAB Discovery Deposition Transcript and Exhibits	348 TTABVUE 1724-1847.	<p>FRE 602, 701(a), 802 – Lack of Foundation, Inadmissible Speculation; Hearsay.</p>	365 TTABVUE 39, 42, 49

³ While CT disclosed Siegel as an expert in this Proceeding, it did not rely on his TTAB deposition or submit it in its trial brief.

of Rene Labor, taken on July 25, 2018.		<p>Labor’s testimony is hearsay and inadmissible speculation and the witness is not credible because of admitted exaggeration. Labor worked at a single cigar store in Miami as a sales-clerk and assistant manager from 2013 to 2017. Labor Dep. Tr. 4:7-10, 17:8-24. He also wrote cigar reviews for the store website (21:9-22:4), including a review of a GC COHIBA Nicaragua cigar where he made assertions that “Whenever I’m asked at the store if we carry Cohiba, 9 times out of 10 the person is referring to the Cuban variant.” Labor Dep., Ex. 4. This was obviously why he was selected as a witness by CT. Yet on cross-examination Labor admitted that in this statement “I am going by an exaggerated sense of feel ... It is just one of those figures of speech that I took an[d] exaggerated it, just because it seems that it seems that way sometimes to me, but there’s absolutely no survey done. There is no research done. There is no tally taken ... Yeah, there’s no fact at all. I could be completely wrong.” (34:10-35:5). Labor’s later assertion in deposition as to the proportion of people coming into his single Florida store who were “maybe” inexperienced smokers (Labor Dep. Tr. 56:14-15), on which CT now heavily relies for its confusion argument, also lacked any foundation in fact – no “survey,” “research” or “tally” was cited to support his statement. Like Labor’s other testimony, this statement was speculative, hearsay, and lacked credibility.</p>	
Designated TTAB Discovery Deposition	350 TTABVUE	FRE 401 – Relevancy	N/A

Transcript and Exhibits of Michael Cullen Cullen performed market research for GC's parent company between 2003-2013, including a 2008 segmentation study.	809-976 (public); 351 TTABVUE 810-977 (conf.)	A marketing study from 2008 is not admissible as evidence of likelihood of confusion in this Proceeding since likelihood of confusion is determined based on facts existing at time at trial. 122 TTABVUE 7 (citing <i>Hornby v. TJX Cos.</i> , 87 USPQ2d 1411, 1416 (TTAB 2008).)	
Declaration of Charles Linehan ("Linehan"); Declaration of Dean J. Gluth ("Gluth"); Testimony of Linehan and Gluth.	307 TTABVUE; 326 TTABVUE 364 TTABVUE 2-205	Pursuant to 37 C.F.R. § 2.123(e)(3), TBMP §§ 527, 533, and 707.03, and Rules 26 and 37 of the Federal Rules of Civil Procedure, GC renews its motion to strike the testimony and exhibits from Linehan and Gluth as: (1) Improper Rebuttal; and (2) Failure to timely disclose. ⁴ (333 TTABVUE) Improper Rebuttal – CT did not rely on the testimony or exhibits of Linehan or Gluth in its Trial Brief. To the extent CT relies on Linehan or Gluth testimony or exhibits in its reply brief, that evidence should not be admitted. Cubatabaco bore the burden of submitting evidence during its case-in-chief that would show that the confusion factors of <i>In re E.I. duPont deNemours & Co.</i> , 476 F.2d 1357, 1361 (C.C.P.A. 1973) favor its position. The evidence in the Rebuttal Declarations is not rebuttal – that is, evidence offered to rebut or explain away General Cigar's own evidence.	N/A

⁴ The Board previously deferred GC's Motion to Strike CT's rebuttal disclosures (333 TTABVUE) on these grounds because "it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision." 337 TTABVUE 3. The Board noted that "Respondent should renew its objections in its trial brief on the case. See TBMP § 801.03. Evidentiary objections that may be raised in a party's brief may instead be raised in an appendix or by way of a separate statement of objections. Trademark Rule 2.128; TBMP § 801.03." Id. at 3, n.3. GC hereby renews and incorporates by reference its motion to strike the rebuttal testimony and exhibits of Linehan and Gluth.

		<p>Rather, it is evidence on the confusion issue that (a) was available to Cubatabaco before the start of its trial period and could have been submitted in the case-in-chief, or (b) is merely cumulative of Cubatabaco's already filed trial evidence. The subjects covered in the Rebuttal Declarations, such as the channels of trade for and pricing of General Cigar COHIBA cigars, were already known to Cubatabaco as a result of discovery, and nothing in the Rebuttal Declarations contradicts or provides a different explanation for facts contained in General Cigar's own trial evidence. Testimony of this type submitted in the rebuttal period is routinely excluded because "rebuttal testimony period is intended solely for the introduction of evidence or testimony that denies, explains, or discredits evidence adduced by the defendant." <i>See e.g., Belden Inc. v. Berk-Tek LLC</i>, 805 F.3d 1064, 116 U.S.P.Q.2d 1869, 1883 (Fed. Cir. 2015); <i>Carefirst of Maryland Inc. v. FirstHealth of the Carolina Inc.</i>, 77 U.S.P.Q.2d 1492, 1498 (TTAB 2005); <i>Life Zone Inc. v. Middleman Group Inc.</i>, 87 U.S.P.Q.2d 1953, 1958 (TTAB 2008); <i>General Electric Co. v. Graham Magnetics Inc.</i>, 197 U.S.P.Q. 690, 692 n.5 (TTAB 1977) (explaining that the rebuttal period is "intended to be limited to denials, refutations, or explanations of Applicant's[/Registrant's] testimony and evidence."); <i>Rowell Laboratories, Inc. v. Canada Packers Inc.</i>, 215 U.S.P.Q. 523, 525 n.2 (TTAB 1982) ("material intended to buttress petitioner's case-in-chief...constituted improper rebuttal"); <i>American Meat Institute v.</i></p>
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		<p><i>Horace W. Longacre, Inc.</i>, 211 U.S.P.Q. 712, 719 (TTAB 1981) (“[i]t is the general rule that a party plaintiff may in his case on rebuttal introduce facts and witnesses appropriate to deny, explain, or otherwise discredit the facts and witnesses adduced by the opponent, but not any facts or witnesses which might appropriately have been introduced during its case-in-chief to sustain its pleading” and thus “a plaintiff may not utilize its rebuttal 12 period to prove its case-in-chief or to shore up its principal case in light of a defendant’s evidence”); <i>Capital City, LLC v. Select Brands LLC</i>, 2013 WL 5402086, at *4-5 (TTAB Aug. 26, 2013) (striking rebuttal evidence as improper rebuttal where it was cumulative of the likelihood of confusion evidence introduced in plaintiff’s case-in-chief) (Non-Precedential).</p> <p>Failure to Disclose Witnesses – Gluth and Lineman were not (i) disclosed in Cubatabaco’s Initial Disclosures; (ii) identified in any of Cubatabaco’s written discovery responses or interrogatories; (iii) identified in any documents Cubatabaco produced during discovery; (iv) disclosed in Cubatabaco’s Pretrial Disclosures; or (v) even contacted by Cubatabaco until mid-January 2021. (333 TTABVUE 17-18.)</p> <p>FRE 401 – Relevancy</p> <p>The evidence should be further excluded on grounds of relevance. Gluth testified that the “sum of [his] testimony is that [he is] aware of one convenience store on Lawrence</p>	
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		<p>Avenue in Chicago that had a box of Cohiba Blue cigars and sold [him] two cigars from that box on a given day.” (364 TTABVUE 181 at Gluth Tr. 59:18-24.) Linehan testified that he does not know the name of who he spoke to at the locations he visited, whether it was licensed to sell tobacco, whether it was a GC direct account, what other GC Cohiba brands were sold there, if any, how many cigars are sold at the location, how many Cohiba cigars are sold at that location, how long the cigar he purchased was sitting in the box, he did not observe anyone else purchasing a cigar from that location. 364 TTABVUE 38-42, 44, 48-52 at Tr. 36:7-40:25; 42:20-24; 46:19-48:22.)</p>	
<p>Trial Cross Examination of Enrique Babot Espinosa</p> <p>General Cigar moves to strike the testimony of Enrique Babot Espinosa.</p>	<p>359 TTABVUE at 75:12-77:6</p>	<p>The witness attempted to change his sworn declaration answer with information that was requested by General Cigar and available to Cubatabaco during the discovery period but was not provided to General Cigar by Cubatabaco in the course of discovery.</p> <p>Mr. Babot cannot supplement his trial testimony, which was filed with the Board on 25 October 10, 2018, after the close of Cubatabaco's trial period, which has been closed since September 16, 2019.</p> <p>Introduction of this information into the trial record is a violation of Fed. R. Civ.P.26(e), 37 C.F.R. 2.120(k)(8), TMBP 408.02, 6 707.02, 703.01(l) and 704.</p>	N/A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

	X	
	:	
EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
Petitioner,	:	Cancellation No. 92025859
	:	
v.	:	
	:	
GENERAL CIGAR CO., INC.,	:	
	:	
Respondent.	:	
	X	

APPENDIX C
RESPONDENT'S RESPONSE TO
PETITIONER'S EVIDENTIARY OBJECTIONS

As a separate statement appended to its trial brief, Petitioner Empresa Cubana del Tabaco, d.b.a. Cubatabaco (“CT”) submitted a statement of its objections (“Statement”) to evidence submitted by Respondent General Cigar Co., Inc. (“GC”) in GC’s trial period. 365 TTABVUE at Appendix B.¹ This Appendix responds to those objections to show that the challenged evidence is admissible.

Over 90% of CT’s 304 evidentiary objections refer to specific questions posed in TTAB deposition and trial testimony and primarily seek exclusion of otherwise relevant evidence under Fed. R. Evid. 403. *See, e.g.*, 365 TTABVUE at Objection Nos. 9-13, 21-304. These objections lack merit, since the objected-to evidence is all probative of one or more issues in the Proceeding (primarily likelihood of confusion under CT’s § 2(d) claim). In such situations, the Board admits the evidence and decides what weight it deserves. *See, e.g., Real Foods Pty Ltd. v. Frito-Lay North Am., Inc.*, 906 F.3d 965, 979, 128 USPQ2d 1370, 1378 (Fed. Cir. 2018) (“The TTAB is entitled to weigh the evidence ...”); *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, Canc. Nos. 92059634 & 92059637, 174 TTABVUE 7-8, 2019 WL 6522400, at *4 (TTAB Dec. 2, 2019) (declining to individually address numerous objections that go to weight rather than admissibility, noting that the Board is capable of weighing the relevance or the strength or weakness of the evidence and according it appropriate probative value); *Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020

¹ CT’s Statement sets forth the totality of CT’s objections to GC’s trial evidence and CT cannot raise new evidentiary objections in its reply. *See, e.g.*, TBMP § 801.02(c); *Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1199 (TTAB 2018) (evidentiary objections raised for first time in reply brief are untimely). *Cf. Productos Lacteos Tocumbo S.A. de C.V. v. Paletteria La Michoacana Inc.*, 98 USPQ2d 1921, 1928 (TTAB 2011) (objection not maintained in opening brief but renewed in reply brief is untimely), *aff’d*, 188 F. Supp. 3d 222 (D.D.C. 2016), *aff’d*, 743 F. App’x 457, 128 USPQ2d 1172 (D.C. Cir. 2018); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (same).

USPQ2d 10085, at *3 (TTAB 2020) (Board is “capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations”).

At the end of its table of 304 evidentiary objections, CT states that it “maintains the objections it made on the record at the discovery depositions and trial in the federal action between the Parties Case No. 97 Civ. 8399 (S.D.N.Y.), as stated therein. TTABVUE Docket Nos. 338, 342-346.” 365 TTABVUE at Appendix B. Most of CT’s trial and discovery objections were to the form of questions and should not be considered. Neither the Board nor GC should be responsible for combing through these voluminous materials to identify and determine the validity of these form objections, which were not identified with specificity in CT’s Statement of objections.²

The balance of CT’s objections attacks the admissibility of certain statements made in the direct testimonies of Steven Abbot (“Abbot”) and Richard Carleton Hacker (“Hacker”) (283 & 273 TTABVUE, respectively), submitted as part of GC’s Trial Evidence. 365 TTABVUE at Appendix B at Obj. Nos. 1-6, 8, 14-19.

With respect to Abbot, CT challenges the admissibility of a handful of statements made in Paragraphs 8(d)-(e), (g), 31, 37, 39, and 59 of his declaration. 273 TTABVUE 56, 17-18, 20-21, 33. In substance, each of CT’s objections to Abbot’s direct testimony at these paragraphs is that Abbot addressed only the “premium cigar” markets and customers and that Abbot never conversed with GC COHIBA customers at gas stations or convenience stores. To the contrary, Abbot based his opinions on his personal experience as a Senior GC Brand Manager, including specifically for the GC COHIBA cigar, his familiarity with GC’s marketing, advertising, and brand planning for COHIBA cigars, his consultations with other brand managers, GC’s internal marketing documents,

² In the event that the Board does evaluate CT’s contemporaneous objections to testimony in the Federal Action, GC requests that the Board give the same evaluation to GC’s objections stated therein.

his meetings with hundreds of cigar merchants and consumers, and other GC business records. 283 TTABVUE 3-4, ¶¶ 1-7. In particular, Abbot testified that from his experience with GC he had “personal knowledge about the U.S. cigar market, including brands of cigars sold on that market, segmentation of the market into premium and non-premium categories, the marketing and brand images of cigars in the U.S., and the sources of information about cigars that are available to consumers.” *Id.* ¶ 6. He also testified that as the brand manager for GC’s COHIBA cigar, he met with hundreds of retailers for GC direct accounts (a representative sample of GC’s customers) and discussed specifically the GC COHIBA cigar. 283 TTABVUE 34, ¶ 63.

To the extent that Abbot’s declaration testimony expresses opinions about the knowledge and preferences of cigar consumers, it is admissible lay witness opinion testimony about, among other things, cigar consumers (in premium and non-premium segments), GC’s cigars and marketing channels, and the Cuban Embargo. His testimony regarding his perceptions of cigar consumers’ knowledge and understanding regarding (a) whether Cuban cigars can be purchased in the U.S., and (b) the availability of Cuban cigars in the U.S., is based on his extensive experience as Senior Brand Manager for GC, during which he was in frequent contact with consumers (283 TTABVUE 17, ¶ 31), and his business responsibilities within one of the largest cigar manufacturers, which required that he acquire an understanding of the target markets for GC’s cigars. *Id.* ¶¶ 4, 6, 7, 31-45. His opinion testimony regarding consumers and the cigar market is therefore admissible under Fed. R. Evid. 701, as it is rationally based on his own perceptions and is helpful to determining facts in issue, *i.e.*, the likelihood of consumer confusion.

Abbot’s testimony, which is based on his personal, business, and industry knowledge, is admissible and entitled to significant weight. *See Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1706 (TTAB 2010) (concluding lay witness could testify “based on his years of

experience in the industry” and expertise of that expected from an individual who has experience and knowledge in the industry); *N. Lock LLC v. C.V. Brewing Co.*, Opp. No. 91219821, 26 TTABVUE 2-3, 2016 WL 5407761, at *1 (TTAB Sept. 16, 2016) (non-precedential) (concluding that lay witnesses could testify about what the other side argued was “technical and specialized issues related to beer making” based on their knowledge in the field).

Moreover, CT’s objections presume that convenience stores and gas stations are important trade channels for GC COHIBA cigars that Abbot ignored. CT, however, failed to show that “convenience stores and gas stations” constitute any more than a *de minimis* channel for GC’s COHIBA cigars. CT did not provide any material evidence in support of this contention that Abbot failed to consider a “key” part of the GC COHIBA cigar business other than to distort GC witness testimony. In any event, Abbot’s un rebutted testimony establishes the contrary facts:

General Cigar markets and positions its COHIBA in the United States premium cigar market as an ultra-luxury cigar, at the top end of the premium cigar spectrum. General Cigar’s COHIBA cigars are positioned as an “aspirational” brand for consumers, and General Cigar’s marketing materials and advertisements evoke the image of a luxury lifestyle through images of the cigar positioned alongside luxurious and expensive champagnes and spirits, enjoyed by individuals wearing expensive watches and well-tailored suits and clothing. These signifiers of a high-status lifestyle are emphasized by the tagline “Experience Luxury.”

283 TTABVUE 19, ¶ 35, 367-84 (Annex Q); 285 TTABVUE 2-912 (Annex W).

CT has not presented competent evidence showing either that (a) GC’s COHIBA cigar is not a premium cigar or (b) that Abbot does not know the market for cigars despite his years of experience of being a senior brand manager for a major cigar manufacturer. Its contrary “evidence” consists of reports from three investigators who assert they purchased one or two COHIBA cigars (of doubtful authenticity and age) at gas stations and convenience stores. *Cf.* 364 TTABVUE 48-49, 181 at Linehan 46:14-47:22; at Gluth 59:18-24 (Q. Mr. Gluth, the sum of your testimony is that you’re aware that one convenience store on Lawrence Avenue in Chicago had a box of Cohiba

Blue cigars and sold you two cigars from that box on a given day; is that correct? A. Correct.); 355 TTABVUE 310-315 at Richter Tr. 48:19-53:21. Accordingly, Abbot's testimony concerning GC COHIBA's product positioning and its channels of trade is admissible.

With respect to Richard Carleton Hacker, a highly qualified expert in cigars and the U.S. cigar market, *see* Hacker Direct Testimony (273 TTABVUE 3, 5-8, ¶¶ 1, 6-18), CT objects to admission of Hacker's direct testimony in Paragraphs 21, 23, 26, 28, and 31-32 in his declaration (273 TTABVUE 8-12). CT's objection is primarily that Hacker's testimony only addresses, and that Hacker only has knowledge about, the premium cigar market. This is not accurate, as his testimony covers cigars in general. *Id.* at 8, ¶ 18.³

Moreover, GC has demonstrated a foundation for Hacker's entire testimony. It is based on his knowledge and experience over decades of work in the tobacco industry and his writing and updating of the authoritative work on the subject of cigars, and the facts and data that he obtained through such work. 273 TTABVUE 5, ¶¶ 6, 10, 11. Notably, Hacker has, among other things, "met and spoken with consumer cigar smokers on a regular basis" and often discussed "the attitudes and beliefs of U.S. cigar smokers" based on a number of factors, including questions he heard from consumers "over the last three decades." *Id.* at ¶¶ 15-16, 18. Hacker bases his opinion about how informed consumers are, in part, on his discussions with "many hundreds of cigar smokers" and "thousands of interactions with both cigar smokers and tobacconists." *Id.* at ¶¶ 21-22, 28. Hacker

³ Hacker testified: "I have relied on my own observations and experiences accumulated in over 30 years as a cigar expert, which include: my frequent personal interactions and discussions with consumer cigar smokers and retail tobacconists at seminars and industry events; the extensive research I performed in connection with my book *The Ultimate Cigar Book*, and the additional extensive research I performed in writing the recently published fourth edition of this book; my review of reliable industry and trade publications such as Smokeshop Magazine, Tobacco International Magazine, and Tobacconist Magazine and reliable Internet cigar commentary; my personal experience in reviewing hundreds of brands of cigars; and pertinent news stories that pertain to the tobacco industry." 273 TTABVUE 8, ¶ 18.

has personally seen “many [consumers] checking their smartphones” to obtain current information about cigars and their origins. *Id.* at ¶ 24. Hacker’s testimony, as it is based on personal experience with cigar smokers and the cigar market, is admissible under Fed. R. Evid. 702 as qualified expert testimony. *See Groobert v. President & Directors of Georgetown Coll.*, 219 F. Supp. 2d 1, 7 (D.D.C. 2002) (“personal experience can be a reliable and valid basis for expert testimony”) (citing *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 149 (1999)). It should be noted that CT chose not to present the testimony of any industry expert to rebut Hacker’s expert testimony, and CT also elected not to cross-examine Hacker during GC’s trial period.

At most, CT’s objections go to the weight of Hacker’s testimony, not its admissibility. The Board should therefore admit Hacker’s testimony in full and give it the weight the Board believes it deserves. *See, e.g., Real Foods Pty Ltd.*, 128 USPQ2d at 1378; *Milwaukee Elec. Tool Corp.*, 174 TTABVUE 7-8.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

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	:	
EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	Cancellation No. 92025859
Petitioner,	:	
	:	
v.	:	
	:	
GENERAL CIGAR CO., INC.,	:	
	:	
Respondent.	:	
-----	X	

APPENDIX D

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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

EMPRESA CUBANA DEL TABACO d.b.a.
CUBATABACO,

Plaintiff,

- against -

CULBRO CORPORATION, and GENERAL
CIGAR CO., INC.

Defendants.

97 Civ. 8399 (RWS)

**PLAINTIFF'S MEMORANDUM OF LAW IN SUPPORT OF
PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT**

February 5, 2002

Confidential Under Protective Order

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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

EMPRESA CUBANA DEL TABACO d.b.a.
CUBATABACO,

Plaintiff,

- against -

CULBRO CORPORATION, and GENERAL
CIGAR CO., INC.

Defendants.

97 Civ. 8399 (RWS)

**PLAINTIFF'S MEMORANDUM OF LAW IN SUPPORT OF
PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT**

February 5, 2002

Confidential Under Protective Order

